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Copyright Laws

Law's American Digest:

BEING A DIGEST OF AMERICAN CASES RELATING TO PATENTS FOR INVENTIONS AND COPYRIGHTS, FROM 1789 TO 1862.

Including numerous Manuscript Cases, Decisions on Appeals from Commissioners of Patents, and the Opinions of the Attorneys-General of the United States, under the Patent and Copyright Laws; and embracing, also, the American Cases in respect to Trade-Marks. Arranged in Chronological Order, with the year in which, and the name of the Judge by whom, decided.

By STEPHEN D. LAW, Esq.,

Author of "Law's United States Courts," &c.

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COPYRIGHT

AND

PATENT LAWS

OF THE

UNITED STATES,

1790 TO 1868.

WITH

NOTES OF JUDICIAL DECISIONS THEREUNDER

AND

FORMS AND INDEXES.

BY STEPHEN D. LAW,

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PREFACE.

In the United States, property in Copyright and in Patents for Inventions is created by, and held solely under laws passed by the General Government. Previous to the adoption of the Federal Constitution, in 1789, the several States had granted exclusive rights to authors and inventors; but that instrument gave to Congress "power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;" and the States can now perform no act in respect thereto, or none not in harmony with, and subordinate to, the superior power of Congress.

In 1790, at the first session of Congress, and among its earliest acts, laws were passed "to promote the progress of useful arts," and "for encouragement of learning, by securing the copies of maps, charts, and

books to the authors and proprietors of such copies, during the times therein mentioned."

The Copyright act of 1790 remained unchanged until 1802, when a supplementary act was passed, extending also its provisions, in which form it continued in force until 1831, when it was repealed, and a new and more complete act substituted in place of it. The act of 1831 is still in force, and is the basis of the existing copyright system of the country; but has been amended and enlarged by acts passed in 1834, 1846, 1856, 1859, 1861, and 1865.

The Patent act of 1790 was superseded by an act passed in 1793, and this latter act, amended and enlarged by acts passed in 1794, 1800, 1819, and 1832, continued in force until 1836, when the entire legislation in respect to patents for inventions was revised, and a new and more carefully drawn law enacted. The act of 1836 still remains in force, and is the basis of the existing patent system of the country; but has been enlarged and amended by acts passed in 1837, 1839, 1842, 1848, 1849, 1851, 1852, 1853, 1855, 1856, 1859, 1860, 1861, 1862, 1863, 1864, and 1865.

The duration of the term of a copyright was fixed, by the act of 1790, at fourteen years, with a right of renewal for fourteen years longer. By the act of 1831, the first term of a copyright was enlarged to twenty-eight years, with a right of renewal, as before,

for fourteen years; thus making the whole term forty-two years.

The duration of the term of patents for inventions was fixed, by the first act of 1790, at fourteen years. The act of 1836 fixed the same duration, but made provision for an extension, under certain circumstances, for seven years longer. By the act of 1861, the term of a patent was fixed at seventeen years—except as to patents for designs, which may be three and a half, or seven, or fourteen years, as desired; and the extension of all patents granted subsequent to the date of that act, March 2d, 1861, was prohibited—except as to patents for designs, which may be extended for seven years.

Congress, however, can grant such exclusive rights for any period, or extend existing terms, as it may see fit; and it has frequently exercised such power, by special acts, even after the expiration of terms secured under the general law.

The laws of this country, in respect to copyrights, except as to the duration of the term, and the formalities by which secured, are substantially like those of England and other countries; in respect, however, to patents for inventions, the differences between our laws and those of other countries are marked and distinct.

The great distinguishing feature of the patent sys-

tem of this country is that which requires all applications for patents to be subjected to a preliminary examination, as to originality and novelty of invention, before a patent can issue, and which forbids the issue of a patent to any one who is not the *first* as well as an *original inventor* of the thing sought to be patented. Though the practical operation of such a system is necessarily attended with difficulties, and the exercise of such power of rejection may sometimes work injustice to the deserving inventor, it can scarcely be questioned that it is highly useful, as well to the inventor, in bringing to his notice what is already known in the art to which his invention appertains, as to the public in interposing a salutary check to the issue of trifling or worthless patents.

In England, and in most other countries, patents, originally, were grants proceeding directly from the sovereign, and were considered by the courts as monopolies, odious in the eye of the law, and to be construed strictly. In this country, however, it has been uniformly held that the design of our patent laws was to encourage genius in advancing the arts, by protecting its productions, and that such laws were to be construed favorably and beneficially for patentees; and that patents granted thereunder were to be considered not as monopolies, but liberally, and as

highly beneficial to the community, as well as rewards to ingenious men for the advantages derived by the public from their exertions.

The copyright and patent systems of this country, as established by the legislature, and interpreted by the courts, may justly be considered as liberal and highly favorable to such interests; and in no country, probably, are the rights of authors and inventors more generally recognized, or their rewards and remuneration more ample and munificent.

In this compilation, the several laws, as to copyright and patents for inventions, which are obsolete, are inserted in full, as well as those laws which are now in force; this has been done for convenience of reference and comparison, and to help to a more perfect understanding and interpretation of those in force.

Notes of decisions, which have a more particular reference to the obsolete acts, are inserted under such acts; decisions of a general nature, though made under such acts, are inserted under the acts now in force. It has not been intended, however, to insert under the several acts all the decisions explanatory of them, but only those of a more general character; adding also suitable references to the appropriate titles of the "Digest of Patent Cases," a work published by the author of the present volume, and

being a Digested Abstract of all the Cases relating to Copyright, Patents for Inventions, and Trade-marks, decided in the American courts, from 1789 to the present time.

THE AUTHOR.

NEW YORK, *June*, 1866.

PROVISION

OF THE

CONSTITUTION OF THE UNITED STATES

AUTHORIZING THE GRANT OF

EXCLUSIVE RIGHTS TO AUTHORS AND INVENTORS.

CONSTITUTION OF THE UNITED STATES.

ARTICLE 1, SECTION 8.

THE Congress shall have power:

To promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries:

Also, to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.

POWER OF CONGRESS, AND OF THE STATES UNDER.

1. The power of Congress, under this article and section, is limited to authors and inventors only, and does not embrace introducers, who are not authors and inventors. *Livingston* v. *Van Ingen*, 9 Johns., 560, 566, 582.—YATES, THOMPSON, and KENT, JJ.; (Ct. Errors;) N. Y., 1812.

2. But such clause does not prevent the several States from exercising the power of securing to introducers of useful inventions (without being the authors or inventors) the exclusive benefit of such inventions for a limited period. *Ibid.*, 560, 566, 582.

POWER OF CONGRESS, AND OF THE STATES UNDER.

3. Nor does it take away from the States the power to enlarge, within their jurisdiction, the privilege, by extending the term of the patent or monopoly, beyond the term allowed by the acts of Congress; nor operate as an exclusion of all State legislation to aid and protect the rights obtained under the general government, if the power is exercised in harmony with, and in subordination to, the superior power of Congress. *Ibid.*, 567, 581.

4. Though a State cannot take away from an individual his patent, yet if an author or inventor, instead of resorting to the act of Congress, should apply to the legislature of a State for an exclusive right to his production, there is nothing to hinder a State granting it, though the operation of the grant would be confined to the limits of the State. *Ibid.*, 581.

5. The power of Congress is only to ascertain and define the rights of property in the invention; it does not extend to regulating the use of it. This is exclusively of local cognizance; such property, like every other species, must be used and enjoyed within each State, according to the laws of such State. *Ibid.*, 581.

6. The laws of any State, granting exclusive rights and privileges in respect to patents and inventions, are inoperative as against the laws of the United States, with which they may come in collision. *Gibbons* v. *Ogden*, 9 Wheat., 186.—MARSHALL, Ch. J.; Sup. Ct., 1824.

7. If the author's book or print contains matter injurious to the public morals or peace, or if the inventor's machine or other production will have a pernicious effect upon the public health or safety, a competent authority remains with the States to restrain their use. *Livingston* v. *Van Ingen*, 9 Johns., 582.—KENT, J.; N. Y., 1812.

8. Such species of property is likewise subject to taxation, and to the payment of debts, as other personal property. *Ibid.*, 582.

9. The fact that a party has a patent giving him the exclusive right to make, use, and sell a particular medicine, does not confer upon him the right to practise as a physician, and use such medicine, in any particular State, except in conformity with the laws of such State. *Jordan* v. *Overseers of Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831. *Thompson* v. *Staats*, 15 Wend., 395.—NELSON, J.; N. Y., 1836.

10. A party has not necessarily a right to use an invention in any State, merely because he has a patent for it. *Vannani* v. *Paine*, 1 Harrington, 68.—ROBINSON, J.; Del., 1833.

11. Where V. had invented a plan for constructing and drawing lotteries, and had obtained a patent therefor, but there was a State law prohibiting lotteries, except under certain conditions, which V. and his associates had not complied with, *Held*, that V. was not entitled to any relief, by way of injunction or otherwise, for any alleged use of his invention within such State. *Ibid.*, 69.

12. The power of Congress, as to patents, is general, and it rests in its sound discretion to say, when and for what length of time, and under what circumstances, a patent for an invention shall be granted.

POWER OF CONGRESS, AND OF THE STATES UNDER.

There is no restriction which limits its power to enact, to cases where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor. *Blanchard* v. *Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

13. The power of Congress to legislate upon the subject of patents is plenary; and as there is no restraint upon its exercise, there can be no limitation to the right to modify at pleasure the laws respecting patents, so that they do not take away the rights of property in existing patents. *McClurg* v. *Kingsland*, 1 How., 206.—BALDWIN, J.; Sup. Ct., 1843.

14. It is no objection to the validity of the laws respecting patents, that such laws are retrospective in their operation. *Ibid.*, 206.

15. Congress may pass an act which shall act retrospectively. Such an act is not necessarily unconstitutional. Though no State can impair the obligations of a contract, this inhibition does not apply to the general government. *Bloomer* v. *Stolley*, 5 McLean, 165.—MCLEAN, J.; Ohio, 1850.

16. A reservation in favor of *assignees*, in an act extending a patent, will not make the act unconstitutional on the ground that Congress can only confer privileges on *inventors*. The power to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts. *Blanchard Gun-Stock Turning Fac.* v. *Warner*, 1 Blatchf., 271, 276.—NELSON, J.; Ct., 1846.

17. Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard* v. *Haynes*, 6 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848.

18. Alleged fraud and misrepresentation, in the passage of an act of Congress extending a patent, will not be presumed; but such an act will be regarded by the courts as the law of the land, until it is repealed. *Gibson* v. *Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

19. Under the fifth amendment of the Constitution, declaring that no person shall be deprived of life, liberty, or property, without due process of law, Congress would have no right to pass an act depriving purchasers of a patented article of the right to use such article. Such an act would not be regarded as due process of law. *Bloomer* v. *McQuewan*, 14 How., 553.—TANEY, Ch. J.; Sup. Ct., 1852.

20. Under the authority conferred by section 8th, article 1st, of the Constitution, it does not follow that Congress may authorize an inventor to recall rights which he has granted to others, or reinvest him with rights of property, which he has before conveyed for a valuable consideration. *Ibid.*, 553.

21. Congress may renew a patent or decline to do so. The grant of an exclusive privilege to an inventor for a limited time, does not imply a binding and irrevocable contract with the people, that at the expiration of the period the invention shall become their property. *Evans* v. *Eaton*, Pet. C. C., 337.—WASHINGTON, J.; Penn., 1816.

POWER OF CONGRESS, AND OF THE STATES UNDER.

22. Congress has the constitutional power to grant an extension of a patent even after it has been once extended under section 18 of the act of 1836. *Bloomer* v. *Stolley*, 5 McLean, 160–162.—McLean, J.; Ohio, 1850.

23. The power of Congress was not exhausted in this respect by the act of 1836. A legislative act does not bind a subsequent legislature. *Ibid.*, 161.

24. Congress may exercise its constitutional power, as to granting rights to inventors, either by special acts, or by a general system. *Ibid.*, 161.

25. A private act of Congress, authorizing the issue of a patent to an inventor, is to be considered as engrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Evans* v. *Eaton*, 3 Wheat., 518.—Marshall, Ch. J.; Sup. Ct., 1818.

26. They are all statutes in *pari materia*, and all relate to the same subject, and are to be construed together. *Bloomer* v. *McQuewan*, 14 How., 549, 551.—Taney, Ch. J.; Sup. Ct., 1852.

See also Digest Pat. Cases, titles Congress; Statutes, B. 1, 4.

ACTS OF CONGRESS

IN RESPECT TO

COPYRIGHTS.

ACTS IN FORCE.

Act of 1819, Chap. 19.	Act of 1859, Chap. 22.
" 1831, " 16.	" 1861, " 37.
" 1834, " 157.	" 1865, " 120.
" 1856, " 169.	" 1867, " 43.

OBSOLETE ACTS.

Act of 1790, Chap. 15.	Act of 1846, Chap. 178.
" 1802, " 36.	

COPYRIGHT LAWS.

ACT OF 1790, CHAPTER 15.

1 STATUTES AT LARGE, 124.

[*Obsolete: Repealed by Act of* 1831, § 14.]

An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned:

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof or resident within the same, his or their executors, administrators or assigns, who hath or have not transferred to any other person the copyright of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who hath or have purchased or legally acquired the copyright (*a*) of any such map, chart, book or books, in order to print, reprint, publish, or vend the same, shall have the sole right and liberty of printing, reprinting, publishing, and vending such map, chart, book or books, for the

term of fourteen years from the recording the title thereof in the clerk's office, as is hereinafter directed: And that the author and authors of any map, chart, book or books already made and composed, and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: *Provided*, he or they shall cause the title thereof to be a second time recorded and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years aforesaid.

(*a*) The "copyright" recognized by this act, and which is intended to be protected, is presumed to be the right of property which an author has at common law, in his manuscript. Such protection is given as well to books published. as to manuscript copies. *Wheaton* v. *Peters*, 8 Pet., 661.—McLean, J.; Sup. Ct., 1834.

Section 2. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any map, chart, book or books, and publishing the same as aforesaid, and within the times limited and granted by this act, shall print, reprint, publish, or import, or cause to be printed, reprinted, published, or

imported from any foreign kingdom or state, any copy or copies of such map, chart, book or books, without the consent of the author or proprietor thereof, first had and obtained in writing, signed in the presence of two or more credible witnesses; or, knowing the same to be so printed, reprinted, or imported, shall publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such map, chart, book or books, without such consent first had and obtained in writing as aforesaid, then such offender or offenders shall forfeit all and every copy and copies of such map, chart, book or books, and all and every sheet and sheets, being part of the same, or either of them, to the author or proprietor of such map, chart, book or books, who shall forthwith destroy the same: And every such offender and offenders shall also forfeit and pay the sum of fifty cents for every sheet which shall be found in his or their possession, either printed or printing, published, imported, or exposed to sale, contrary to the true intent and meaning of this act, the one moiety thereof to the author or proprietor of such map, chart, book or books, who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, wherein the same is cognizable. *Provided always*, That such action be commenced within one year after the cause of action shall arise, and not afterward.

SECTION 3. *And be it further enacted*, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit

a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside (*a*): And the clerk of such court is hereby directed and required to record the same forthwith, in a book to be kept by him for that purpose, in the words following (giving a copy thereof to the said author or proprietor, under the seal of the court, if he shall require the same.) "District of to wit: *Be it remembered*, That on the day of in the year of the independence of the United States of America, A. B., of the said district, hath deposited in this office the title of a map, chart, book or books (as the case may be), the right whereof he claims as author or proprietor (as the case may be), in the words following, to wit: [here insert the title] in conformity to the act of the Congress of the United States, intituled, 'An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.' C. D., clerk of the district of

." For which the said clerk shall be entitled to receive sixty cents from the said author or proprietor, and sixty cents for every copy under seal actually given to such author or proprietor as aforesaid. And such author or proprietor shall, within two months from the date thereof, cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks. (*b*)

(*a*) If the title of an author depended upon the act of 1790, it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by this section. *Ewer* v. *Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

(*b*) 1. The provision of this section requiring the author to publish

the title of his book, in a newspaper, is merely directory, and constitutes no part of the essential requisites for securing the copyright. *Nichols* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

2. The publication in the newspaper is intended as legal notice of the rights secured to the author; but is not necessary where actual notice is brought home to the party. *Ibid.*, 158.

3. The condition upon which the proprietor is to be entitled to the benefit of the act cannot be extended to the requisition contained in the last sentence of that section, to publish a copy of the record of the title, as prescribed therein. *Ewer* v. *Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

4. The publication of a copy of such notice is only necessary to enable him to sue for the forfeitures created by that section. *Ibid.*, 490.

SECTION 4. *And be it further enacted*, That the author or proprietor of any such map, chart, book or books, shall, within six months after the publishing thereof, deliver, or cause to be delivered to the Secretary of State a copy of the same, to be preserved in his office.

1. The requirement of this section, as to delivering a copy of the book to the Secretary of State, is merely directory, and constitutes no part of the essential requisites for securing a copyright. The copy to be delivered to the Secretary of State appears to be designed for public purposes, and has no connection with the copyright. *Nichols* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

2. Under this section a copy of a book may be deposited with the Department of State, after the expiration of six months from the time of its publication if not done before, and will avail from the time of its being deposited. *Daboll's Case*, 1 Opin., 532.—WIRT, Atty. Gen.; 1822.

3. Where a work consisted of a number of volumes, the delivery to the Secretary of State of the first volume of the work within six months after its publication and of the rest of the volumes, before the offence complained of is committed, or the action brought, is a sufficient compliance with the law. *Dwight* v. *Appletons*, 1 N. Y. Leg. Obs., 199.—THOMPSON, J.; N. Y., 1843.

SECTION 5. *And be it further enacted*, That nothing in this act shall be construed to extend to prohibit the importation or vending, reprinting or publishing, within the United States, of any map, chart, book or books, writ-

ten, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.

SECTION 6. *And be it further enacted*, That any person or persons who shall print or publish any manuscript, without the consent and approbation of the author or proprietor thereof, first had and obtained as aforesaid (if such author or proprietor be a citizen of, or resident of these United States), shall be liable to suffer and pay to the said author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof.

SECTION 7. *And be it further enacted*, That if any person or persons shall be sued or prosecuted for any matter, act, or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.

Approved May 31st, 1790.

ACT OF 1802, CHAPTER 36.

2 STATUTES AT LARGE, 171.

[*Obsolete: Repealed by Act of* 1831, § 14.]

An Act supplementary to an act, intituled "An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the time therein mentioned," and extending the benefits thereof to the arts of designing, engraving, and etching historical and other prints.

OBSOLETE. ACT OF 1802, CHAP. 36, § 1.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That every person who shall, from and after the first day of January next, claim to be the author or proprietor of any maps, charts, book or books, and shall thereafter seek to obtain a copyright of the same agreeable to the rules prescribed by law, before he shall be entitled to the benefit of the act, intituled "An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the time therein mentioned," he shall, in addition (*a*) to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information by causing the copy of the record, which, by said act, he is required to publish in one or more of the newspapers, to be inserted at full length in the title-page, or in the page immediately following the title of every such book or books; and if a map or chart shall cause the following words to be impressed on the face thereof, viz.: "*Entered according to act of Congress, the day of* 18 [here insert the date when the same was deposited in the office] *by A. B. of the State of* [here insert the author's or proprietor's name and the State in which he resides].

(*a*) 1. By this section no person can be entitled to the benefit of the act of 1790, unless he shall, *in addition* to the requisites enjoined in sections 3 and 4 of that act, cause a copy of the record, required by that act to be published, to be inserted at full length in the title-page, or on the page immediately following the title of the book. *Ewer* v. *Coxe*, 4 Wash., 490.—WASHINGTON, J.; Pa., 1824.

2. The person, therefore, claiming a copyright, before he can be entitled to the benefits of the act of 1790, must perform the requisites required by this act, *in addition* to those prescribed in sections 3 and 4 of the act of 1790, and must perform the whole. The act admits of no other construction. *Ibid.*, 491.

3. The meaning of the act is as if it read, "the proprietor, before he shall be entitled to the benefit of the act of 1790, shall cause a copy of the record of the title to be published, and shall deliver a copy of the book to the Secretary of State, as directed by the third and fourth sections of that act; and shall also cause a copy of the said record to be inserted at full length in the title-page," &c. *Ibid.*, 491.

4. The act of 1802 requires the requisites enjoined in sections 3 and 4 of the act of 1790, as to notice and the deposit of the book in the State Department, to be performed "in addition" to the one required by this act of 1802, before an author "shall be entitled to the benefit of the first act." *Wheaton* v. *Peters*, 8 Pet., 665.—McLEAN, J.; Sup. Ct., 1834.

SECTION 2. *And be it further enacted*, That from and after the first day of January next, every person, being a citizen of the United States or resident within the same, who shall invent and design, engrave, etch or work, or from his own works and inventions, shall cause to be designed and engraved, etched or worked, any historical or other print or prints, shall have the sole right and liberty of printing, reprinting, publishing, and vending such print or prints, for the term of fourteen years from the recording the title thereof in the clerk's office, as prescribed by law for maps, charts, book or books: *Provided*, he shall perform all the requisites, in relation to such print or prints, as are directed in relation to maps, charts, book or books, in the third and fourth sections of the act to which this is a supplement, and shall moreover cause the same entry to be duly engraved on such plate, with the name of the proprietor, and printed on every such print or prints as is hereinbefore required to be made on maps or charts.

1. The person who, under this section, is intended and described as the proprietor of a copyright in a print, is one who shall not only invent *and* design, but who shall also engrave, etch, or work the print to which the right is claimed; or, who, *from his own works and inventions*, shall cause the print to be designed and engraved, etched, or worked. *Binns* v. *Woodruff*, 4 Wash., 51.—WASHINGTON, J.; Pa., 1821.

2. In the first case, the inventor and designer is identified with the engraver, or, in other words, the entire work, or subject of the copyright, is executed by the same person. In the latter, the invention is designed or embodied by the person in whom the right is vested, and the form and completion of the work are executed by another. *Ibid.*, 51.

3. But in neither case can a person claim a copyright for a mere invention, the work of his imagination locked up in his own mind, or existing in a form not visible to others. Neither is he so entitled, unless he has not only invented, but also designed or represented the subject in some visible form. *Ibid.*, 51.

4. Where neither the design nor the general arrangement of a print, nor the parts which composed it, was the invention of the plaintiff, but he had employed and paid the artists who had composed and executed it, *Held*, that under this section he was not entitled to a copyright. *Ibid.*, 53.

SECTION 3. *And be it further enacted*, That if any printseller or other person whatsoever, from and after the said first day of January next, within the time limited by this act, shall engrave, etch or work, as aforesaid, or in any other manner copy or sell, or cause to be engraved, etched, copied or sold, in the whole or in part, by varying, adding to, or diminishing from the main design, or shall print, reprint, or import for sale, or cause to be printed, reprinted, or imported for sale, any such print or prints, or any parts thereof, without the consent of the proprietor or proprietors thereof, first had and obtained, in writing, signed by him or them respectively, in the presence of two or more credible witnesses; or knowing the same to be so printed or reprinted, without the consent of the proprietor or proprietors, shall publish, sell, or expose to sale or otherwise, or in any other manner dispose of any such print or prints, without such consent first had and obtained, as aforesaid, then such offender or offenders shall forfeit the plate or plates on which such print or prints are or shall be copied, and all

and every sheet or sheets (being part of or whereon such print or prints are or shall be copied or printed) to the proprietor or proprietors of such original print or prints, who shall forthwith destroy the same; and further, that every such offender or offenders shall forfeit one dollar for every print which shall be found in his, her, or their custody; either printed, published, or exposed to sale, or otherwise disposed of, contrary to the true intent and meaning of this act, the one moiety thereof to any person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered in any court having competent jurisdiction thereof.

SECTION 4. *And be it further enacted*, That if any person or persons, from and after the passing of this act, shall print or publish any map, chart, book or books, print or prints, who have not legally acquired the copyright of such map, chart, book or books, print or prints, and shall, contrary to the true intent and meaning of this act, insert therein or impress thereon that the same has been entered according to act of Congress, or words purporting the same, or purporting that the copyright thereof has been acquired; every person so offending shall forfeit and pay the sum of one hundred dollars, one moiety thereof to the person who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, having cognizance thereof. *Provided always*, that in every case for forfeitures hereinbefore given, the action be commenced within two years from the time the cause of action may have arisen.

Approved April 29th, 1802.

ACT OF 1819, CHAPTER 19.

3 STATUTES AT LARGE, 481

[*This Act still in Force.*]

An act to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents [and copyrights].

Be it enacted, by the Senate and House of Representatives of the United States of America, in Congress assembled, That the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable (*a*); *Provided, however*, That from all judgments and decrees of any Circuit Courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such Circuit Courts. (*b*)

(*a*) 1. The act of 1819, so far as it gave cognizance to the courts of

the United States in cases of copyrights, still remains in force, and is the only law conferring equitable jurisdiction on these courts in such cases; the ninth section of the act of 1831 protects manuscripts only. *Stephens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

2. The equity jurisdiction of such courts, as to copyrights, does not extend to the adjudication of forfeitures: a decree, therefore, cannot be entered for the penalties incurred for a violation of a copyright. *Ibid.*, 455.

3. Under the acts of 1790 and 1819, as to patents and copyrights the owners of copyrights and patents do not have redress or relief in any cases where they could not before have had relief in some court, either of equity or law. *Pierpont* v. *Fowle*, 2 Wood. & Min., 27.—WOODBURY, J.; Mass., 1846.

4. These acts merely enable them to prosecute such claims in the Circuit Court of the United States, as they usually had done before, but without going to the State tribunals; the public interest required a uniform construction to be placed by one tribunal on all important questions connected with rights so held. *Ibid.*, 27.

5. The jurisdiction of the Federal courts, under the acts of Congress respecting copyrights, has not taken away or diminished the original jurisdiction, which, before such acts, the State courts exercised—except where the jurisdiction was made exclusive in express terms, or by the necessary construction of the Federal Constitution. *Woolsey* v. *Judd*, 4 Duer, 382.—DUER, J.; N. Y., 1855.

6. Under the act of Congress, giving to the Circuit Courts cognizance of cases arising under the laws of the United States, granting to authors the exclusive right to their writings, the citizenship of the parties litigant is immaterial. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44, 45.—CADWALLADER, J.; Pa., 1860.

7. The act of 1819 concerns remedies, and not rights. *Ibid.*, 45.

8. Where a wrong has been committed in respect to a literary work, but the bill does not ask for an injunction to protect the common law rights of the author, or the violation of any copyright secured, but only asks an account, redress cannot be sought in a court of equity, but the party must proceed at law for damages. *Monk* v. *Harper*, 3 Edw. Ch., 110, 111.—MCCOUN, V. Chan.; N. Y., 1837.

See also DIGEST PAT. CASES, titles ACTIONS, A; EQUITY, A.

(*b*) A writ of error, or appeal, as the case may require, now lies to the Supreme Court, from all judgments or decrees of any Circuit Court, rendered in any action, at law or in equity, arising under any of the laws as to copyrights. Act of 1861, chap. 37.

ACT OF 1831, CHAPTER 16.

4 STATUTES AT LARGE, 436.

[*This Act still in Force.*]

An Act to amend the several acts respecting copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from and after the passing of this act, any person or persons, being a citizen or citizens of the United States, or resident therein, who shall be the author or authors of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving, and the executors, administrators, or legal assigns of such person or persons (*a*), shall have the sole right and liberty of printing, reprinting, publishing, and vending (*b*) such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed. (*c*)

(*a*) WHO MAY HAVE, AND WHAT SUBJECT OF COPYRIGHT.

1. Under this act a person, to be a "resident" so as to be entitled to a copyright, must be a permanent resident of the country. A person temporarily residing here, even though he has declared his intention of becoming a citizen, cannot take or hold a copyright. *Carey* v. *Collier*, 56 Niles's Reg., 262.—BETTS, J.; N. Y., 1839.

2. The legal assignee of the author may take out the copyright, and it will make no difference whether he holds it as trustee for the benefit

of another or not. *Little* v. *Gould*, 2 Blatchf., 366.—NELSON, J.; N. Y., 1852.

3. Under this act no person can obtain a copyright except authors who are citizens or residents of the United States, and proprietors under derivations of title from such authors. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

4. The assignee of a work composed by a *non-resident alien* cannot obtain a copyright for it. *Ibid.*, 45.

5. To constitute one an author, he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846.

6. One who gets others to compile a work or engrave a print is not entitled to a copyright. *Pierpont* v. *Fowle*, 2 Wood. & Min., 46.—WOODBURY, J.; Mass., 1846. *Atwill* v. *Ferrett*, 2 Blatchf., 46.—BETTS, J.; N. Y., 1846. *De Witt* v. *Brooks*, MS.—NELSON, J.; N. Y., 1861.

7. A book, within the statute, need not be a volume made up of many sheets bound together; it may be a single sheet, as the words of a song, or the music accompanying it. *Clayton* v. *Stone*, 2 Paine, 383, 391.—THOMPSON, J.; N. Y., 1828.

8. A newspaper or price current cannot be considered a book within the sense and meaning of the act of Congress. *Ibid.*, 385.

9. A label used in the sale of any article is not a book, within the provisions of the statute respecting copyrights. *Coffeen* v. *Brunton*, 4 McLean, 517.—MCLEAN, J.; Ind., 1849.

10. The natural objects from which maps and charts are made are open to all, and therefore a copyright cannot subsist in a chart, as a general subject, but may in an individual work, and others may be restrained from copying it. *Blunt* v. *Patten*, 2 Paine, 400, 401.—THOMPSON, J.; N. Y., 1828.

11. A man has a right to a copyright of a map of a State or country which he has surveyed, or caused to be compiled from existing materials, at his own expense, or skill, or labor, or money. *Emerson* v. *Davies*, 3 Story, 781.—STORY, J.; Mass., 1845.

12. Another may publish another map of the same State or country, but cannot take it substantially and designedly from the map of the other person, without any such exercise of skill, labor, or expense. *Ibid.*, 781.

13. The author or compiler of a musical composition, made up of different parts copied from older compositions, without material change, and put together into one tune with only slight alterations or additions, is not entitled to a copyright for such therefor. *Reed* v. *Carusi*, 8 Law Rep., 411.—TANEY, Ch. J.; Md., 1845.

14. But the circumstances of its corresponding with older musical compositions, and belonging to the same style of music, does not constitute it a plagiarism, provided it is, in its main design and in its material and important parts, the effort of his own mind. *Ibid.*, 411.

15. A musical composition, to be the subject of a copyright, must be substantially a new and original work, and not a copy of a piece already produced, with additions and variations, which a writer of music with experience and skill could readily make. *Jollie* v. *Jaques*, 1 Blatchf., 626.—NELSON, J.; N. Y., 1850.

16. The phrase *design*, when used as a term of art, means the giving of a visible form to the conceptions of the mind; or, in other words, to the invention. *Binns* v. *Woodruff*, 4 Wash., 52.—WASHINGTON, J.; Pa., 1821.

17. A reporter cannot have any copyright in the written opinions of the judges of a court; nor can the judges confer any such right on the reporter. *Wheaton* v. *Peters*, 8 Pet., 668.—MCLEAN, J.; Sup. Ct., 1834. *Little* v. *Gould*, 2 Blatchf., 170.—CONKLING, J.; N. Y., 1851.

18. Such decisions are the property of the public, and are not the subject of copyright. *Little* v. *Gould*, 2 Blatchf., 362.—NELSON, J.; N. Y., 1852.

19. But a reporter may have a copyright in his own marginal notes, and in the arguments of counsel, as arranged and prepared by him. *Gray* v. *Russell*, 1 Story, 21.—STORY, J.; Mass., 1839.

20. A work may be the subject of a copyright, if the plan, arrangement, and combination of its materials are new, though the materials may be drawn from many sources, but are for the first time brought together in such plan, arrangement, and combination. *Gray* v. *Russell*, 1 Story, 17.—STORY, J.; Mass., 1839. *Emerson* v. *Davies*, 3 Story, 778. STORY, J.; Mass., 1845.

21. But there can be no copyright of a plan distinct from the work itself, any more than there can be of an idea. The words in which an idea is expressed, are a subject of property; and so is the classification of the subject discussed. *Story's Exrs.* v. *Holcombe*, 4 McLean, 316.—MCLEAN, J.; Ohio, 1847.

See also DIGEST PAT. CASES, titles AUTHOR; COPYRIGHT, B., C.; ABRIDGMENT; CHARTS; COMPILATIONS; DICTIONARIES; REVIEWS; TRANSLATION.

(*b*) COPYRIGHT, WHAT IS.

1. The privilege of an author to an exclusive sale of his works, for a limited number of years, although a monopoly, is not so in the odious meaning of the term; but is but a proper reward for his labor, and to which he is as much entitled as to the exclusive enjoyment of any other kind of property. *Blunt* v. *Patten*, 2 Paine, 395.—THOMPSON, J.; N. Y., 1828.

2. Copyright is an exclusive right to the multiplication of copies, for the benefit of the author or his assigns, disconnected from the plate, or any other physical existence. *Stephens* v. *Cady*, 14 How., 330.—NELSON, J.; Sup. Ct., 1852.

3. Before publication, an author has the exclusive possession of the ideas contained in his book, and the combination of words to represent

them. But when he has published his book, and given his thoughts, sentiments, knowledge, or information to the world, he can have no longer an exclusive possession in them. *Stowe* v. *Thomas*, 5 Amer. Law Reg., 228.—GRIER, J.; Pa., 1853.

4. When an author has sold his work, the only property which he reserves to himself, or which the law gives to him, is the exclusive right to multiply the copies of that particular combination of character which exhibits to the eyes of another the ideas intended to be conveyed. This is what the law terms copy, or copyright. *Ibid.*, 228.

5. An author's exclusive property in a literary composition, or copyright, consists only in a right to multiply copies of his book, and enjoy the profits therefrom, and not in an exclusive right to his conceptions. *Ibid.*, 228.

6. The case of *Millar* v. *Taylor*, 4 Burr, 311, has finally settled the question as to the nature of the property which an author has in his works; and it is, that, after publication, his property consists in the "right of copy," which signifies "the sole right of printing, publishing, and selling his literary composition or book;" not that he has such a property in his original conceptions, that he alone can use them in the composition of a new work, or clothe them in a different dress by translation. *Ibid.*, 230.

See also DIGEST PAT. CASES, title COPYRIGHT, A.

(*c*) FOUNDATION OF COPYRIGHT.

1. Congress, in passing the copyright act, did not legislate in reference to existing rights. Instead of sanctioning an existing right, it created it. *Whcaton* v. *Peters*, 8 Pet., 661.—MCLEAN, J.; Sup. Ct., 1834.

2. In the United States an author can have no exclusive property or copyright in his published production except under the laws of Congress. *Ibid.*, 662.

3. The author of a literary composition has, at common law, no exclusive right to print and publish it. *Dudley* v. *Mayhew*, 3 Coms., 12. —STRONG, J.; N. Y., 1849.

4. Copyright, though formerly considered to be founded on common law, can now only be viewed as part of the statute law. *Clayton* v. *Stone*, 2 Paine, 383.—THOMPSON, J.; N. Y., 1828.

5. The object of the acts of Congress, securing to authors the exclusive right to their writings, was the promotion of science. *Ibid.*, 392.

See also DIGEST PAT. CASES, title COPYRIGHT, A.

SECTION 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more

than one person, be still living, and a citizen or citizens of the United States, or resident therein, or, being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required, in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term.

1. The extension under this act looks entirely to the author and his family, and not to assignees. *Pierpont* v. *Fowle*, 2 Wood. & Min., 42.—WOODBURY, J.; Mass., 1846.

2. An assignment of a "copyright" should not, by construction, be extended beyond the first term, unless it seems to be actually meant by the author to be transferred forever, and including any future contingency. *Ibid.*, 44.

3. But where it is clear that the author intended to transfer all his interest in the copyright, as well in the extended as in the original term, and the assignment is not, in its terms, broad enough to cover the second term, a court of equity will direct the contract to be reformed, so as to embrace all the interest. *Cowen* v. *Banks*, MS.—NELSON, J.; N. Y., 1862.

4. An assignee alone cannot take out the second or extended term, unless he has paid for it, clearly contracted for it, and, in equity, rather than by any technical law, is to be protected in it. *Pierpont* v. *Fowle*, 2 Wood. & Min., 44.—WOODBURY, J.; Mass., 1846.

5. The taking out a second term of a copyright is not like the strengthening of a defective title, but rather like a new interest obtained after the general interest had expired. *Ibid.*, 46.

See also DIGEST PAT. CASES; title COPYRIGHT, E.

SECTION 3. *And be it further enacted*, That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be pub-

lished in one or more of the newspapers printed in the United States, for the space of four weeks.

SECTION 4. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall, before publication, deposit a printed copy of the title of such book, or books, map, chart, musical composition, print, cut, or engraving, in the clerk's office of the District Court of the district wherein the author or proprietor shall reside, and the clerk of such court is hereby directed and required to record the same thereof forthwith, in a book to be kept for that purpose, in the words following (giving a copy of the title, under the seal of the court, to the said author or proprietor, whenever he shall require the same): "District of to wit: Be it remembered, that on the day of Anno Domini, A. B., of the said district, hath deposited in this office the title of a book (map, chart, or otherwise, as the case may be), the title of which is in the words following, to wit: (here insert the title); the right whereof he claims as author, (or proprietor, as the case may be,) in conformity with an act of Congress, entitled 'An act to amend the several acts respecting copyrights.' C. D., Clerk of the district." For which record the clerk shall be entitled to receive, from the person claiming such right, as aforesaid, fifty cents, and the like sum for every copy under seal, actually given to such person or his assigns. And the author or proprietor of any such book, map, chart, musical composition, print, cut, or engraving, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, a copy of the same to the clerk of said district. And it shall be the

duty of the clerk of each District Court, at least once in every year, to transmit a certified list of all such records of copyright, including the titles so recorded, and the dates of record, and also all the several copies of books or other works deposited in his office according to this act, to the Secretary of State, to be preserved in his office. (*a*)

SECTION 5. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall give information of copyright being secured, by causing to be inserted in the several copies of each and every edition published during the term secured on the title-page, or the page immediately following, if it be a book, or, if a map, chart, musical composition, print, cut, or engraving, by causing to be impressed on the face thereof, or if a volume of maps, charts, music, or engravings, upon the title or frontispiece thereof, the following words, viz.: "Entered according to act of Congress, in the year , by A. B., in the clerk's office of the District Court of ," (as the case may be.) (*a*)

(*a*) NOTES TO §§ 4 AND 5.

1. The act of 1831 embodies the provisions of the acts of 1790 and 1802, and imposes on the persons claiming the privilege of copyright the same duties and liabilities which attended the right under the prior statutes. *Baker* v. *Taylor*, 2 Blatchf., 83.—BETTS, J.; N. Y., 1848.

2. Under sections 4 and 5 of this act, the depositing the title-page in the proper clerk's office, publishing a notice according to the act, and delivering a copy of the book, are conditions, the performance of which is essential to the title. *Ibid.*, 84.

3. And the notice must be published in the manner specified in the act. *Ibid.*, 84.

4. All the things required by these sections must be done to secure a copyright. *Jollie* v. *Jaques*, 1 Blatchf., 620.—NELSON, J.; N. Y., 1850. *Struve* v. *Schwedler*, 4 Blatchf.—NELSON, J.; N. Y., 1857.

5. Until all the things required by these sections are done, the copyright is not secured; but by taking the incipient step, a right is ac-

quired which chancery will protect, until the other acts may be done. *Pulte* v. *Derby*, 5 McLean, 332.—McLean, J.; Ohio, 1852.

6. Where a work consists of a number of volumes, the insertion of the record on the page next following the title-page of the *first volume* of the work is a sufficient compliance with the statute. *Dwight* v. *Appletons*, 1 N. Y. Leg. Obs., 198.—Thompson, J.; N. Y., 1843.

7. The author may insert the same record in another edition, published in a different number of volumes, without impairing the copyright. *Ibid.*, 199.

8. The number of volumes in which it was stated the work would be published, make no part of its title, and may be rejected as surplusage. *Ibid.*, 199.

9. After such title-page has been deposited, the author can maintain an action for an infringement or violation of his right, even though the work may not have been published, or the printed copy deposited. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 398.—Sprague, J.; Mass., 1860. Contra, *Keene* v. *Wheatley*, 1 Amer. Law Reg., 44.—Cadwallader, J.; Pa., 1860.

10. The record from the clerk's office, made in the form prescribed by section 4, or of the depositing of a title-page, is *prima facie* evidence that a printed title was deposited. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 398.—Sprague, J.; Mass., 1860.

11. Where the title-page of a book was deposited in 1846, and the notice of the entry, inserted in the book, stated it to have been deposited in 1847, *Held*, that the error created a fatal defect in the plaintiff's title. *Baker* v. *Taylor*, 2 Blatchf., 84.—Betts, J.; N. Y., 1848.

12. Even if the error arose from mistake, it will make no difference as to the result. *Ibid.*, 84.

13. Under section 4 a person is not entitled to any benefit, under the act, unless he deposits the title-page *before* the publication of his work. *Ibid.*, 85.

14. Where copies of a book were sold prior to the date of the deposit of a copy of the title-page, and a printed copy of the book was deposited in the clerk's office, at the same time the title-page was deposited, *Held*, that these facts warranted an inference of an actual publication of the book prior to the date of such deposit. *Ibid.*, 85.

See also Digest Pat. Cases, title Copyright, D.; and notes to section 3 of the act of 1790, and to section 1 of the act of 1802.

Section 6. *And be it further enacted*, That if any other person or persons, from and after the recording the title of any book or books, according to this act, shall, within the term or terms herein limited, print (*a*), publish, or import, or cause to be printed, published, or

imported, any copy of such book or books (*b*), without the consent of the person legally entitled to the copyright thereof, first had and obtained in writing, signed in presence of two or more credible witnesses, or shall, knowing the same to be so printed or imported, publish, sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such book without such consent in writing; then such offender shall forfeit every copy of such book to the person legally, at the time, entitled to the copyright thereof; and shall also forfeit and pay fifty cents for every such sheet which may be found in his possession, either printed, or printing, published, imported, or exposed to sale, contrary to the intent of this act, the one moiety thereof to such legal owner of the copyright as aforesaid, and the other to the use of the United States, to be recovered by action of debt in any court having competent jurisdiction thereof. (*c*)

(*a*) 1. The intent with which a work is reprinted cannot be taken into consideration; it is the act of reprinting that is prohibited by the statute. *Nichols* v. *Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808. *Story's Ex'rs* v. *Holcombe*, 4 McLean, 309, 310.—MCLEAN, J.; Ohio, 1847.

2. It is of no consequence in what form the works of another are used, whether it be a simple reprint or by incorporating it in some other work. If his copyright is violated, he can maintain an action therefor. *Gray* v. *Russell*, 1 Story, 19.—STORY, J.; Mass., 1839.

3. To entitle a party to an action for the infringement of a copyright, it is not necessary that the whole or a greater part of his work should be taken. If so much is taken as to impair the value of the original, or so that the labors of the original author are substantially appropriated, that is sufficient in point of law to constitute a piracy. *Folsom* v. *Marsh*, 2 Story, 115.—STORY, J.; Mass., 1841.

4. The entirety of the copyright is the property of the author; and it is no defence that another has appropriated only a part of such property and not the whole. *Ibid.*, 116.

5. Nor does it necessarily depend upon the quantity taken, whether it is an infringement of a copyright or not. *Ibid.*, 116. *Story's Ex'rs* v. *Holcombe*, 4 McLean, 309, 310.—MCLEAN, J.; Ohio, 1847.

6. Intention cannot be taken into account in reference to an infringement. If a copyright has been invaded, whether the party knew the work was copyrighted or not, he is liable to the penalty for violation. *Millett* v. *Snowden*, 1 West. L. Jour., 240.—BETTS, J.; N. Y., 1843.

(*b*) 1. A book may in one part of it infringe the copyright of another work, and in other parts be no infringement; in such a case, the remedy will not be extended beyond the injury. *Story's Exrs.* v. *Holcombe*, 4 McLean, 315—.MCLEAN, J., Ohio, 1847.

2. A book, within the meaning of the statute, does not include a translation of a work. *Stowe* v. *Thomas*, 2 Amer. Law Reg., 230.—GRIER, J.; Pa., 1853.

3. A translation may be called a transcript or copy of the author's thought or conception, but in no correct sense can it be called a *copy* of his book. *Ibid.*, 231.

See also DIGEST PAT. CASES, title INFRINGEMENT, A.

(*c*) 1. An *action on the case* is the proper form of action to recover damages for a violation of a copyright; *trespass* will not lie. *Atwill* v. *Ferrett*, 2 Blatchf., 48.—BETTS, J.; N. Y., 1846.

2. The penalty of fifty cents per sheet imposed by this section is incurred for every sheet found to have been in the defendants' possession, or which they had sold, or held for sale. *Dwight* v. *Appletons*, 1 N. Y. Leg. Obs., 198.—THOMPSON, J.; N. Y., 1843.

3. The penalty declared by this section can be adjudged only for the sheets found in the possession of the defendant. *Backus* v. *Gould*, 7 How., 811.—MCLEAN, J.; Sup. Ct., 1848.

4. The penalty imposed by this section is not incurred by printing and publishing so much of a book as to amount to an infringement of the copyright. *Rogers* v. *Jewett*, 12 Mo. Law Rep., 340.—CURTIS, J.; Mass., 1858.

5. The words "a copy of a book," found in section 6 of the act of 1831, import a transcript or copy of the entire book. *Ibid.*, 341.

6. Congress did not intend to inflict these penalties upon the unlawful printing or publication of less than an entire work. *Ibid.*, 341.

SECTION 7. *And be it further enacted*, That if any person or persons, after the recording of the title of any print, cut, or engraving, map, chart (*a*), or musical composition, according to the provisions of this act, shall, within the term or terms limited by this act, engrave, etch, or work, sell, or copy, or caused to be engraved, etched, worked, or sold, or copied, either on the whole, or by varying, adding to, or diminishing the main design, with intent to evade the law; or shall print or import

for sale, or cause to be printed or imported for sale, any such map, chart, musical composition, print, cut, or engraving, or any parts thereof, without the consent of the proprietor or proprietors of the copyright thereof, first obtained in writing, signed in the presence of two credible witnesses; or knowing the same to be printed or imported without such consent, shall publish, sell, or expose to sale, or in any manner dispose of any such map, chart, musical composition, engraving, cut, or print without such consent, as aforesaid; then such offender or offenders shall forfeit the plate or plates on which such map, chart, musical composition, engraving, cut, or print, shall be copied, and also all and every sheet thereof so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof; and shall further forfeit one dollar for every sheet of such map, chart, musical composition, print, cut, or engraving, which may be found in his or their possession, printed or published, or exposed to sale, contrary to the true intent and meaning of this act; the one moiety thereof to the proprietor or proprietors, and the other moiety to the use of the United States, to be recovered in any court having competent jurisdiction thereof. (*b*)

(*a*) 1. Though a party cannot have a copyright in the original elements or materials of his chart, he has a right to the result of his labors and surveys in making it. Another party may resort to the original materials of the chart, and survey for himself, but he cannot avail himself, either in whole or in part, of the surveys of the former. *Blunt* v. *Patten*, 2 Paine, 395, 396.—THOMPSON, J.; N. Y., 1828.

2. The natural objects from which charts are made, being, however, open to all, a copyright cannot subsist in a chart, as a general subject, but it may in an individual work, and others may be restrained from copying such work. *Ibid.*, 400, 401.

3. But a right in such a subject is violated only when another copies from the chart of him who has secured the copyright, and thereby availed himself of his labor and skill. *Ibid.*, 402.

4. In all such cases, it is a proper question for a jury, whether the one is a copy of the other or not; if there was some small variance, it would be a proper subject of inquiry whether the alteration was not merely colorable. *Ibid.*, 402.

5. But a subsequent compiler has a right to avail himself of all prior publications which are not copyrighted, and if his chart is compiled from such publications, it is no infringement, although it may agree with another's chart. *Ibid.*, 403.

6. One person may publish a map of the same State or country for which another has a copyright, by using the like means or materials, and the like skill, labor, and expense, in its preparation. But he has no right to publish a map, taken substantially and designedly from the map of such other person, without any such exercise of skill, labor, or expense. *Emerson* v. *Davies*, 3 Story, 781.—STORY, J.; Mass., 1845.

See also DIGEST PAT. CASES, title CHARTS.

(*b*) 1. The penalty for an infringement is, under this section, fixed by law. If the jury find there has been an infringement, they must ascertain the number of sheets proved to have been sold, or offered for sale (not the number printed), and return a verdict for one dollar for each sheet so sold, or offered to be sold. *Millett* v. *Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

2. A defendant is not liable to the penalty imposed by this section, unless he was guilty of the infraction of the copyright within two years before action was brought. *Reed* v. *Carusi*, 8 Law Rep., 412.—TANEY, Ch. J.; Md., 1845.

3. The engraving or preparation of plates, where the work is printed from plates, may have been more than two years, but every printing for sale would be a new infraction of the right, and, if such printing was within two years before suit brought, the defendant is liable. *Ibid.*, 412.

4. The penalty is at the rate of one dollar for each sheet the defendant may have caused to be printed for sale, within two years before suit brought. *Ibid.*, 412.

See also DIGEST PAT. CASES, title PENALTIES, A.

SECTION 8. *And be it further enacted*, That nothing in this act shall be construed to extend to prohibit the importation, or vending, printing, or publishing of any map, chart, book, musical composition, print, or engraving, written, composed, or made by any person not being a citizen of the United States, nor resident within the jurisdiction thereof.

SECTION 9. *And be it further enacted*, That any per-

son or persons who shall print or publish any manuscript whatever without the consent of the author or legal proprietor first obtained as aforesaid, (if such author or proprietor be a citizen of the United States, or resident therein), shall be liable to suffer and pay to the author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof; and the several courts of the United States empowered to grant injunctions to prevent the violation of the rights of authors and inventors, are hereby empowered to grant injunctions, in like manner, according to the principles of equity, to restrain such publication of any manuscript as aforesaid.

1. An author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavors to realize a profit by its publication. *Wheaton* v. *Peters*, 8 Pet., 657.—McLean, J.; Sup. Ct., 1834.

2. Notwithstanding the copyright by statute, there remains in an author a common law title to his works before publication. *Jones* v *Thorne*, 1 N. Y. Leg. Obs., 409.—McCoun, V. Ch.; N. Y., 1843.

3. At common law, independently of the statute, the author of a manuscript might obtain redress against one who had surreptitiously gained possession of it. *Bartlette* v. *Crittenden*, 4 McLean, 301.—McLean, J.; Ohio, 1847.

4. On general equitable principles, relief may also be given, under like circumstances, by a court of chancery. *Ibid.*, 301.

5. The use, by an author, of his manuscript for the purpose of instruction, is not an abandonment of it to the public. Nor is it an abandonment, to allow his pupils to take copies. *Ibid.*, 303.

6. Those also who have been permitted to take copies, have no right to a use which was not in contemplation when the consent to take copies was given. *Ibid.*, 303.

7. An author has a common law right in his manuscript until he relinquishes it by contract or some equivocal act. *Bartlette* v. *Crittenden*, 5 McLean, 36, 38.—McLean, J.; Ohio, 1849.

8. Such right is also protected by section 9 of the copyright act of 1831. *Ibid.*, 38.

9. A surreptitious publication of an important part of a manuscript

is equally within the statute as if the manuscript was complete; and the whole of a manuscript need not be printed. *Ibid.*, 39, 40.

10. This section protects manuscripts only. *Stephens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

11. At common law an author has a right to his unpublished manuscripts the same as to any other property he may possess; and this act of the 3d of February, 1831, gives him a remedy by injunction to protect this right. *Little* v. *Hall*, 18 How., 170.—MCLEAN, J.; Sup. Ct., 1855.

12. The common law right of an author in his manuscript has not been taken away or abridged by the statutes which have been passed for the protection of copyright. Its existence is prior to these statutes, and independent of their provisions. *Woolsey* v. *Judd*, 4 Duer, 385.—DUER, J.; N. Y., 1855.

13. The act of 1831, section 9, giving redress for the unauthorized *printing or publishing* of *manuscripts*, operates in favor of a resident of the United States who has acquired the proprietorship of an *unprinted* literary composition from a non-resident alien author. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 45.—CADWALLADER, J.; Pa., 1860.

14. But this section—and which is the only one—enabling a proprietor, who derives his title from such an author, to assert any right under the act—gives no redress for an unauthorized theatrical representation. *Ibid.*, 45.

See also DIGEST PAT. CASES, titles LETTERS; MANUSCRIPTS.

SECTION 10. *And be it further enacted*, That, if any person or persons shall be sued or prosecuted, for any matter, act, or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.

SECTION 11. *And be it further enacted*, That, if any person or persons, from and after the passing of this act, shall print or publish any book, map, chart, musical composition, print, cut, or engraving, not having legally acquired the copyright thereof, and shall insert or impress that the same hath been entered according to act of Congress, or words purporting the same, every person so offending shall forfeit and pay one hundred dollars: one moiety thereof to the person who shall sue for the same, and the other to the use of the United States, to be re-

covered by action of debt, in any court of record having cognizance thereof.

1. The penalty imposed by this section, and given "to the *person* who shall sue for the same," cannot be recovered in the name of more than one person. *Ferrett* v. *Atwill*, 1 Blatchf., 154, 155.—BETTS, J.; N. Y., 1846.

2. A declaration for such penalty in the name of *two* persons is bad, on general demurrer. *Ibid.*, 154.

3. There is a manifest difference between giving a penalty to a common informer, and imposing one for the benefit of the person aggrieved: in the latter case, the term person may be regarded as comprehending every one affected by the injury. *Ibid.*, 156.

See also DIGEST PAT. CASES, title PENALTIES, A.

SECTION 12. *And be it further enacted*, That, in all recoveries under this act, either for damages, forfeitures, or penalties, full costs shall be allowed thereon, any thing in any former act to the contrary notwithstanding.

SECTION 13. *And be it further enacted*, That no action or prosecution shall be maintained, in any case of forfeiture or penalty under this act, unless the same shall have been commenced within two years after the cause of action shall have arisen.

SECTION 14. *And be it further enacted*, That the "act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies during the times therein mentioned," passed May thirty-first, one thousand seven hundred and ninety, and the act supplementary thereto, passed April twenty-ninth, one thousand eight hundred and two, shall be, and the same are hereby, repealed: saving, always, such rights as may have been obtained in conformity to their provisions.

SECTION 15. *And be it further enacted*, That all and several the provisions of this act, intended for the protec-

tion and security of copyrights, and providing remedies, penalties, and forfeitures, in cases of violation thereof, shall be held and construed to extend to the benefit of the legal proprietor or proprietors of each and every copyright heretofore obtained, according to law, during the term thereof, in the same manner as if such copyright had been entered and secured according to the directions of this act.

SECTION 16. *And be it further enacted*, That whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut, or engraving, or by a proprietor of the same: if such author or authors, or either of them, such inventor, designer, or engraver, be living at the passage of this act, then such author or authors, or the survivor of them, such inventor, engraver, or designer, shall continue to have the same exclusive right to his book, chart, map, print, cut, or engraving, with the benefit of each and all the provisions of this act, for the security thereof, for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. And if such author or authors, inventor, designer, or engraver, shall not be living at the passage of this act, then his or their heirs, executors and administrators, shall be entitled to the like exclusive enjoyment of said copyright, with the benefit of each and all the provisions of this act for the security thereof, for the period of twenty-eight years

from the first entry of said copyright, with the like privilege of renewal to the widow, child, or children, of author or authors, designer, inventor, or engraver, as is provided in relation to copyrights originally secured under this act: *Provided*, That this act shall not extend to any copyright heretofore secured, the term of which has already expired.

Approved February 3d, 1831.

ACT OF 1834, CHAPTER 157.

4 STATUTES AT LARGE, 728.

[*This Act still in Force.*]

An Act supplementary to the act to amend the several acts respecting copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all deeds or instruments in writing for the transfer or assignment of copyrights, being proved or acknowledged in such manner as deeds for the conveyance of land are required by law to be proved or acknowledged in the same State or district, shall and may be recorded in the office where the original copyright is deposited and recorded; and every such deed or instrument that shall in any time hereafter be made and executed, and which shall not be proved or acknowledged and recorded as aforesaid, within sixty days after its execution, shall be judged fraudulent and void against any subsequent purchaser or mortgagee for valuable consideration without notice.

1. An assignment of an interest in a copyright must be in writing, to be valid and operative; but an *agreement* to assign may be by parol. *Gould* v. *Banks*, 8 Wend., 565.—NELSON, J.; N. Y., 1832.

2. An assignment of a "copyright" in general terms is to be referred to what was then in existence, and not to any future contingency. It should not be by construction extended beyond the first term, unless it seems to be so actually meant by the author, and to include a future contingency. *Pierpont* v. *Fowle*, 2 Wood. & Min., 43–45.—WOODBURY, J.; Mass., 1846.

3. Otherwise, if the contract of sale or assignment uses language looking beyond the existing copyright, such as referring to all the *interest* in the matter, or to the *manuscript* or book itself, or using some other expression more comprehensive than the word "copyright." *Ibid.*, 45.

4. This statute prescribes only the instrument by which they may be assigned, and the mode of recording, but does not define what interest may be assigned. *Roberts* v. *Myers*, 13 Mo. Law Rep., 401.—SPRAGUE, J.; Mass., 1860.

5. There is no sufficient reason for preventing an author conveying a distinct portion of his right. *Ibid.*, 401.

6. Where an assignment was of the exclusive right of acting and representing a certain drama, within the United States except as to certain cities, for the term of one year, *Held*, that it was valid under the statute. *Ibid.*, 400, 401.

7. CONTRA.—The statutes of the United States for the protection of authors do not, like those for the benefit of inventors, sanction transfers of limited local proprietorships of exclusive privileges. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 46.—CADWALLADER, J.; Pa., 1860.

8. A writing which is in form a transfer by an author of his exclusive right for a designated portion of the United States operates *at law* only as a mere *license*, and is ineffectual as an assignment. *Ibid.*, 46.

9. But in *equity*, a limited local or other partial assignment, if made for a valuable consideration, is carried into effect, whether it would be effectual in law or not. *Ibid.*, 47.

10. An assignment of a copyright, although not recorded, is still valid as between the parties, and as to all persons not claiming under the assignors. *Webb* v. *Powers*, 2 Wood. & Min., 510.—WOODBURY, J.; Mass., 1847.

11. A formal transfer of a copyright by this act is required to be proved and recorded as deeds for the conveyance of land, and such record operates as notice. *Little* v. *Hall*, 18 How., 171.—MCLEAN, J.; Sup. Ct., 1855.

SECTION 2. *And be it further enacted*, That the clerk of the district court shall be entitled to such fees, for per-

forming the services herein authorized and required, as he is entitled to for performing like services under existing laws of the United States.

Approved June 30th, 1834.

ACT OF 1846, CHAPTER 178.

9 STATUTES AT LARGE, 106.

[*Obsolete: Repealed by Act of* 1859, § 6.]

Extract from an Act to establish the "Smithsonian Institution, for the Increase and Diffusion of Knowledge among Men."

SECTION 10. *And be it further enacted*, That the author or proprietor of any book, map, chart, musical composition, print, cut, or engraving, for which a copyright shall be secured under the existing acts of Congress, or those which shall hereafter be enacted respecting copyrights, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver, or cause to be delivered, one copy of the same to the librarian of the Smithsonian Institution, and one copy to the librarian of Congress Library, for the use of the said libraries.

Approved August 10, 1846.

1. This act did not make the delivery of copies of a work to the librarian of the Smithsonian Institution, and to the librarian of the Congress Library, a pre-requisite to a title to a copyright for the work. *Jollie* v. *Jaques*, 1 Blatchf., 620–622.—NELSON, J.; N. Y., 1850.

2. The duty was enjoined only upon those who have already acquired the right, and no forfeiture was declared in case of a non-compliance. *Ibid.*, 621.

ACT OF 1856, CHAPTER 169.

11 STATUTES AT LARGE, 138.

[*This Act still in Force.*]

An Act supplemental to an act entitled "An act to amend the several acts respecting copyright," approved February third, eighteen hundred and thirty-one.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled: Any copyright hereafter granted under the laws of the United States to the author or proprietor of any dramatic composition, designed or suited for public representation, shall be deemed and taken to confer upon the said author or proprietor, his heirs or assigns, along with the sole right to print and publish the said composition, the sole right also to act, perform or represent the same, or cause it to be acted, performed or represented, on any stage or public place, during the whole period for which the copyright is obtained; and any manager, actor, or other person acting, performing or representing the said composition, without or against the consent of the said author or proprietor, his heirs or assigns, shall be liable for damages, to be sued for and recovered by action on the case or other equivalent remedy, with costs of suit in any court of the United States, such damages in all cases to be rated and assessed at such sum not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court having cognizance thereof shall appear to be just:

Provided nevertheless, That nothing herein enacted shall impair any right to act, perform or represent a dramatic composition as aforesaid, which right may have been acquired, or shall in future be acquired by any manager, actor or other person previous to the securing of the copyright for the said composition, or to restrict in any way the right of such author to process in equity in any court of the United States for the better and further enforcement of his rights.

Approved August 18th, 1856.

1. The act of 1856 was passed to give to the authors of dramatic compositions the exclusive right of acting and representing, which they did not enjoy under the previous statutes. *Roberts* v. *Meyers*, 13 Mo. Law Rep., 397.—SPRAGUE, J.; Mass., 1860.

2. It assumes the doctrine that representation is not publication. The prior acts secured to authors the exclusive right of printing and publication; and it was only because publication did not embrace acting or representation that this act was passed, superadding that exclusive right to those previously enjoyed. *Ibid.*, 397.

3. The previous acting or representing a play will not deprive the author of the right to afterward take out a copyright. *Ibid.*, 397.

4. An assignee of the exclusive right of acting and representing a drama in certain places, may maintain an action in his own name, even after a representation by him, for an injunction to prevent its being represented by another within such places. *Ibid.*, 400, 401.

5. And such action may be maintained although the author or assignee has only filed his title-page, and has not published the work or play. *Ibid.*, 401. (CONTRA, *post*, 8.)

6. A legislative enactment securing generally to literary proprietors a copyright for a limited period, but containing no special provision as to theatrical representation, does not, in the case of a dramatic literary composition, include the sole right of representing it. *Keene* v. *Wheatley*, 9 Amer. Law Reg., 44.—CADWALLADER, J.; Pa., 1860.

7. The only act which affords redress for unauthorized theatrical representations is the act of 18th August, 1856; but this only applies to cases in which copyright is effectually secured under the act of 1831. *Ibid.*, 45.

8. But under this act, an assignee of a dramatic composition cannot maintain an action for its unauthorized representation by others, unless he has performed *all* the acts required by law to secure a copyright, including the deposit of a *printed* copy. *Ibid.*, 45, 46.

ACT OF 1859, CHAPTER 22.

11 STATUTES AT LARGE, 380.

[*This Act still in Force.*]

Extract from an Act entitled, "An act for keeping and distributing all public documents."

SECTION 6. [Repealing act of 1846, § 10.] *And be it further enacted*, That the tenth section of an act entitled, "An act to establish the Smithsonian Institution for the increase and diffusion of knowledge among men," approved August 10th, 1846, is hereby repealed.

SECTION 8. *And be it further enacted*, That all books, maps, charts, and other publications of every nature whatever, heretofore deposited in the Department of State, according to the laws regulating copyrights, together with all the records of the Department of State, in regard to the same, shall be removed to, and be under the control of the Department of the Interior, which is hereby charged with all the duties connected with the same, and with all matters pertaining to copyright, in the same manner and to the same extent that the Department of State is now charged with the same; and hereafter all such publications of every nature whatever shall, under present laws and regulations, be left with and kept by him.

Approved February 5th, 1859.

ACT OF 1861, CHAPTER 37.

12 STATUTES AT LARGE, 130.

[*This Act still in Force.*]

An Act to extend the right of appeal from the decisions of circuit courts to the Supreme Court of the United States.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That from all judgments and decrees of any circuit court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.

Approved February 18th, 1861.

ACT OF 1865, CHAPTER 126.

13 STATUTES AT LARGE, 540.

[*This Act still in Force.*]

An Act supplemental to an act entitled "An act to amend the several acts respecting copyright," approved February 3d, 1831, and to the acts in addition thereto and amendment thereof.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the provisions of said acts shall extend to and include photographs and negatives thereof which shall hereafter be made, and shall inure to the benefit of the authors of the same, in the same manner and to the same extent, and upon the same conditions, as to the authors of prints and engravings.

SECTION 2. *And be it further enacted*, That a printed copy of every book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall be secured under said acts, shall be transmitted free of postage or other expense, by the author or proprietor thereof, within one month of the date of publication, to the Library of Congress, at Washington, for the use of said library, and the Librarian of Congress is hereby required to give a receipt in writing for the same.

SECTION 3. *And be it further enacted*, That if any proprietor of a book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall be secured as aforesaid, shall neglect to deliver the same, pursuant to the requirements of this act, it shall be the duty of the Librarian of Congress to make demand thereof in writing at any time within twelve months after the publication thereof; and in default of a delivery thereof within one month after the demand shall have been made, the right of exclusive publication secured to such proprietor under the acts of Congress respecting copyright shall be forfeited.

SECTION 4. *And be it further enacted*, That in the construction of this act the word "book" shall be construed to mean every volume and part of a volume,

together with all maps, prints, or other engravings belonging thereto; and shall include a copy of any second or subsequent edition which shall be published with any additions, whether the first edition of such book shall have been published before or after the passing of this act: *Provided, however*, That it shall not be requisite to deliver to the said library any copy of the second or any subsequent edition of any book, unless the same shall contain additions as aforesaid, nor of any book which is not the subject of copyright.

Approved March 3d, 1865.

ACT OF 1867, CHAPTER 43.

14 STATUTES AT LARGE, 395.

[*This Act still in Force.*]

An Act amendatory of the several acts respecting copyrights.

SECTION 1. [Amending Act of 1865, § 3.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That every proprietor of a book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which a copyright shall have been secured, who shall fail to deliver to the Library of Congress at Washington a printed copy of every such book, pamphlet, map, chart, musical composition, print, engraving, or photograph, within one month after publication thereof, shall, for every such default, be subject to a penalty of twenty-five dollars, to be collected, by the Librarian of Congress, in the name of the United States, in any District or Circuit Court of the United States, within the jurisdiction of which the delinquent may reside or be found.

SECTION 2. *And be it further enacted*, That every such proprietor may transmit any book, pamphlet, map, chart, musical composition, print, engraving, or photograph, for which he may have secured a copyright, to the Librarian of Congress, by mail free of postage, provided the words "copyright matter" be plainly written or printed on the outside of the package containing the same; and it shall be the duty of the several postmasters and deputy postmasters to give a receipt for the same, if requested, and when such package shall be delivered to them, or any of them, to see that the same is safely forwarded to its destination by mail, without cost or charge to said proprietor.

Approved, February 18, 1867.

FORMS

UNDER THE COPYRIGHT ACTS.

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1. AGREEMENT TO SELL MANUSCRIPT AND COPYRIGHT OF BOOK.
2. AGREEMENT TO ENLARGE A SECOND EDITION OF A BOOK.
3. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.
4. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.
5. LICENSE TO PRINT ONE EDITION OF A BOOK.
6. ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION FOR SPECIFIED TIME AND PLACES.

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1. AGREEMENT TO SELL THE MANUSCRIPT AND COPYRIGHT OF A BOOK.

Agreement, made and entered into this first day of January, 1860, by and between James Smith, of Poughkeepsie, State of New York, of the one part, and Charles Scribner, of New York City, State aforesaid, of the other part:

Whereas, the said James Smith has composed or compiled a work called the "Flowers of Poesy,"

Now this agreement witnesseth that the said party of the first part, for and in consideration of the sum of five hundred dollars, to be paid as hereinafter mentioned, and other good and valuable considerations herein named, has agreed to sell, and does hereby sell, to the said party of the second part, his heirs, executors, administrators, and assigns, the manuscript copy of the said book, including a full and complete Index thereto. And the said party of the first part also agrees to examine and correct the proof-sheets of said work as they shall be furnished by said party of the second part.

The said party of the second part, for himself his heirs, executors, administrators, and assigns, agrees to pay to the said party of the first part, his executors, administrators, or assigns, the said sum of five hundred dollars in manner following: One hundred dollars on the execution of this contract; two hundred dollars when the Index shall be ready for the printer; and the

AGREEMENT TO ENLARGE A SECOND EDITION OF A BOOK.

balance when the proof-sheets shall all have been examined and corrected and furnished to the printer. Said party of the second part also agrees to furnish the whole of said proof-sheets to said party of the first part within three months after the delivery of the manuscript; and further agrees to furnish and deliver to said party of the first part, free of cost, fifteen bound copies of said work within three months after he, said party of the first part, shall have completed his labors on said work.

The said party of the second part, his heirs and assigns, are to have the exclusive right to take out and own the copyright of such work, and any renewals of such copyright authorized by law.

It is further agreed, that in case said book shall not make three hundred pages of the size and style of the pages of a work known as "Pearls of Poetry," then and in such case said party of the first part is to receive, and the said party of the second part is to pay, a sum bearing such proportion to the sum of five hundred dollars as the number of pages furnished bears to three hundred; but in case the said work shall contain more than three hundred pages, the sum to be paid therefor shall not be increased.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered in presence of
JOHN SMITH,
JAMES BROWN.

JAMES SMITH. [L. S.]
CHARLES SCRIBNER. [L. S.]

5 CENT INT. REV. STAMP.

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2. AGREEMENT TO ENLARGE A SECOND EDITION OF A BOOK, AND CORRECT PROOF OF THE SAME.

This agreement, made the eighth day of January, 1866, by and between James Smith, of Poughkeepsie, New York, of the first part, and Charles Scribner, of New York City, of the second part, witnesseth:

That the said James Smith, for and in consideration of three hundred dollars, and other consideration herein named, agrees to examine, correct, and enlarge the work known as "Flowers of Poesy," to furnish additional manuscript matter for the second edition of the work, and to enlarge the Index and make it full and complete.

ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.

It is understood and agreed that the new edition of the work shall be of the same sized page as the present work, and contain an equal amount of matter on each page, and that the additional matter furnished shall enlarge the work not less than one hundred pages, and shall be furnished to the said Charles Scribner at not less than twenty pages per day (one hundred and twenty pages per week), commencing on the twentieth instant.

And the said James Smith is to examine and to correct the proof-sheets as fast as they shall be furnished, and to complete the Index as soon as may be, after the whole signatures of the text shall be ready for him for that purpose.

And the said Charles Scribner, on his part, agrees to print the said work as the matter shall be furnished, to furnish the said James Smith a copy of the work, by signatures, as each signature shall be worked off, for the purpose of arranging the Index; to furnish the said James Smith fifty bound copies of the work, as soon as they can be conveniently finished, and to pay the said James Smith the sum of three hundred dollars on the day the last proof-sheet is corrected for the press.

The said Charles Scribner is to take out and secure a copyright of said work; and the said James Smith, on the completion of the work, is to execute and deliver to the said Charles Scribner, his heirs and assigns, forever, an assignment of all his right and title and interest in and to the said work.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year above written.

JAMES SMITH. [L. S.]
CHARLES SCRIBNER. [L. S.]

In presence of
JOHN SMITH,
JAMES BROWN.

5 CENT INT. REV. STAMP.

---

3. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.

Indenture, made this first day of January, 1860, between James Smith, of Poughkeepsie, State of New York, of the one part, and Charles Scribner, of the City of New York, State aforesaid, of the other part.

Whereas, the said James Smith has written and compiled a book, entitled "Flowers of Poesy," for which he took out copyright in the Southern District of New York, on the first day of August, A. D. 1859:

ASSIGNMENT OF COPYRIGHT FOR ORIGINAL TERM.

Now this indenture witnesseth, that the said James Smith, for and in consideration of the sum of one thousand dollars, to him in hand paid by the said Charles Scribner, the receipt whereof is hereby acknowledged, has bargained, sold, and assigned, and by these presents does bargain, sell, and assign, unto the said Charles Scribner, all the said book, and all his copyright, title, interest, property, claim, and demand of, in, and to the same, to have and to hold the said book, copyright, and all the profit, benefit, and advantage that shall or may arise, by and from printing, reprinting, publishing, and vending the same: Provided, nevertheless, and these presents are upon this express condition, that the number of copies to be printed on the first, and each and every other edition or impression of the said book, shall not exceed one thousand; and that the said Charles Scribner shall and will pay unto the said James Smith the further sum and sums of one hundred dollars for, at, and upon the reprinting or making a second, and each and every other future and further edition or impression that shall or may be made of the said book, for and towards a further reward and satisfaction to the said James Smith, for his writing and compiling the same. The said payments shall be made before the publication of the said several impressions or editions (after the first) and sale of the same, or any part thereof, by the said Charles Scribner, or by any other person or persons, by, for, or under him. And the said Charles Scribner doth covenant, promise, and agree, to and with the said James Smith, that he, the said Charles Scribner, shall and will pay, or cause to be paid, to the said James Smith, the said respective sum and sums of one hundred dollars, at and upon the reprinting, and before the publication and sale of the said second and every other future and further edition and impression that shall and may be made of the said book, according to the proviso aforesaid, and the true intent and meaning of these presents. And to the fulfilment of the covenants herein contained, the parties bind their respective executors, administrators, and assigns, as well as themselves.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered in presence of
JOHN SMITH,
JAMES BROWN.

JAMES SMITH. [L. S.]
CHARLES SCRIBNER. [L. S.]

ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.

STATE OF NEW YORK,
CITY AND COUNTY OF NEW YORK. } *ss.*

On this first day of January, 1860, personally appeared James Smith and Charles Scribner, to me known to be the individuals described in and who executed the foregoing instrument, and severally acknowledged that they executed the same for the purposes therein mentioned.

5 CENT INT. REV. STAMP.

JAMES BROWN,
Notary Public.

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4. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.

Indenture, made this first day of May, 1864, between James Smith, of Poughkeepsie, State of New York, of the one part, and Charles Scribner, of the City and State of New York.

Whereas, the said James Smith has written and composed a book, entitled "Flowers of Poesy,"

Now this indenture witnesseth, that the said James Smith, for and in consideration of the sum of five hundred dollars, to him in hand paid by said Charles Scribner, the receipt of which is hereby acknowledged, has bargained, sold, and assigned, and by these presents does bargain, sell, and assign unto the said Charles Scribner, his heirs, executors, administrators, and assigns, all the said book, and the manuscript thereof, and all his right, title, and interest, property, claim, and demand, of every kind and nature whatsoever, of, in, and to the same, and in any and all copyrights, and any and all renewals thereof, which may or can be had, or secured, or taken, in respect to said book or manuscript, under and by virtue of any acts of Congress, with any and all profit, benefit, and advantage that shall or may arise by or from printing, publishing, or vending the same, during the original or renewed terms of any such copyright. To have and to hold the same to the said Charles Scribner, his heirs, executors, administrators, and assigns forever.

And the said James Smith agrees to examine and correct the proof-sheets of said work, as fast as they shall be furnished, and to make and complete a full and correct Index therefor, as soon as may be after all the signatures of the text shall be furnished for that purpose.

LICENSE TO PRINT ONE EDITION OF A BOOK.

And the said Charles Scribner, for himself, his heirs, executors, administrators, and assigns, covenants and agrees to furnish and deliver, free of cost, to said James Smith, twenty-five bound copies of said work, within three months after the said Index shall or may be completed.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered in presence of
JOHN DOE,
RICHARD ROE.

JAMES SMITH. [L. S.]
CHARLES SCRIBNER. [L. S.]

Acknowledgment, as in No. 3.

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5. LICENSE TO PRINT ONE EDITION OF A BOOK.

Indenture, made this first day of January, 1860, by and between James Smith, of Poughkeepsie, New York, of the first part, and Charles Scribner, of the City of New York, State aforesaid, of the second part.

Whereas, the said James Smith has in preparation a work, to be called the "Flowers of Poesy,"

Now this indenture witnesseth, that the said James Smith, for the consideration hereinafter expressed, does hereby authorize and allow the said Charles Scribner to print, publish, and sell an edition of one thousand copies of said work, the said James Smith hereby reserving to himself the general copyright in said work.

And the said James Smith, in consideration of the payments hereinafter agreed and covenanted to be made by said Charles Scribner, doth hereby covenant and agree, to and with the said Charles Scribner, that he will furnish to the printer, to be employed by him, fair copy of the said work, and will superintend the printing, and correct the proofs thereof, in the usual manner; and that he will take out of the clerk's office of the District Court of the United States for the Southern District of New York the usual evidences of copyright, for the protection of said work, and will not authorize any person to print, publish, or sell, and will not print, publish, or sell himself, any other copies until the whole of said one thousand copies have been disposed of by said Charles Scribner; Provided, said one thousand copies are sold within five years from the date hereof.

ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION.

And the said Charles Scribner, in consideration of the aforesaid authority and agreement, does hereby covenant and agree, to and with said James Smith, that he will pay him, the said James Smith, the sum of twenty cents for each and every copy of the said one thousand copies, payable semi-annually, as fast as the said copies shall be sold or otherwise disposed of, he rendering to the said James Smith an account of sales of said work, at the expiration of six months from the day of the first publication, until the whole shall be sold, and that he will also give to the said James Smith fifty copies of said work, handsomely bound, free of charge, as soon as conveniently may be done, after the manuscript copy has been furnished by the said James Smith.

And the said Charles Scribner, in consideration, also, of the aforesaid authority and agreement, does further covenant and agree, to and with said James Smith, that he will not print, publish, or sell any more than the said one thousand copies, until authorized by said James Smith, or his legal representatives, in writing; it being understood that the license herein contained extends only to one edition of the number above specified.

In witness whereof, the said parties have hereunto set their hands and seals, the day and year first above written.

Sealed and delivered in presence of
JOHN SMITH,
JAMES BROWN.

JAMES SMITH. [L. S.]
CHARLES SCRIBNER. [L. S.]

Acknowledgment, as in No. 3.

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6. ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION FOR SPECIFIED TIME AND PLACES.

Know all men by these presents: That for and in consideration of the sum of one thousand dollars, to be paid as hereinafter mentioned, I, Dion Bourcicault, of the City and County of New York, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto George Roberts, of the State of Connecticut, for the term of one year from the date hereof, the right, privilege, and license of acting, performing and representing, and of permitting to be acted, performed and represented, my play in five acts entitled

ASSIGNMENT OF RIGHT TO PERFORM DRAMATIC COMPOSITION.

'The Octoroon, or Life in Louisiana," in all cities in the United States and Canadas, excepting, however, the cities of Boston, New York, Philadelphia, Charleston, Mobile, and New Orleans. To have and to held the same to said George Roberts, his executors and administrators, together with all the rights and privileges granted and secured to me under the acts of Congress for the protection of my copyright of said play for the period and places aforesaid. Said sum of one thousand dollars to be paid as follows, to wit: six hundred and fifty dollars at the date of these presents and delivery of the manuscript of said play to said Roberts; the further sum of one hundred and fifty dollars on the fifteenth day of February next, and the further sum of two hundred dollars on the thirtieth day of March next. But it is nevertheless expressly understood and agreed, inasmuch as I am in negotiation with the managers of the Cincinnati Theatre for the sale of the license to perform and represent said play in such City of Cincinnati, that I am at liberty to conclude said sale, and in such event I am to credit the amounts I shall receive therefor towards the two payments above mentioned to be made on the fifteenth day of February and thirtieth day of March next by said Roberts to me.

In witness whereof, I have hereunto set my hand and seal, this thirtieth day of December, in the year one thousand eight hundred and fifty-nine.

In presence of DION BOURCICAULT. [L. S.]

L. PITKIN,
WM. DIXEY.

Acknowledgment, as in No. 3.

This assignment held valid in *Roberts* v. *Meyers*, 13 Mo. Law Rep., 396.—SPRAGUE, J.; Mass., 1860.

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PATENT LAWS.

ACT OF 1790, CHAPTER 7.

1 STATUTES AT LARGE, 109.

[*Obsolete: Repealed by Act of* 1793, § 12.]

An Act to promote the progress of useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That upon the petition of any person or persons to the Secretary of State, the Secretary for the department of war, and the Attorney-General of the United States, setting forth that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the department of war, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to bear testo by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making,

constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent by the said Secretary at the time of granting the same.

Under this section it was held, that the allegations and suggestions of the pe ition must be substantially recited in the patent, or the patent was void. *Evans* v. *Chambers*, 2 Wash., 126.—WASHINGTON, J.; Pa., 1807.

SECTION 2. *And be it further enacted*, That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in

the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege shall come in question.

SECTION 3. *And be it further enacted*, That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

SECTION 4. *And be it further enacted*, That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators or assigns, first had and obtained in writing, every person so offending shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved the thing or things so devised, made, con

structed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

SECTION 5. *And be it further enacted*, That upon oath or affirmation made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

See notes to act of 1793, § 10; and also DIGEST PAT. CASES, title COURTS, B. 3.

SECTION 6. *And be it further enacted*, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence (*a*), that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence (*b*), tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

(*a*) Of the novelty and utility of an invention, the patent is *prima facie* evidence of a very slight character. *Lowell* v. *Lewis*, 1 Mass., 184. —STORY, J.; Mass., 1817.

See also DIGEST PAT. CASES, title PATENT, P. 2.

(*b*) As to General Issue, and notices with, see notes to act of 1793, § 6, and to act of 1836, § 15.

SECTION 7. *And be it further enacted*, That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifica-

tions, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Approved April 10th, 1790.

ACT OF 1793, CHAPTER 11.

1 STATUTES AT LARGE, 318.

[*Obsolete: Repealed by Act of* 1836, § 21.]

An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application (*a*), and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition (*b*), and giving a short description of the said invention or discovery,

and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed: and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

(*a*) 1. This section is to be construed with the other parts of the act to mean that the discovery should be unknown, and not used as the invention of any other than the patentee, before the application for a patent. *Morris* v. *Huntington*, 1 Paine, 353.—THOMPSON, J.; N. Y., 1824.

2. This section of the act is to be construed with section 6 of the same act, and means that the first inventor has a right to a patent, though there may have been a knowledge of the thing invented before the *application* for a patent, if such use or knowledge was not anterior to the *discovery*. *Mellus* v. *Silsbee*, 4 Mass., 111.—STORY, J.; Mass., 1825. *Goodyear* v. *Matthews*, 1 Paine, 301.—LIVINGSTON, J.; Ct., 1814. *Treadwell* v. *Bladen*, 4 Wash., 707, 708.—WASHINGTON, J.; Pa., 1827. CONTRA, *Whitney* v. *Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831. *Thompson* v. *Haight*, 1 U. S. Law Jour., 573.—VAN NESS, J.; N. Y., 1822.

3. The meaning of the words "not known or used," &c., in this section, is that the invention must not have been known or used BY THE PUBLIC *before the application*. *Pennock* v. *Dialogue*, 2 Pet., 19.—STORY, J.; Sup. Ct., 1829.

4. The patent act of 1790 used the words "not known or used before," without adding the words "the application:" in connection

with the structure of the sentence in which they stand, they might have been referred either to the time of the invention, or of the application. The addition of the latter words in the act of 1793 must have been *ex industria*, and with the cautious intention to clear away a doubt, and fix the original and deliberate meaning of the legislature. *Ibid.*, 22. *Shaw* v. *Cooper*, 7 Pet., 319.—McLEAN, J.; Sup. Ct., 1833.

5. Within the spirit of this section, it was held that the Secretary of State, though not expressly authorized, might receive the surrender of letters patent, which were defective by reason of mistakes committed either by the department, or by the inventor, innocently, and reissue a new and corrected patent. *Grant* v. *Raymond*, 6 Pet., 242.—MARSHALL, Ch. J.; Sup. Ct., 1832. Same view had been before taken in *Sullivan's Case*, Opin., Gilpin's Ed., 158.—WIRT, Atty.-Gen., 1818. *Morris* v. *Huntington*, 1 Paine, 355.—THOMPSON, J.; N. Y., 1824. *Grant* v. *Mason*, 1 Law Int. and Rev., 22.—THOMPSON, J.; N. Y., 1828. *Anon.*, 2 Opin., 456.—TANEY, Atty.-Gen., 1831.

(*b*) 1. Though this act, like that of 1790, required a petition to be presented, and the patent, when issued, to recite the "allegations and suggestions of the petition," it seems that, after this act of 1790, the petition alone seldom contained any thing as to the patent beyond a mere title. *Hogg* v. *Emerson*, 6 How., 480, 481.—WOODBURY, J.; Sup. Ct., 1847.

2. But the specification, being filed at the same time and often on the same paper, seems to have been regarded, whether specially named in the petition or not, as a part of it. To avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. *Ibid.*, 481.

SECTION 2. *Provided always, and be it further enacted,* That any person, who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which shall have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use, or vend the original discovery, nor shall the first inventor be at liberty to use the improvement: (*a*) And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery. (*b*)

(*a*) As to doctrine that the patentee of an improvement has no right

to use the original discovery, nor the first inventor the right to use the improvement, see *Gray* v. *James*, Pet. C. C., 399.—WASHINGTON, J.; Pa., 1817. *Washburn* v. *Gould*, 3 Story, 150.—STORY, J.; Mass., 1844. *Woodworth* v. *Rogers*, 1 Wood. & Min., 141.—WOODBURY, J.; Mass., 1847; and generally DIGEST PAT. CASES, title IMPROVEMENT, C.

(*b*) 1. It is not every change of form and proportion which is declared by this act to be no discovery, but such as is *simply* a change of form and proportion, and nothing more. If by changing the form and proportion a new effect is produced, there is not simply a change of form and proportion, but a change of principle also. *Davis* v. *Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

2. Though this declaratory act, that a change in form is not a discovery, was not re-enacted in the law of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. *Winans* v. *Denmead*, 15 How., 341.—CURTIS, J.; Sup. Ct., 1853.

See also DIGEST PAT. CASES, titles FORM; IMPROVEMENT, A.

SECTION 3. *And be it further enacted*, That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe, that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, (*a*) or

with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent-right, shall come in question. (*b*) And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

(*a*) 1. Under the provisions of this section requiring drawings with written references, if the specification refers to the drawings, they thereby become part of the written description of the invention. *Earle* v. *Sawyer*, 4 Mass., 10, 11.—STORY, J.; Mass., 1825. *Brooks* v. *Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

2. It is sufficient if drawings and written references are put on file with the specification; and if the references required are written on the drawings the statute is satisfied. *Emerson* v. *Hogg*, 2 Blatchf., 9, 10.—BETTS, J.; N. Y., 1845.

3. The patent act of 1793 does not limit the inventor to one single mode or one single set of ingredients to carry into effect his invention. He may claim as many modes as he pleases, provided always that the claim is limited to such as he has invented and as are substantially new. And section 3 of the act requires, in the case of a machine, that the inventor shall explain the several modes in which he has contemplated the application of its principle. *Ryan* v. *Goodwin*, 3 Sumn., 521.—STORY, J.; Mass., 1839.

4. Under the act of 1793, the specification was not required to be made a part of the letters patent, but the inventor could have it so incorporated with them if he desired. *Hogg* v. *Emerson*, 11 How., 604.—WOODBURY, J.; Sup. Ct., 1850.

(*b*) An exemplification of a specification of a patent is made evidence by this section of the act of Congress. The exemplification of the patent itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. The drawing or model need not be exemplified. *Peck* v. *Farrington*, 9 Wend., 45.—SAVAGE, Ch. J.; N. Y., 1832.

SECTION 4. *And be it further enacted*, That it shall be

lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree.

1. It is the business of the assignee of a patent-right to see that the assignment is put on record. *Morrill* v. *Worthington*, 14 Mass., 392.—CURIAM; Mass., 1817.

2. Under this section, an assignment is not valid unless it has been recorded in the office of the Secretary of State. *Higgins* v. *Strong*, 4 Blackf., 183.—DEWEY, J.; Ind., 1836.

3. Under this section, until an assignment is recorded, the assignee is not substituted to the rights and responsibilities of the patentee so as to maintain a suit at law or in equity, founded thereon. *Wyeth* v. *Stone*, 1 Story, 296.—STORY, J.; Mass., 1840.

4. Under this section, the recording of an assignment is indispensable to convey the right. *Dobson* v. *Campbell*, 1 Sumn., 326.—STORY, J.; Me., 1833. *Boyd* v. *McAlpine*, 3 McLean, 428.—MCLEAN, J.; Ohio, 1844.

SECTION 5. *And be it further enacted*, That if any person shall make, devise, and use, or sell the thing so invented (*a*), the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent (*b*) of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum, that shall be at least equal to three times the price, for which the patentee has usually sold or licensed, to other persons, the use of the said invention, which may be recovered in an action on the case founded on this act, in the Circuit Court of the United States, or any other court having competent jurisdiction. (*c*)

(*a*) 1. Under the act of 1790, a patent was made *prima facie* evidence; that act was repealed by the act of 1793, and that provision

was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove these facts in order to make out his case. *Corning* v. *Burden*, 14 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

2. Under this section, subjecting to a penalty "any person who shall make, devise, *and* use, or sell the thing so invented," it might well be questioned whether any person would be subject to the penalty for using a machine which he had not also made and devised. Such doubt is removed by section 3 of the act of 1800, which subjects to damages "any person who shall make, devise, use. *or* sell" the invention of another. *Evans* v. *Jordan*, 1 Brock., 250, 251.—MARSHALL, Ch. J.; Va., 1813.

3. The maker and seller of a patented article, within the meaning of this section, is the person for whom, by whose direction, and for whose account the article is sold—and not the mere workman employed to sell. *Delano* v. *Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

(*b*) Where one erected, on his own premises and at his own expense, a machine which was claimed to be the invention of another; and afterwards such inventor took a lease of the machine for a term of years, covenanting to reconvey the same at the end of the term of years, *Held*, that such covenant amounted to license or consent in writing, within the meaning of this section. *Reutgen* v. *Kanowrs*, 1 Wash., 172.—WASHINGTON, J.; Pa., 1804.

(*c*) 1. Under this section, it was held the assignee of a *part* of a patent could not maintain an action for a violation. *Tyler* v. *Tuel*, 6 Cra., 324.—CURIAM; Sup. Ct., 1810.

2. But the assignee of a moiety may join with the patentee in an action for a violation. *Whittemore* v. *Cutter*, 1 Gall., 430.—STORY, J.; Mass., 1813.

This section repealed by act of 1800, § 4.

SECTION 6. *Provided always, and be it further enacted*, That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter (*a*), of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove, that the specification, filed by the plaintiff, does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made,

for the purpose of deceiving the public (*b*), or that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee (*c*), or that he had surreptitiously obtained a patent for the discovery of another person (*d*); in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void (*e*).

(*a*) 1. The object of this section was to guard against defeating patents by the setting up of a prior invention which had never been reduced to practice. *Bedford* v. *Hunt*, 1 Mass., 305.—STORY, J.; Mass., 1817.

2. This section appears to have been drawn with the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue, and intends to relieve the defendant from the difficulties of pleading, by allowing him to give in evidence matter which affects the patent. *Evans* v. *Eaton*, 3 Wheat., 503, 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

3. Such notice is, however, for the security of the plaintiff, to protect him against surprise. *Ibid.*, 504.

(*b*) Under this section a defect or concealment in a specification, in order to make the patent invalid, must appear to have been made for the purpose of deceiving the public. *Whitney* v. *Carter*, Fessenden on Pat., 2d ed., 139.—JOHNSON, J.; Geo., 1809. *Park* v. *Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813. *Whittemore* v. *Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray* v. *James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817. *Lowell* v. *Lewis*, 1 Mass., 189.—STORY, J.; Mass., 1817.

(*c*) 1. Where a defence is made that the patentee is not the original discoverer of the thing patented, the patent will be considered as relating back to the original discovery. Construing sections 1 and 6 together, the patentee's right does not date from the time of his application for a patent, but from the time of his discovery. *Dixon* v. *Moyer*, 4 Wash., 72.—WASHINGTON, J.; Pa., 1821.

2. Under this section, if the thing had been in use or known anterior to the patentee's supposed discovery, his patent is void. Though the patentee had no knowledge of such previous discovery, still his patent is void, as the law supposes he may have known it. *Evans* v. *Eaton*, 3 Wheat., 514.—MARSHALL, Ch. J.; Sup. Ct., 1818.

3. The use of a machine, to test its value, as a cracker machine to the extent of half a barrel of flour, held to amount to a using of it with-

in the meaning of this section. *Watson* v. *Bladen*, 4 Wash., 583.—WASHINGTON, J.; Pa., 1826.

(*d*) 1. This section does not enumerate all the defences of which the defendant may legally avail himself; as he may give in evidence that he never did the thing attributed to him; that the patentee is an alien, and not entitled under the act; or that he has a license or authority under the patentee. *Whittemore* v. *Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813. *Kneass* v. *Schuylkill Bank*, 4 Wash., 11.—WASHINGTON, J.; Pa., 1820. *Pennock* v. *Dialogue*, 2 Pet., 23.—STORY, J.; Sup. Ct., 1828.

2. This section only declares the defences available against a patentee; but no process or means are given by it for the examination of a patent, however false and fraudulent it may be, if the patentee will forbear to bring suit against those using it. *Delano* v. *Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834.

(*e*) 1. If a defendant seeks to annul a patent, he must proceed in precise conformity with section 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of vacatur by the court. This section does not control the 3d. *Grant* v. *Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

2. The Circuit Court, in a civil suit, cannot declare a patent void except for the causes specified in this section. If the patent is defective for any other cause, the verdict must be general for the defendant. *Whitney* v. *Emmett*, Bald., 321.—BALDWIN, J.; Pa., 1831.

3. Under this section, the Circuit Courts of the United States have exclusive jurisdiction in suits where the patent may be declared void. *Parsons* v. *Barnard*, 7 Johns., 144.—CURIAM; N. Y., 1810. *Wilson* v. *Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

See also notes to act of 1836, § 15, and DIGEST PAT. CASES, title GENERAL ISSUE.

SECTION 7. *And be it further enacted*, That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party, claiming that right, shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

SECTION 8. *And be it further enacted*, That the persons, whose applications for patents, were, at the time of passing this act, depending before the Secretary of

State, Secretary at War, and Attorney-General, according to the act passed the second session of the first Congress, intituled "An act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

SECTION 9. *And be it further enacted*, That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State (*a*); and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to choose an arbitrator, the patent shall issue to the opposite party. (*b*) And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

(*a*) An inventor filed a description of his alleged invention in 1802, as required by section 3 of the act of 1793, and took no further step until 1814, when another person made application for a patent for the same invention; *Held*, that there was no limitation of time within which a patent must be taken out after specification filed, and that the facts made a case of interference, to be arbitrated under this section. *Anon.*, 5 Opin., 701.—RUSH, Atty.-Gen.; 1814.

(*b*) The refusal of a defendant to submit his claim to arbitration under this section, and his subsequently obtaining a patent therefor, is not conclusive evidence, in a proceeding under section 10, that such patent was obtained surreptitiously. *Stearnes* v. *Barrett*, 1 Mass., 174. —STORY, J.; Mass., 1816.

SECTION 10. *And be it further enacted*, That upon oath or affirmation being made before the judge of the

District Court, where the patentee, his executors, administrators, or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District Court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

1. The jurisdiction given to the District Court, under this section, applies only to cases in which the patent has been obtained by fraud, surreptitiously, by false suggestion, or by some wilful misrepresentation and deception. *Delano* v. *Scott.*, Gilpin, 493.—HOPKINSON, J.; Pa., 1834.

2. The summary proceeding under this section is given to protect the public from manifest fraud, in taking out patents (the fees of office being no check), for known and common things. *Ibid.*, 494.

3. It gives the power to any person to call upon a patentee for an examination of his right, and have it repealed, if it shall be found that he is not entitled to it. *Ibid*, 500.

4. Proceedings under this section, upon the rule *nisi*, are not conclu-

sive. The process awarded, upon making the rule absolute, is in the nature of a *scire facias*, and is not final. *Stearnes* v. *Barrett*, 1 Mass., 165.—STORY, J.; Mass., 1816. *Wood & Brundage*, *Ex parte*, 9 Wheat., 615.—STORY, J.; Sup. Ct., 1824. *Delano* v. *Scott*, Gilpin, 499.—HOPKINSON, J.; Pa., 1834. CONTRA, *McGaw* v. *Bryan*, 1 U. S. Law Jour., 98.—VAN NESS, J.; N. Y., 1822.

5. In proceedings under this section, the United States will not be substituted as plaintiffs, in place of the patentee. *Wood* v. *Williams*, Gilpin, 520, 524.—HOPKINSON, J.; Pa., 1834.

See also DIGEST PAT. CASES, title COURTS, B. 3.

SECTION 11. *And be it further enacted*, That every inventor, before he presents his petition to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition; and the money thus paid, shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office. *Provided nevertheless*, That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person, obtaining such copy, shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the party obtaining the same, shall pay two dollars, of which payments, an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

1. A defendant, being permitted under section 6 of the act of 1793, to set up the defence that the plaintiff's specification does not contain the whole truth, he has, under this section, a right to call for and have a copy of the plaintiff's specification, and no conditions can be imposed upon the use of such copy. *Anon.*, 1 Opin., 376.—WIRT, Atty.-Gen. 1820.

2. The proviso to this section cannot be considered as opening to all persons, indiscriminately, the right to demand copies of papers respecting patents granted to others. As to others than a defendant, as provided for in section 6, it rests in the discretion of the department whether copies shall be furnished or refused. *Anon.*, 1 Opin., 718.—WIRT, Atty.-Gen.; 1825.

SECTION 12. *And be it further enacted*, That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An act to promote the progress of useful arts," be, and the same is hereby repealed. *Provided always*, That nothing contained in this act, shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, or assigns, shall be considered within the purview of this act, in respect to the violation of their rights; provided such violations shall be committed after the passing of this act.

Approved February 21st, 1793.

ACT OF 1794, CHAPTER 58.

(1 STATUTES AT LARGE, 393.)

[*Obsolete: Repealed by Act of* 1836, § 21.]

An Act supplementary to the act intituled "An act to promote the progress of useful arts."

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That all suits, actions, process, and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An

act to promote the progress of useful arts," which may have been set aside, suspended, or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation, in which they may have been, when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process, or proceedings, be, and are hereby entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place. *Provided always*, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding, as is used in other cases for compelling the appearance of a party.

Approved June 7th, 1794.

ACT OF 1800, CHAPTER 25.

2 STATUTES AT LARGE, 37.

[*Obsolete: Repealed by Act of* 1836, § 21.]

An Act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the pen alties for violating the rights of patentees.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all and singular the rights and

privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries and improvements, by the act intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby are extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed, by such persons, in as full and ample manner, and under the same conditions, limitations and restrictions, as by the said act is provided and directed in the case of citizens of the United States. *Provided always*, That every person petitioning for a patent for any invention, art or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery, which it shall afterward appear had been known or used previous to such application for a patent shall be utterly void.

1. Under this act a foreigner, though having resided within the United States for more than two years, could not have a patent for an invention operated by him in another country before he came here, as he could not take the oath required by this statute. *Duplat's Case*, 1 Opin., 332.—WIRT, Atty.-Gen.; 1820.

2. By the provisions of this act, taken in connection with those of the act of 1793, citizens and aliens are placed substantially upon the same ground as to a right to a patent when the invention has not been known or used before it was patented. In both cases the right is to be tested by the same rule. *Shaw* v. *Cooper*, 7 Pet., 316.—MCLEAN J.; Sup. Ct., 1833.

3. Where a person made an invention in England, in 1813 or 1814, and before coming to this country made known his invention to others, and shortly after coming here disclosed it, in 1817, to an individual here, and in 1817 or 1818, the invention was sold in England, and soon after went into use there and in France, and subsequently, in 1822, the inventor took out a patent here; *Held*, that there had been such a public use of the invention, without an assertion of right on the part of the inventor, as rendered the patent void. *Ibid.*, 318–323.

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery or improvement on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs-at-law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations and restrictions, as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

SECTION 3. *And be it further enacted*, That where any patent shall be, or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators, or assigns, first obtained in writing, shall make, devise, use, or sell (*a*) the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum

equal to three times the actual damage (*b*) sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered by action (*c*) on the case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereof.

(*a*) This section gives an action against any one who shall "make, devise, use, *or* sell," the thing patented, and takes the place of section 5 of the act of 1793, which gave an action against any one who should "make, devise, and use, or sell." This change was made because of some doubt whether the language of section 5 of the act of 1793 did not couple the making and *using* together to constitute an offence, so that making without using, or using without making, was not an infringement. *Whittemore* v. *Cutter*, 1 Gall., 432.—STORY, J.; Mass., 1813. *Evans* v. *Jordan*, 1 Brock., 252.—MARSHALL, Ch. J.; Va., 1813.

(*b*) 1. Under this section the jury find single damages, and the court treble them in awarding judgment. *Lowell* v. *Lewis*, 1 Mass., 185.—STORY, J.; Mass., 1817.

2. Under this section, if the jury find for the plaintiff, they are to find the actual damages sustained by him. The court will treble them. *Gray* v. *James*, Pet. C. C., 403.—WASHINGTON, J.; Pa., 1817. *Evans* v. *Hettick*, 3 Wash., 422.—WASHINGTON, J.; Pa., 1818.

3. This section fixed the amount of recovery at three times the actual damage sustained. Trebling the damages, under the act of 1836, rests with the discretion of the court. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847.

(*c*) 1. This section gave jurisdiction only in actions *on the case; Held*, therefore, that a suit in equity, respecting a patent, in order to be cognizable by the circuit courts, must come within the provisions of the judiciary act of 1789, as to citizenship of parties, and that where the parties were all residents of the same State, such courts had not jurisdiction. *Livingston* v. *Van Ingen*, 1 Paine, 48, 54.—LIVINGSTON, J.; N. Y., 1811.

2. This defect was afterwards remedied by the act of 1819, chap. 19

SECTION 4. *And be it further enacted*, That the fifth section of the above-mentioned act, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be and hereby is repealed.

Approved April 17th, 1800.

ACT OF 1819, CHAPTER 19.

(3 STATUTES AT LARGE, 481.)

[*Obsolete: Repealed by Act of* 1836, § 21.]

An Act to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries: and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided, however*, That from all judgments and decrees of any Circuit Courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such Circuit Courts.

Approved February 15th, 1819.

1. This act removed the defect that existed under the act of 1800, by which the Circuit Courts did not have jurisdiction of suits in equity,

except in actions on the case. *Livingston* v. *Van Ingen*, 1 Paine, 54 (note).—LIVINGSTON, J.; N. Y., 1811.

2. This act does not enlarge or alter the powers of the court over the subject-matter of the cause of action. It only extends its jurisdiction to parties not before falling within it. It removed the objection, that prior to it, a citizen of one State could not obtain an injunction in the Circuit Court for a violation of a patent-right, against a citizen of the same State, and gave the jurisdiction, although the parties were citizens of the same State. *Sullivan* v. *Redfield*, 1 Paine, 447, 448.—THOMPSON, J.; N. Y., 1825.

3. This act extends the jurisdiction of the Circuit Courts to all cases at law and in equity, arising under the patent laws; but there is nothing in the act which, either in terms or by necessary implication, renders that jurisdiction exclusive. *Burrall* v. *Jewett*, 2 Paige, 145.—WALWORTH, Chan.; N. Y., 1830.

4. The substance of this enactment, so far as it relates to the subject of patent-rights, is incorporated into section 17 of the act of 1836. *Stevens* v. *Gladding*, 17 How., 455.—CURTIS, J.; Sup. Ct., 1854.

ACT OF 1832, CHAPTER 162.

4 STATUTES AT LARGE, 559.

[*Obsolete: Repealed by Act of* 1836, § 21.]

An Act concerning patents for useful inventions.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

SECTION 2. *And be it further enacted*, That application to Congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified

at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the State or Territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

1. Under the patent laws, prior to 1836, if a patent was renewed, it was a new grant, independent of the old, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees or assignees had, by their original grant, secured to themselves by express covenant or grant, a right to the benefit of the renewed patent. *Washburn* v. *Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

2. Prior to this statute, the only mode of prolonging the term of a patent beyond the original grant, was by means of private acts of Congress upon individual applications. *Wilson* v. *Rosseau*, 4 How., 685.—NELSON, J.; Sup. Ct., 1845.

SECTION 3. *And be it further enacted*, That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive

intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided, however*, That such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

Approved July 3d, 1832.

1. The provision of this section is susceptible of but one construction, and that is, that the patentee may sustain an action for any use or violation of his invention, after the grant of the new patent. No prior use of a defective patent can authorize the use of the invention after the emanation of the renewed patent. *Stimpson* v. *Westchester R. R.*, 4 How., 402.—McLean, J.; Sup. Ct., 1845.

2. To give to the patentee the fruits of his invention was its object, which would be defeated, if a right could be founded on a use subsequent to the original patent, and prior to the renewed one. *Ibid.*, 402.

3. The proviso of this section is in affirmance of the principles laid down by the Supreme Court in *Pennock* v. *Dialogue*, 2 Pet., 1 (1829); in *Grant* v. *Raymond*, 6 Pet., 241–245 (1832); and in *Shaw* v. *Cooper*, 7 Pet., 314, 315 (1833). *McClurg* v. *Kingsland*, 1 How., 207.—Baldwin, J.; Sup. Ct., 1843.

4. As the exception in the proviso is limited to the use of the invention under a special license after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in *Pennock* v. *Dialogue*, 2 Pet., 1; whereby the patent would become void. *Ibid.*, 207.

ACT OF 1832, CHAPTER 203.

4 STATUTES AT LARGE, 577.

[*Obsolete: Repealed by Act of* 1836, § 21.]

An Act concerning the issuing of patents to aliens, for useful discoveries and inventions.

Be it enacted, by the Senate and House of Representatives of the United States of America in Congress assembled, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended, in like manner, to every alien, who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided*, That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same

for any period of six months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Approved July 13th, 1832.

ACT OF 1836, CHAPTER 357.

5 STATUTES AT LARGE, 117.

[*This Act still in Force.*]

An Act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose. (*a*)

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be established and attached to the Department of State (*b*) an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said

office. And said Commissioner shall receive the same compensation (*c*) as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage. (*d*)

(*a*) POLICY OF THE PATENT LAWS.

1. Many of the provisions of our patent acts are derived from the principles and practice which have prevailed in England. And though the known and settled construction of the English statute of Monopolies, by their courts of law, has not been received by our courts with all the weight of authority, yet the construction of that statute by the English courts, and the principles and practice which have regulated the grants of English patents afford materials to illustrate our statute. *Pennock* v. *Dialogue*, 2 Pet., 18.—STORY, J.; Sup. Ct., 1829.

2. The intention of the patent laws is to promote the progress of the useful arts, by the benefits *granted to inventors*, not by those accruing to the public, after the patent has expired, as in England. Intended for their benefit and security, the law should be construed favorably and beneficially in favor of patentees. *Whitney* v. *Emmett*, Bald., 321–323.—BALDWIN, J.; Pa., 1831.

3. The settled purpose of the United States has ever been to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public from the exertions of the individual, and is intended as a stimulus to those exertions. The laws passed for such purpose should be construed in the spirit in which they have been passed, and should be fairly executed by the United States. *Grant* v. *Raymond*, 6 Pet., 241, 242.—MARSHALL, Ch. J.; Sup. Ct., 1832.

4. The great object and intention of the patent acts is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to those discoveries, by the exclusive right to make, use, and sell the thing discovered for a limited time. *Ibid.*, 243.

5. The Constitution of the United States, in giving authority to Congress to grant patents for a limited period, declares the object to be to promote the progress of science and the useful arts, an object as truly national and meritorious, and well founded in public policy, as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts—and latterly of the English—to construe patents fairly and liberally, and not subject them to any overnice and critical refinements. *Ames* v. *Howard*, 1

Sumn 485.—STORY, J.; Mass., 1833. *Blanchard* v. *Sprague*, 3 Sumn., 539, 540.—STORY, J.; Mass., 1839.

6. The patent law gives to inventors a monopoly, but not in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefits. To secure to inventors the remuneration for their time, ingenuity, and expense, a liberal construction should be given to the law. *Brooks* v. *Bicknell*, 3 McLean, 437.—MCLEAN, J.; Ohio, 1844. *Parker* v. *Haworth*, 4 McLean, 372.—MCLEAN, J.; Ill., 1848. *Parker* v. *Stiles*, 5 McLean, 54, 56.—LEAVITT, J.; Ohio, 1849. *Bloomer* v. *Stolley*, 5 McLean, 162.—MCLEAN, J.; Ohio, 1850. *Parker* v. *Sears*, MS.—GRIER, J.; Pa., 1850. *Goodyear* v. *Railroads*, 2 Wall., Jr., 363.—GRIER, J.; N. J., 1853. *Allen* v. *Hunter*, 6 McLean, 306.—MCLEAN, J.; Ohio, 1855.

7. Patents are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor, as *strictissimi juris*. *Ames* v. *Howard*, 1 Sumn., 485.—STORY, J.; Mass., 1833.

8. The patent laws are not made to encourage monopolies of what before belonged to others, or to the public—which is the true idea of a monopoly—but the design is to encourage genius in advancing the arts, through science and ingenuity, by protecting its productions of what did not before exist, and of what never belonged to another person, or the public. *Davoll* v. *Brown*, 1 Wood. & Min., 57.—WOODBURY, J.; Mass., 1845.

9. The patent acts have been passed for the promotion of the useful arts—for the ultimate benefit of the republic, and not for the sole benefit of inventors and patentees. It is for the ultimate benefit of the public, that privileges are granted to inventors, allowed to operate, and protected for limited times for their direct benefits. *Day* v. *Union Rub. Co.*, 3 Blatchf., 500.—HALL, J.; N. Y., 1856. *Kendall* v. *Winsor*, 21 How., 327, 328.—DANIEL, J.; Sup. Ct., 1858.

10. The power granted by the patent laws is domestic in its character, and necessarily confined within the limits of the United States. The patent acts do not and were not intended to operate beyond the limits of the United States, and the patentee's right of property and exclusive use cannot extend beyond the limits to which the law itself is confined. *Brown* v. *Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

See also DIGEST PAT. CASES, title PATENT, P. 1; STATUTES, B. 2.

(*b*) The Patent Office is now attached to the Department of the Interior, and the Secretary of the Interior performs all the duties connected therewith formerly devolving upon the Secretary of State. Act of 1849, § 2.

(*c*) Salary now fixed at $4,500. Act of 1861, § 4.

(*d*) The franking privilege was annulled by the "Act to reduce the rates of postage," approved March 3d, 1845; but was again restored by the "Act to establish certain post routes, and for other purposes," approved March 3d, 1847. See also act of 1848, § 4.

ACT OF 1836, CHAP. 357, § 2. IN FORCE.

SECTION 2. *And be it further enacted*, That there shall be, in said office, an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars (*a*), and to be called the Chief Clerk of the Patent Office; who in all cases during the necessary absence of the Commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. (*b*) And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks, at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk, at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger, at seven hundred dollars. (*c*) And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

(*a*) Salary increased to $2,500 by act of 1861, § 4.

(*b*) 1. Under this section the chief clerk has been considered as the "acting Commissioner," whenever the Commissioner has been unable to discharge his duties from any necessary cause, as well as when a vacancy occurs from death or resignation. *Woodworth* v. *Hall*, 1 Wood. & Min., 392.—WOODBURY, J.; Mass., 1846.

2. The appointment of an acting Commissioner will be presumed to have been duly made, where drawn in question, incidentally or collat-

erally, if it be shown that the person certifying is in the public discharge of those duties. *Woodworth* v. *Hall*, 1 Wood. & Min., 255.—WOODBURY, J.; Mass., 1846.

3. The certificate to a patent made by a person as "acting Commissioner," is legal and sufficient. *Wilson* v. *Rosseau*, 4 How., 663, 668.—NELSON, J.; Sup. Ct., 1845. *Woodworth* v. *Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846. *York & Md. R. R.* v. *Winans*, 17 How., 41.—CAMPBELL, J.; Sup. Ct., 1854.

See also DIGEST PAT. CASES, title COMMISSIONER OF PATENTS, G.

(*c*) 1. As to the appointment of additional examiners, see act of 1837, § 11; act of 1839, § 1; act of 1856, §§ 9, 10; and act of 1860, § 5.

2. The Commissioner of Patents is now authorized to appoint additional examiners, not exceeding four in each class. Act of 1861, § 7.

SECTION 3. *And be it further enacted*, That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said Commissioner and the Chief Clerk shall also, before entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

SECTION 4. *And be it further enacted*, That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings, belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant, under the signature

of the Chief Clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. (*a*) And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office (*b*), on paying, for the written copies, the sum of ten cents for every page of one hundred words (*c*); and for copies of drawings, the reasonable expense of making the same.

(*a*) 1. A certified copy of an assignment is competent evidence, and the party cannot be required to produce the originals. *Brooks* v. *Bicknell*, 3 McLean, 436.—McLean, J.; Ohio, 1844.

2. Certified copies of papers and drawings, on file in the Patent Office, must be received in evidence when offered. If they are discordant, they may destroy the effect of each other; but they need not concur in every particular. *Emerson* v. *Hogg*, 2 Blatchf., 12.—Betts, J.; N. Y., 1845.

3. Certified copies of papers in the Patent Office are *prima facie* evidence of the genuineness of the original, on file, and absolute evidence of the correctness of the copies from the records. *Parker* v. *Haworth*, 4 McLean, 371.—McLean, J.; Ill., 1848.

4. A certified copy of an assignment of a patent, from the Patent Office, is *prima facie* evidence of the genuineness of the original. *Lee* v. *Blandy*, MS.—McLean, Leavitt, JJ.; Ohio, 1860.

5. A former and defective certified copy of a patent may be corrected by a full and corrected certified copy. *Brooks* v. *Bicknell*, 3 McLean, 434.—McLean, J.; Ohio, 1844. *Woodworth* v. *Hall*, 1 Wood. & Min., 260.—Woodbury, J.; Mass., 1846.

(*b*) 1. The Commissioner of Patents having under his care and custody the records as to patents, it is his duty to give authenticated copies to any person demanding the same, on payment of the legal fees; but a demand accompanied by rudeness and insult is not a legal demand. *Boyden* v. *Burke*, 14 How., 583.—Grier, J.; Sup. Ct., 1852.

2. The officer intrusted to give copies of papers or drawings, in patent cases, has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given when asked for. *Anon.*, 1 Opin., 171.—Pinckney, Atty.-Gen.; 1812.

(*c*) Copies of papers cannot be taken by third persons. They must be made by the proper officer, and the fees paid therefor. *Anon.*, 2 Opin., 456.—Taney, Atty.-Gen.; 1831.

See also Digest Pat. Cases, title Copies of Papers.

SECTION 5. [Enlarged by act of 1837, § 6.] *And be it further enacted*, That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State (*a*), and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design (*b*), and in its terms grant to the applicant or applicants (*c*), his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years (*d*), the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery (*e*), referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery. (*f*)

(*a*) Now signed by the Secretary of the Interior. Act of 1849, § 2.

(*b*) The phraseology of this act, in respect to what the patent shall contain, was changed from that contained in the acts of 1790 and 1793, in order to conform to the usage and construction under the act of 1793 (of inserting the whole descriptive portion of the petition in the patent), as such course sometimes was misunderstood, and led to misconstructions. *Hogg* v. *Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

(*c*) Patents can now issue, by section 6 of the act of 1837, to the assignee or assignees of the inventor.

(*d*) 1. The term of the patent is now extended to seventeen years. Act of 1861, § 16.

2. A patent may be issued for a less term of years than fourteen. The restriction is on the *maximum* only, not on the *minimum*. *Sullivan's Case*, Opin., Gilpin's Ed., 1841, 168.—WIRT, Atty.-Gen.; 1818.

3. A patentee under this section is not obliged to claim the whole fourteen years. He may waive his claim to a part of the term, in favor of the public, by antedating it, or he may take a patent for a term less

than fourteen years, or he may seek protection against strangers for six months previous to the issue, if in that time he has made application and is seeking in good faith and with reasonable diligence to perfect his specifications. *Cushman, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1858.

(*e*) 1. The exclusive grant of a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. *Boyd* v. *Brown*, 3 McLean, 297.—MCLEAN, J.; Ohio, 1843.

2. It does not cover the products of the patented machine. *Ibid.*, 297. *Simpson* v. *Wilson*, 4 How., 711.—NELSON, J.; Sup. Ct., 1845. *Goodyear* v. *The Railroads*, 2 Wall., Jr.—GRIER, J.; N. J., 1853.

3. At common law, an inventor has no exclusive right to make and vend his invention, after he has published it to the world. Such exclusive right is the creature of the statute, which also prescribes the remedy for its violation. *Dudley* v. *Mayhew*, 3 Comst., 13–17.—STRONG, J.; N. Y., 1849.

4. The fact that a party has a patent, giving him the exclusive right to make, use, and sell a particular medicine, does not confer upon him the right to practise as a physician, and use such medicine in any particular State, except in conformity with the laws of such State. *Jordan* v. *Overseers of Poor*, 4 Ohio, 310.—LANE, J.; Ohio, 1831. *Thompson* v. *Staats*, 15 Wend., 395.—NELSON, J.; N. Y., 1836.

5. A party has not necessarily a right to use an invention, in any State, merely because he has a patent for it under the United States. *Vannani* v. *Paine*, 1 Harrington, 68.—ROBINSON, J.; Del., 1833.

6. Where V. had a patent for a plan for constructing and drawing lotteries, and had obtained a patent therefor, but there was a State law prohibiting lotteries, except under certain conditions, which the plaintiff and his associates had not complied with, *Held*, that V. was not entitled to any relief, by way of injunction or otherwise, for any alleged use of his invention in the State. *Ibid.*, 69.

7. The Commissioner of Patents, in issuing letters patent, does not warrant the same, nor does the patent bind the Government more than it does private persons; but the validity of such patent is open to inquiry, either in whole or in part, whether at the instance of private persons or of the Government. A patent does not conclude anybody. *Morton's Anæsthetic Patent*, 8 Opin., 276.—CUSHING, Atty.-Gen.; 1856.

8. Letters patent issue subject to all legal objections that may be brought against them. *Shreeve* v. *United States*, MS.—LORING, J.; Ct. Claims, 1859.

9. In using the word *patent*, it is to be understood as including the patent, the specification attached to it, with the model and drawings in the Patent Office. *Whitney* v. *Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831. *Hogg* v. *Emerson*, 6 How., 478, 482, 485.—WOODBURY, J.; Sup. Ct., 1847.

10. Under the act of 1790, a patent was made *prima facie* evidence;

that act was repealed by the act of 1793, and that provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, but the plaintiff was bound to prove these facts in order to make out his case. But the act of 1836 introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of the facts stated in it. *Corning* v. *Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853. *Allen* v. *Hunter*, 6 McLean, 304, 305.—MCLEAN, J.; Ohio, 1855. *Teese* v. *Phelps*, 1 McAllister, 49. —MCALLISTER, J.; Cal., 1855. *Cahoon* v. *King*, MS.—CLIFFORD, J.; Me., 1859.

(*f*) Under the patent laws since 1836, the specification is always annexed to and forms a part of the letters patent. *Pitts* v. *Whitman*, 2 Story, 621.—STORY, J.; Mass., 1843.

See also DIGEST PAT. CASES, title PATENT, D. 1, 2; E., H., I., P., 1, 2.

SECTION 6. *And be it further enacted*, That any person or persons, having discovered or invented any new and useful art (*a*), machine (*b*), manufacture, or composition of matter (*c*), or any new and useful improvement (*d*) on any art, machine, manufacture, or composition of matter, not known or used by others (*e*) before his or their discovery or invention (*f*) thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, (*g*) and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, con

struct, compound and use the same (*h*); and in case of any machine, he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions (*i*); and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. (*j*) He shall, furthermore, accompany the whole with a drawing, or drawings (*k*), and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. (*l*) The applicant shall also make oath or affirmation (*m*) that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths. (*n*)

(*a*) 1. When art is spoken of as the subject of a patent, it is not an art in the abstract, but it is an art as explained in the specification, and illustrated by a machine, or model, or drawings, when of a character so to be. It means a useful art or manufacture, which must be described with exactness in its mode of operation, and which can be protected only in the mode and to the extent described. *Smith* v. *Downing*, MS.—WOODBURY, J.; Mass., 1850.

2. In the English patent laws the word "art" is not used at all. In ours, as well as in our Constitution, the word art means a useful art, or a manufacture which is beneficial. *Ibid.*

3. A process, *eo nomine*, is not the subject of a patent, under our laws. It is included under the general term "useful art," and an art may require one or more processes or machines, in order to produce a certain result or manufacture. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

See also DIGEST PAT. CASES, titles ART; PROCESS.

(*b*) 1. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. *Corning* v. *Burden*, 15 How., 267.—GRIER, J.; Sup. Ct., 1853.

2. A patent cannot be for the function or abstract effect of a machine, but only for the machine itself. *Ibid.*, 268.

3. A new process is usually the result of discovery; a machine of invention. *Ibid.*, 268.

4. One may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine, by which the operation or process may be performed, and each may be entitled to a patent. *Ibid.*, 268.

5. The word "machine" in the statute includes new combinations as well as new organizations of mechanism. *Wintermute* v. *Redington*, MS.—WILSON, J.; Ohio, 1856.

See also DIGEST PAT. CASES, title MACHINES, A.

(*c*) 1. It is not necessary that every ingredient, or that any one ingredient used by the patentee in his invention, should be new or unused before, for the purpose intended. The true question is whether the combination of materials used by the patentee is substantially new. *Ryan* v. *Goodwin*, 3 Sumn., 518.—STORY, J.; Mass., 1839.

2. There is a wide difference between the invention of a new method or process, by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist together in any other material. *Goodyear* v. *The Railroads*, 2 Wall., Jr., 360.—GRIER, J.; N. J., 1853.

3. In the first case the inventor can patent nothing but his process, and not his composition of matter; in the latter, both are new and original, and both patentable; not severally, but as one discovery or invention. *Ibid.*, 361.

See also DIGEST PAT. CASES, titles COMPOSITION OF MATTER; MANUFACTURE, ARTICLE OF.

(*d*) 1. An "improved machine," and "an improvement on a machine," are substantially the same. *Barrett* v. *Hall*, 1 Mass., 476.—STORY, J.; Mass., 1818. *Evans* v. *Eaton*, 3 Wheat., 517.—MARSHALL, Ch. J.; Sup. Ct., 1818.

2. An improvement has essential reference to a subject-matter to be

improved. It is not an original, but embraces, and either adds to or alters, the original. *Page* v. *Ferry*, MS.—WILKINS, J.; Mich., 1857.

See also DIGEST PAT. CASES, title IMPROVEMENTS.

(*e*) 1. The words "by others," in this section, were probably added by way of explanation of the doubt formerly entertained on the subject, whether a use by the patentee himself of his invention before application, would deprive him of a right to a patent; and to confirm the decision in *Pennock* v. *Dialogue*, 2 Pet., 18–22, that a prior use, to invalidate a patent, must have been by others than the inventor. *Reed* v. *Cutter*, 1 Story, 597.—STORY, J.; Mass., 1841.

2. Such words do not denote a plurality of persons by whom the use should be known, but that the use should be known by some other person or persons than the patentee. *Ibid.*, 597, 598.

3. The words "not known or used" are qualified by section 15, and mean a knowledge or use existing in a manner accessible to the public. *Gayler* v. *Wilder*, 10 How., 497.—TANEY, Ch. J.; Sup. Ct., 1850.

As to priority of invention, see also DIGEST PAT. CASES, titles INVENTION, C.; INVENTOR, B.; and PRIOR KNOWLEDGE.

(*f*) 1. Under the Constitution and laws of the United States respecting patents, *discovery* is synonymous with *invention*. *Kemper*, *Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. An invention resting in mere theory, or in intellectual notion, or imperfect experiments, and not reduced to practice, is not patentable. *Reed* v. *Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

3. Conceiving the idea of an improvement or machine is not invention. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

As to what is invention, see DIGEST PAT. CASES, title INVENTION, A., and the several titles, ART; COMPOSITION OF MATTER, A.; COMBINATION; DISCOVERY; IMPROVEMENTS, A.; MACHINES, A.; MANUFACTURE, ARTICLE OF; NEW APPLICATION; PRINCIPLE.

(*g*) Under the present practice of the Patent Office, two distinct and separate inventions cannot be included in one application, except where they have a necessary and dependent connection with each other, and all co-operate in attaining the end sought.

(*h*) 1. The description should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. *Gray* v. *James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817.

2. It is not enough, however, if, from the description, some very skilful artisan could make and use it, but persons of ordinary skill must be able to do so; and must be able not only to construct but to use the machine for a useful purpose. *Lippincott* v. *Kelly*, 1 West. Law Jour., 514.—IRVIN, J.; Pa., 1844.

3. No description will fulfil the demands of the law but such as is of record, and of which all the world may have the benefit. *Dixon* v. *Moyer*, 4 Wash. 73.—WASHINGTON, J.; Pa., 1821.

4. The object of this provision is twofold: 1, that when the term has

expired, and the invention becomes public property, such means of information may be accessible through the Patent Office as will enable others to avail themselves of its benefits; and 2, that while the patent is in force, others may be informed of the precise claim of the patentee, and not ignorantly infringe his exclusive right. *Parker* v. *Stiles*, 5 McLean, 55.—LEAVITT, J.; Ohio, 1849. *Brooks* v. *Bicknell*, 3 McLean, 441.—MCLEAN, J.; Ohio, 1844. *Judson* v. *Moore*, MS.—LEAVITT, J.; Ohio, 1860.

5. But the specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. *Kneass* v. *Schuylkill Bank*, 4 Wash., 14.—WASHINGTON, J.; Pa., 1820. *Brooks* v. *Bicknell*, 3 McLean, 447, 448.—MCLEAN, J.; Ohio, 1844. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

See also DIGEST PAT. CASES, titles COMPOSITION OF MATTER, B.; SPECIFICATION, B.; IMPROVEMENT, B.

(*i*) 1. This section seems clearly to show that a patentee may lawfully unite in one patent all the modes of applying his invention contemplated, and all the different sorts or modifications of machinery, by which it may be applied, and if each were new the patent would cover them all. *Wyeth* v. *Stone*, 1 Story, 292.—STORY, J.; Mass., 1840.

2. It is the duty of an inventor to describe in his specification the several different modes or devices or modifications known to him of his invention. *Sargent* v. *Carter*, 11 Mo. Law Rep., 655.—CURTIS, J.; Mass., 1858.

See also DIGEST PAT. CASES, title MACHINES, B.

(*j*) 1. The summing up or claim is conclusive upon the right and title of the patentee. *Wyeth* v. *Stone*, 1 Story, 285.—STORY, J.; Mass., 1840.

2. The claim is the most material part of the specification. *Many* v. *Jagger*, 1 Blatchf., 378.—NELSON, J.; N. Y., 1848.

3. Although a patentee does not expressly claim equivalents, he is understood to embrace them, and in contemplation does embrace them. *Byam* v. *Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

See also DIGEST PAT. CASES, title PATENTS, P. 5.

(*k*) 1. Drawings annexed, and referred to in the specification, constitute a part thereof; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. *Earle* v. *Sawyer*, 4 Mass., 9.—STORY, J.; Mass., 1825.

2. References to the drawings in the specification are not requisite to the validity of a patent, unless they are necessary to an understanding of the invention. *Brooks* v. *Bicknell*, 3 McLean, 261.—MCLEAN, J.; Ohio, 1843. *Washburn* v. *Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

3. The description of a machine or improvement, accompanied by a drawing, may, in many cases, be understood without references. *Ibid.*, 262.

4. The drawings may be signed by the inventor, or by his attorney for him. *Anon.*, MS.—BLACK, Atty.-Gen.; 1859.

5. Duplicate drawings are now required. Act of 1837, § 6.

6. Drawings should be in duplicate, twenty inches by fifteen in size; one on thick drawing-paper, colored and shaded, and the other on tracing-cloth, and should be in perspective, with detached sectional and plane views.

7. In the case of designs, photographs may be substituted for drawings, but the "negatives" must be sent to the Patent Office.

See also DIGEST PAT. CASES, title DRAWINGS.

(*l*) 1. Models and drawings are a part of the letters patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg* v. *Emerson*, 6 How., 485.—WOODBURY, J.; Sup. Ct., 1847. *Stephens* v. *Salisbury*, MS.—MORSELL, J.; D. C., 1855.

2. Models should be made of durable material; and, if of wood, should be stained, painted, or varnished, and should not be more than one foot in length and height, unless a larger model is necessary to exhibit the invention.

3. In the case of a design, which can be sufficiently represented by a drawing, a model may be dispensed with.

See also DIGEST PAT. CASES, title MODELS.

(*m*) 1. The taking of the oath by the inventor is but a prerequisite to the granting of a patent, and in no degree essential to its validity. If, therefore, not conformable to the statute it is no objection to the patent. *Whittemore* v. *Cutter*, 1 Gall., 433.—STORY, J.; Mass., 1813.

2. The oath extends to all the schedule or specification no less than to the title of the invention. *Hogg* v. *Emerson*, 6 How., 482.—WOODBURY, J.; Sup. Ct., 1847.

3. The declaration admitted under the English law cannot be substituted in place of the oath. *Anon.*, 3 Opin., 532.—GILPIN, Atty.-Gen.; 1840.

4. Affirmation may be substituted in place of an oath, when the person of whom it is required is conscientiously scrupulous of taking an oath. Act of 1837, § 13.

5. As to the persons before whom the oath may be taken, when the applicant is not, for the time being, residing in the United States. Act of 1842, § 4.

See also DIGEST PAT. CASES, title OATH.

(*n*) 1. The act of 1836, sections 6 and 15, and the act of 1837, section 9, are to be construed, as to originality of invention, as though they were embodied in one act. *Smith* v. *Ely*, 5 McLean, 84.—MCLEAN, J.; Ohio, 1849.

2. The things specified in this section are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor. *Ransom* v. *Mayor, &c., of New York*, MS.—HALL, J.; N. Y., 1856.

IN FORCE. ACT OF 1836, CHAP. 357, § 7.

SECTION 7. [Amended by act of 1839, §§ 7-11: repealed in part by act of 1839, § 12; and act of 1863, § 1.] *And be it further enacted*, That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination (*a*) of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application (*b*), if the Commissioner shall deem it to be sufficiently useful (*c*) and important, it shall be his duty to issue a patent therefor. (*d*) But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof (*e*), or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. (*f*) In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by

this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. (*g*) But if the applicant in such case, shall persist in his claims for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew (*h*), in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners (*i*), to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may

possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

(*a*) The proceedings before the Commissioner are initiatory—all relating to the question whether a patent shall issue. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

See also DIGEST PAT. CASES, title APPLICATION FOR PATENT, A.

(*b*) 1. An inventor will not be deprived of the benefit of his invention and a right to a patent, by a use of his invention before his application for a patent, without his consent and against his will, and without any *laches* or misconduct on his part. *Pierson* v. *Eagle Screw Co.*, 3 Story, 407.—STORY, J.; R. I., 1844. *Fry & Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

2. The provisions of sections 7 and 15 of the act of 1836, introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad—that is, a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty.-Gen.; 1848.

3. If the applicant is an original inventor, and in a condition to make the oath required, the act requires the Commissioner to issue the patent, and the courts declare it valid, and establish the American right

to the exclusion of the foreign discovery, which has not, in either of the modes indicated by the act of Congress, been communicated to the public. *Ibid.*, 21. Also *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

4. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. *Parkhurst* v. *Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849. *Howe* v. *Underwood*, MS.—SPRAGUE, J.; Mass., 1854. *Allen* v. *Hunter*, 6 McLean, 321.—MCLEAN, J.; Ohio, 1855. *Poppenheusen* v. *N. Y. G. P. Comb Co.*, MS.—INGERSOLL, J.; N. Y., 1858. *Ellithorpe* v. *Robertson*, MS.—INGERSOLL, J.; N. Y., 1859.

5. The words "prior to the application," refer only to the "public use or sale of the invention with the applicant's consent or allowance," and do not refer to any thing else. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

6. The words "prior to the alleged invention of the applicant," refer to an invention or discovery of some one, other than the applicant, in this country, and also to a patent or description in this or some foreign country. *Ibid.*

7. The true meaning of this section is, that a patent shall issue to the applicant and be valid, if he is the originator and author of a useful invention, unless the thing invented by him has, prior to his alleged invention or discovery, been invented, or discovered, or used by some one else in this country; or unless the invention of the applicant has been patented or described in some printed publication in this or some foreign country, prior to the alleged invention or discovery of the applicant; or has been on sale with the applicant's consent, prior to his application for a patent. *Ibid.*

8. The provision of this section as to the invention having been in use or on sale prior to the application, amended by the act of 1839, § 7.

See also DIGEST PAT. CASES, titles PRIOR KNOWLEDGE; PRIOR USE.

(*c*) 1. As to the utility of an invention, all that the law requires is, that the invention should not be frivolous or injurious. The word *useful* is used in contradistinction to mischievous or immoral. Whether the invention be more or less useful is unimportant. *Lowell* v. *Lewis*, 1 Mass., 186.—STORY, J.; Mass., 1817. *Bedford* v. *Hunt*, 1 Mass., 303.—STORY, J.; Mass, 1817. *Earle* v. *Sawyer*, 4 Mass., 6.—STORY, J.; Mass., 1825. *Whitney* v. *Emmett*, Bald., 309.—BALDWIN, J.; Pa., 1831. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf., 290.—NELSON, J.; N. Y., 1851. *Page* v. *Ferry*, MS.—WILKINS. J.; Mich., 1857. *Leach, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

2. The invention need not be the best for the use to which it can be applied. *Many* v. *Jagger*, 1 Blatchf., 381.—NELSON, J.; N. Y., 1848. *Roberts* v. *Ward*, 4 McLean, 566.—MCLEAN, J.; Mich., 1849. *Wilbur* v. *Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

See also DIGEST PAT. CASES, title INVENTION, D. 1.

(*d*) 1. The Commissioner is bound to issue a patent in the case and under the circumstances mentioned in this section. He has no discretion about it. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *Aiken, Ex parte* (*Car-Wheels*), MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

2. When a patent has issued, the jurisdiction of the Commissioner is exhausted, and he has no further control over it, except under section 13, upon application for a reissue. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

3. But his power exists in full force until the patent actually issues, and is not controlled by intervening opinions in proceedings during the examination. *Wade* v. *Matthews*, MS., 5 Opin., 222.—JOHNSON, Atty.-Gen.; 1849.

See also DIGEST PAT. CASES, title APPLICATION FOR PATENTS, B.

(*e*) 1. The inventor must be the original inventor as to all the world, to be entitled to a patent. *Reutgen* v. *Kanowrs*, 1 Wash., 188.—WASHINGTON, J.; Pa., 1804. *Dawson* v. *Follen*, 2 Wash., 311.—WASHINGTON, J.; Pa., 1808. *Lowell* v. *Lewis*, 1 Mass., 190.—STORY, J.; Mass., 1817.

2. No person, who is not at once the first as well as the original inventor, by whom the invention has been perfected and put into use, is entitled to a patent. *Reed* v. *Cutter*, 1 Story, 596, 598.—STORY, J.; Mass., 1841.

3. A subsequent inventor, though an original one, is not entitled to a patent. *Ibid.*, 596–598.

4. The invention must be original with the inventor, and not known to others. The only exception exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known* in a *foreign* country, but not patented there, or described in any printed publication. *Parker* v. *Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

See also DIGEST PAT. CASES, titles INVENTOR, B.; INVENTION, C.

(*f*) An original application or specification cannot be amended, to conform the specification to the alterations suggested by the Commissioner, except under this section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

(*g*) Right of withdrawal extended to foreigners by act of 1837, section 12.

Right of withdrawal, as to applications made after March 2d, 1861, abolished by act of 1861, section 9.

As to the effect of a withdrawal, see DIGEST PAT. CASES, title APPLICATION FOR PATENTS, C.

(*h*) The renewal oath required by this section, is required only where the applicant persists in his application, after having been informed of the defects of his specification. If the rejection is final, though upon a first examination, no new oath is necessary to enable him to appeal. *Crooker, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

So much of this section as requires the renewal of the oath, repealed by the act of 1863, section 1.

(*i*) 1. By section 11, of the act of 1839, an appeal was given to the Chief Justice of the Circuit Court of the United States for the District of Columbia; and by section 12 of the same act, the board of examiners was abolished. The right of appeal was afterwards extended, by the act of 1852, section 4, to either of the assistant justices of such court.

2. By the act of 1863, section 3, establishing the Supreme Court of the District of Columbia, and abolishing the Circuit Court, the powers theretofore exercised by the judges of the Circuit Court were conferred upon the justices of the said Supreme Court, severally. Under this act, appeals are now taken to the justices of said Supreme Court.

3. An appeal lies under this section to an applicant, upon the refusal of a patent to him when there is no opposing party. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. There is nothing in the act of 1839 which takes away, or impairs such right. *Ibid.*

5. There is no limitation of time as to an appeal from the decision of the Commissioner of Patents. *Janney, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

As to right of appeal, duties of Commissioner of Patents in cases of, &c., see DIGEST PAT. CASES, title APPEALS, B.

See also notes to section 8 of this act, and notes to section 11 of the act of 1839.

SECTION 8. [Modified by act of 1839, § 6.] *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be (*a*); and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the

applicants is entitled to receive a patent as prayed for. (*b*) But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. (*c*) And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

(*a*) 1. The interference mentioned in this section must be an interference in respect to patentable matters, and the claims of the applicants must be limited to the matters specifically set forth as their respective inventions; and what is not claimed is to be considered, for the purpose of such interference, as disclaimed. A patentable improvement is not an interference. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

2. There can be no interference between applications, unless there is a substantial identity of the things for which a patent is sought. *Tyson* v. *Rankin*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

3. An interference may be declared between a pending application and an application for a reissue of an existing patent, but the omission to do so at that time does not take away the right of the Patent Office to declare such an interference subsequently. *Hicks* v. *Shaver*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

4. The Commissioner has authority to permit one of two competing applicants for a patent for a similar invention to withdraw his application, after decision upon an interference, and refile his application, and to declare a second interference between such last application and the competing one. *Wade* v. *Matthews*, 5 Opin., 224.—JOHNSON, Atty.-Gen.; 1849.

5. A second interference is only a rehearing of the same case. *Eames* v. *Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

6. The proceedings in contested cases in the Patent Office have no resemblance to trials at law. *Spear* v. *Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

See also DIGEST PAT. CASES, title INTERFERENCE.

(*b*) 1. The scope of this section is broad enough to include the question of *interference* as well as that of *priority*, if it should arise, on an appeal to the judge. The question of priority necessarily includes that of interference. *Bain* v. *Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

2. An appeal is given by section 7 to an applicant where there is no opposing party; and by this section where there are interfering applications; and there is nothing in the repealing act of 1839 which takes away or impairs such right. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

3. Under this section no appeal can be taken from the decision of the Commissioner of Patents, unless the *application* for a patent is rejected. In no case can an appeal be taken to the granting of a patent. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

4. A patentee therefore has no right of appeal from the decision of the Commissioner granting a patent to another person, an applicant, in an interference between such applicant and patentee. *Ibid.*

5. The word "either" in this section—when speaking of the parties who may appeal—applies to the words "such applicants," *i. e.*, *either of such applicants*. This construction is sustained by the language below authorizing the judge, on appeal, "to determine which or whether *either of the applicants* is entitled to *receive* a patent as *prayed* for. *Ibid.*

6. This decision was followed in *Whipple* v. *Renton*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854. *Hopkins* v. *Barnum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859. *Kingsley* v. *Herriet*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854. *Drake* v. *Cunningham*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

7. In a later case, it was held that a patentee has equal right of appeal from a decision of the Commissioner of Patents in favor of an applicant, and granting him a patent, that an applicant has from a decision in favor of a prior patentee, and refusing the applicant a patent. *Babcock* v. *Degener*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

8. This decision was followed in *Spear* v. *Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859; and *Beech* v. *Tucker*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

9. The right of appeal is now considered as established in accordance with these later decisions.

10. As to the requisites of the reasons of appeal, and the jurisdiction of the justices of the Circuit Court on appeal, and the effect of their decisions, see notes to section 11 of the act of 1839.

See also DIGEST PAT. CASES, title APPEALS, B.

(*c*) 1. By the act of 1839, section 6, the obtaining a foreign patent more than six months prior to his application here will not debar a person from receiving a patent, provided the invention has not been introduced into public and common use in the United States prior to such application.

2. The provisions of this section, and of section 6 of the act of 1839, as to the obtaining of patents after foreign patents have been secured, and as to the date of the home patent in such case, relates only to such patents as are *applied for* here *after* the issue of the foreign patent. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851.

SECTION 9. [Amended by act of 1861, § 10.] *And be it further enacted*, That before any application for a patent shall be considered by the Commissioner as aforesaid, the applicant shall pay into the Treasury of the United States, or into the Patent Office, or into any of the deposit banks (*a*), to the credit of the Treasury, if he be a citizen of the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars; if a subject of the king of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars (*b*); for which payment duplicate receipts shall be taken, one of which to be filed in the office of the Treasurer. And the moneys received into the Treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the Patent Fund.

(*a*) Fees may be sent to the Patent Office, or be paid to the Assistant Treasurers of the U. S. at New York City; Boston, Mass.; and St. Louis, Mo.: Treasurers of the Mint, Philadelphia, Pa.; and New Orleans, La.: Surveyor and Inspector of the Customs, Pittsburg, Pa.: Surveyor of the Customs, Cincinnati, O.: Collectors of the Customs at Baltimore, Md.; Buffalo Creek, N. Y.; and San Francisco, Cal.: Receivers of Public Moneys at Jeffersonville, Ind.; Chicago, Ill.; and Detroit, Mich.; and any National Bank which has been designated a depository of public money.

(*b*) By a subsequent statute, all laws fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are repealed, and a uniform rate of fees established for all. Act of 1861, section 10.

SECTION 10. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime (*a*); and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

(*a*) 1. Under this section, if an inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such persons in trust for the heirs-at-law or devisees of the inventor. *Stimpson* v. *Rogers*, 4 Blatchf.—INGERSOLL, J.; Ct., 1859.

2. It need not, however, be expressed in the patent, that it is issued to such executor *in trust* for those entitled to it. It will be sufficient that the patent set forth that it was issued to the grantee as executor. What the executor does in relation to the property of the devisor, he does in trust for those to whom such property is given by the will. *Ibid.*

SECTION 11. *And be it further enacted*, That every patent shall be assignable in law, either as to the whole

interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use (*a*) the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof (*b*), for which the assignee or grantee shall pay to the Commissioner the sum of three dollars. (*c*)

(*a*) 1. This section provides for but three kinds of assignments: 1st, As to the whole interest; 2d, As to an undivided part; and 3d, An exclusive right in any district. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 339.—GRIER, J.; Pa., 1849. *Potter* v. *Holland*, MS.—INGERSOLL, J.; Ct., 1858.

2. The term *exclusive* comprehends not only an exclusive right to the whole patent, but an exclusive right to the patent in a particular section of country. *Washburn* v. *Gould*, 3 Story, 131.—STORY, J.; Mass., 1844.

3. The monopoly is capable of subdivision as to locality, and in no other way. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849. *Whittemore* v. *Cutter*, 1 Gall., 431.—STORY, J.; Mass., 1813. *Brooks* v. *Byam*, 2 Story, 525, 552.—STORY, J.; Mass., 1843. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, J.; N. Y., 1846. *Ritter* v. *Serrell*, 2 Blatchf., 383.—BETTS, J.; N. Y., 1852. *Washing Mach. Co.* v. *Earle*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

4. An assignment of a patent may be made as well before the issuing of the patent as afterwards. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates. And when the party has acquired an inchoate right, an assignment of it is legal. *Gayler* v. *Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850. *Rathbone* v. *Orr*, 5 McLean, 131, 132.—MCLEAN, J.; Mich., 1850. *Rich* v. *Lippincott*, 26 Jour. Fr. Inst., 3d Ser., 13.—GRIER, J.; Pa., 1853.

5. Future improvements may be sold, as well as those already made; and to include a second as well as a first patent. *Nesmith* v. *Calvert*, 1 Wood & Min., 41.—WOODBURY, J., Mass., 1845.

6. The inchoate right of an inventor to a renewal is the subject of sale. *Clum* v. *Brewer*, 2 Curt., 520.—CURTIS, J.; Mass., 1855.

7. One tenant in common has as good right to use and sell to others to use the thing patented, as the other tenant in common has; and neither can restrain the other from such use or sale. *Ibid.*, 524.

8. A paper purporting to be an assignment of an expired patent is void. *Bell* v. *McCullogh*, MS.—LEAVITT, J.; Ohio, 1858.

(*b*) 1. The provision as to recording assignments within three months is merely directory, and except as to intermediate *bona fide* purchasers, without notice, any subsequent recording is sufficient. *Brooks* v. *Byam*, 2 Story, 542.—STORY, J.; Mass., 1843. *Pitts* v. *Whitman*, 2 Story, 615.—STORY, J.; Mass., 1843. *Blanch. Gun-Stock Fac.* v. *Warner*, 1 Blatchf, 271.—NELSON, J.; Ct., 1846. *Holden* v. *Curtis*, 2 N. Hamp., 63.—WOODBURY, J.; N. H., 1819.

2. A mere license need not be recorded—it is not an exclusive right. *Brooks* v. *Byam*, 2 Story, 542, 543.—STORY, J.; Mass., 1843. *Stevens* v. *Head*, 9 Verm., 177.—WILLIAMS, Ch. J.; Vt., 1837.

3 Under this section an assignment must be recorded within three months to defeat the right of a subsequent purchaser without notice, and for a valuable consideration. In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office. Within that period he must protect himself in the best way he can, as an unrecorded assignment would prevail; but it must be one in writing, that may be recorded. *Gibson* v. *Cook*, 2 Blatchf., 148.—NELSON, J.; N. Y., 1850.

See also DIGEST PAT. CASES, titles ASSIGNMENT, B. 2; LICENSE, B.

(*c*) For existing fees for recording assignments, see act of 1861, section 10.

SECTION 12. [Amended by act of 1861, §§ 9, 10.] *And be it further enacted*, That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the Treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars (*a*), file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same.

And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be duty of the Commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application (*b*), who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided, however*, That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

(*a*) 1. The fee required on filing a caveat is now reduced to ten dollars, and such sum is no longer to be considered as a part of the sum required to be paid on filing a subsequent application for a patent for the same invention. Act of 1861, sections 9, 10.

2. A caveat may be renewed at the end of one year by paying a further fee of ten dollars, and so on from year to year.

(*b*) 1. This section is for the benefit of the inventor, but is not necessary for the preservation of his right, nor does the omission to file a caveat impair his tile. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. It only enables him to have notice of any interfering application. It, however, gives no notice to the world, nor even to the interfering applicant, and is notice to the Commissioner only. *Ibid.*

3. The caveat is to set forth the "design and purpose" of the inven-

tion, and "its principal and distinguishing characteristics;" but it is not necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distinguished from other inventions. *Anon.*, MS., Opin.—BLACK, Atty.-Gen.; 1857.

4. The Commissioner can perform no act upon it, but filing it, nor in consequence of it, except to give the caveator notice of a conflicting application. *Ibid.*

5. A caveat answers a double purpose: 1st, to give notice of the claim of the inventor; and 2d, to prevent a patent issuing to another for the same thing. *Allen* v. *Hunter*, 6 McLean, 304.—MCLEAN, J.; Ohio, 1855.

6. A caveat is evidence as to an invention, so far as it extends to the *description* of the invention and the machinery which was then constructed. *Jones* v. *Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

7. A caveat is not conclusive evidence that an invention is not perfected. *Johnson* v. *Root*, MS.—SPRAGUE, J.; Mass., 1858.

8. The fact that a patent is granted to one person, while another has a caveat pending and in force, will not of itself vacate the patent granted, nor authorize the Commissioner to grant a patent to the caveator. *Cochrane* v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

9. The purpose of a caveat is to save the discoverer of an invention from the effect of the rule of law that gives to the inventor who first adapts his invention to practical use the right to the grant of a patent; and if the Commissioner gives the caveator notice of any interfering application, it secures him against the effect of the rule. *Phelps, Dodge & Co.* v. *Brown Bros.*, 18 How. Pr., 9.—NELSON, J.; N. Y., 1859.

10. But if the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. *Ibid.*, 9.

See also DIGEST PAT. CASES, title CAVEAT.

SECTION 13. [Amended by act of 1837, §§ 5–8; Repealed in part by act of 1861, § 9.] *And be it further enacted*, That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or

deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. (*a*) And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. (*b*) And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. (*c*) And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification; and the Commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall hereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification. (*d*)

(*a*) 1. This section contemplates two classes of cases, where a patent is *invalid or inoperative;* 1st, by reason of a defective or insufficient

specification; and 2d, where the same objection arises because the patentee has claimed more than he had a right to claim. *Goodyear* v. *Day*, MS.—DICKERSON, J.; N. J., 1852.

2. This section may be regarded as affirming the propriety of the usage which had obtained under the former laws, and under which a second reissue was allowed as well as the first. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851.

3. There may be more than one reissue of the same patent. The surrender and reissue should be allowed to follow each other as often as the inventor is content to be more specific or more modest in his claims. *Ibid.* Also *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

4. The power to correct mistakes in a patent is confided to the Commissioner of Patents under this section, and does not belong to the courts. The courts can only construe the specification and claim as it stands. *Kittle* v. *Merriam*, 2 Curt., 478.—CURTIS, J.; Mass., 1855.

5. This section gives to the patentee the right to correct his description or specification, when its imperfection has arisen from inadvertency, accident, or mistake. But the only condition on which this can be done, is that the original patent is *inoperative* or invalid by reason of a failure to comply with the requirements of the statutes. The proceeding is therefore equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling a patentee to an action for its infringement. *Morfitt* v. *Gaab*, MS.—LEAVITT, J.; Ohio, 1860.

6. The words in this section, "it shall be *lawful* for the Commissioner, &c., to cause a new patent to be issued," are to be construed as *mandatory*, and to be of the same import as if the words had been, "it *shall be the duty* of the Commissioner," &c. The true meaning is, the Commissioner is to have no discretion in the case provided for in the section. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

7. When the case provided for arises, he is *commanded* to exercise the power, whether he thinks it just and right to exercise it or not; he has no discretion. *Ibid.*

8. The surrender and reissue of a patent extended by act of Congress, after an extension, under section 18 of the act of 1836, stands on the same footing as if such surrender and reissue were made under the extension by virtue of said section 18. *Gibson* v. *Harris*, 1 Blatchf., 169, 170.—NELSON, J.; N. Y., 1846.

9. It is not the meaning of this section that the patentee, in his reissue, must describe and claim in his new specification, either in words or idea, just what he described and claimed in his old one; but his specification must be of the same invention, and he cannot embrace a different subject-matter than that he sought to patent originally. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851. *Battin* v. *Taggart*, 17 How., 83.—MCLEAN, J.; Sup. Ct., 1854.

10. Upon an application for a reissue, the applicant is not necessarily

confined to the original *record*, *i. e.*, the patent and specification, but the original model may be referred to as evidence of the then invention. *Wilson* v. *Singer*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860. *Ball*, *Ex parte*, MS. (App. Cas.), and *Dietz*, *Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

11. Fee on reissue now thirty dollars. Act of 1861, § 10.

See also DIGEST PAT. CASES, title REISSUE OF PATENT, B., C.

(*b*) 1. Under this section the power to surrender a patent and take out a renewal thereof, is vested exclusively in the patentee, his executors, administrators, or assigns, and there is nothing restricting such right because of special or limited grants of licenses previously made. *Smith* v. *Mercer*, 4 West. Law Jour., 52.—KANE, J.; Pa., 1846.

2. By this section the sole right to surrender is given, 1st, to the patentee, if he is alive and has made no assignment of the original patent; 2, to the executors and administrators of the patentee, after his decease, where there has been no such assignment; and 3d, to the assignee, where there has been an assignment of the original patent. The right to surrender is given to no one else. *Potter* v. *Holland*, MS. —INGERSOLL, J.; Ct., 1858.

3. Where, however, there has been an assignment of an undivided part of the whole patent, in such case the assignee and patentee become joint owners, and should join in the surrender; and if they do not it will be invalid, unless the part owner not joining shall ratify it. *Ibid.*

4. A licensee has no authority to make a surrender, and one made without his consent is valid. But such a licensee may hold under the original or the reissued patent, as he prefers. *Ibid.*

5. There may be a claim of right in an invention, under one or the old patent, for one section of the country, and a different claim of right, under the reissued patent, for the same invention, for another section of country. *Ibid.*

See also DIGEST PAT. CASES, title REISSUE OF PATENT, A.

(*c*) 1. Under this section the second patent, with corrected specifications, has relation back to the emanation of the first patent, as fully for every legal purpose as to causes subsequently accruing, as if the second patent had been issued at the date of the first one. *Stanley* v. *Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839.

2. A reissued patent is only a continuation of the original one. *Ames* v. *Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833. *Stanley* v. *Whipple*, 2 McLean, 37.—MCLEAN, J.; Ohio, 1839. *Woodworth* v. *Hall*, 1 Wood. & Min., 257.—WOODBURY, J.; Mass., 1846.

3. The rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw* v. *Cooper*, 7 Pet., 315.—MCLEAN, J.; Sup. Ct., 1833.

4. A patentee cannot by a surrender affect the rights of third persons to whom he had previously conveyed an interest. *Woodworth* v. *Stone*, 3 Story, 750.—STORY, J.; Mass., 1845. *McBurney* v. *Goodyear*, 11 Cush., 370.—MERRICK, J.; Mass., 1853.

5. The grant of an amended patent is conclusive as to the existence of the facts necessary for a reissue; unless it is patent there is a clear excess of authority, or there has been fraud. *Allen* v. *Blunt*, 3 Story, 745.—STORY, J.; Mass., 1845. *S. C.*, 2 Wood. & Min., 139.—WOODBURY, J.; Mass., 1846. *Battin* v. *Taggart*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854.

(*d*) 1. Under this section an improvement may be annexed to the specification of the original patent, so as to make it form a part of the original patent; but there is nothing that forbids an inventor taking out a new patent for the improvement, if he prefers it. *O'Reilly* v. *Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

2. Nor is he bound in his new patent to refer specially to his former one. *Ibid.*, 122.

3. The provision of this section authorizing additions to patents for improvements, is now repealed, and patents of additions are no more granted. Act of 1861, § 9.

SECTION 14. *And be it further enacted*, That whenever, in any action for damages for making, using, or selling (*a*) the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof (*b*), according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States. (*c*)

(*a*) The sale, under execution, of the *materials* of patented articles is not such a sale as makes the sheriff liable to an infringement. *Sawin* v. *Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

(*b*) 1. The patent act of 1790, section 4, made the infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, section 5, declared that an infringer should pay a sum

equal to three times the price for which the patentee had sold licenses. The act of 1800 provided that an infringer should pay three times the actual damages sustained. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853.

2. This section confines the jury to the actual damages sustained by the patentee. The power to increase them as punitive damages is committed to the discretion and judgment of the court. *Ibid.*, 488.

3. *Actual damages*, according to this section, are the amount fixed by the verdict. *Stephens* v. *Felt*, 2 Blatchf., 38.—BETTS, J.; N. Y., 1846.

4. But such term cannot be construed to mean exemplary, vindictive, or punitory damages, inflicted by way of smart money. *Stimpson* v. *Railroads*, 1 Wall., Jr., 169.—GRIER, J.; Pa., 1847. *Buck* v. *Hermance*, 1 Blatchf., 406.—NELSON, J.; N. Y., 1849. *Pitts* v. *Hall*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

5. Damages are only to be compensatory: the criterion is indemnity. *Parker* v. *Hulme*, 7 West. Law Jour., 428.—KANE, J.; Pa., 1849.

6. Damages cannot include counsel fees, in addition to the taxable costs. *Stimpson* v. *Railroads*, 1 Wall., Jr., 166, 169.—GRIER, J.; Pa., 1847. *Blanch. Gun-Stock Fac.* v. *Warner*, 1 Blatchf., 272.—NELSON, J.; Ct., 1846. *Parker* v. *Hulme*, 7 West. Law Jour., 429.—KANE, J.; Pa., 1849. *Teese* v. *Huntington*, 23 How., 8.—CLIFFORD, J.; Sup. Ct., 1859.

7. It rests with the discretion of the court whether the damages shall be trebled. Previous to 1836, the court was compelled to treble them. *Guyon* v. *Serrell*, 1 Blatchf., 245.—NELSON, J.; N. Y., 1847. *Stimpson* v. *Railroads*, 1 Wall., Jr., 166.—GRIER, J.; Pa., 1847.

8. The court may increase the damages though the plaintiff is not entitled to costs, for neglect of filing a disclaimer, as required by section 9 of the act of 1837. *Guyon* v. *Serrell*, 1 Blatchf., 246.—NELSON, J.; N. Y., 1847.

9. The object of this section, as to trebling damages, is to remunerate patentees, who were compelled to sustain their patents against wanton and persistent infringers. *Seymour* v. *McCormick*, 16 How., 488.—GRIER, J.; Sup. Ct., 1853. *Bell* v. *McCulloch*, MS.—LEAVITT, J.; Ohio, 1858.

See also DIGEST PAT. CASES, titles DAMAGES; INFRINGEMENT.

(*c*) 1. The word "assignees" in this section, is to be construed by reference to section 11, of the same act, as meaning the assignees of a whole interest, or an undivided one, or an exclusive local right. *Blanchard* v. *Eldridge*, 1 Wall., Jr., 340.—GRIER, J.; Pa., 1849. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

2. To enable an assignee to sue in his own name, he must have the exclusive right, or entire, or unqualified monopoly, which the patentee had, excluding the patentee himself as well as others. *Gayler* v. *Wilder*, 10 How., 493.—TANEY, Ch. J.; Sup. Ct., 1850.

3. The assignees of an exclusive right in a patent, are the proper persons to maintain an action for a violation of it. *Washburn* v. *Gould*, 3 Story, 131, 167.—STORY, J.; Mass., 1846.

4. The grantee of an exclusive right under a patent, even though such right is limited to a particular number of machines, may maintain an action for infringement. *Wilson* v. *Rosseau*, 4 How., 686, 688.—NELSON, J.; Sup. Ct., 1845.

5. Under this section, in connection with section 11, an action is given only to such party—composed of one or more persons—as possesses the whole interest in the patent. *Suydam* v. *Day*, 2 Blatchf., 23.—NELSON, BETTS, JJ.; N. Y., 1846.

6. Where a party has an interest in only a part of a patent, as a license to use the invention, he cannot maintain an action for an infringement. *Ibid.*, 23.

7. Under this section, an action is properly brought in the name of a patentee, in behalf of a licensee who is damaged by an infringement. *Goodyear* v. *McBurney*, 3 Blatchf., 33.—NELSON, J.; N. Y., 1853.

SECTION 15. [Enlarged by act of 1837, § 9; and by act of 1839, § 7.] *And be it further enacted*, That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence (*a*), of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial (*b*), tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public (*c*), or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new (*d*), or that it had been described in some public work anterior to the supposed discovery thereof by the patentee (*e*), or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent (*f*), or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was

using reasonable diligence in adapting and perfecting the same (*g*); or that the patentee, if an alien at the time the patent was granted, had failed and neglected for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued (*h*); in either of which cases judgment shall be rendered for the defendant with costs. And whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used (*i*): *Provided, however*, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. (*j*) *And provided, also*, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court, to adjudge and award as to costs as may appear to be just and equitable. (*k*)

(*a*) 1. The right to plead the general issue and give notice, is an en-

largement of the defendant's mode of defence, but does not take away his right to plead specially. *Phillips* v. *Combstock*, 4 McLean, 525.—McLEAN, J.; Ind., 1849.

2. The defendant need not plead the general issue, and give notice of the special matter. He may plead specially, and then the plea is the only notice. *Evans* v. *Eaton*, 3 Wheat., 504.—MARSHALL, Ch. J.; Sup. Ct., 1818. *Grant* v. *Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832. *Phillips* v. *Combstock*, 4 McLean, 525.—McLEAN, J.; Ind., 1849. *Smith* v. *Ely*, 15 How., 141.—TANEY, Ch. J.; Sup. Ct., 1853. *Day* v. *N. E. Car-Spring Co.*, 4 Blatchf., 181.—BETTS, J.; N. Y., 1854.

3. But where notice of special matter is given under the general issue, special pleas containing the same matters cannot be filed. *Wilder* v. *Gayler*, 1 Blatchf., 597.—NELSON, J.; N. Y., 1850. *Brunswick* v. *Holzalb*, MS.—LEAVITT, J.; Ohio, 1858.

(*b*) 1. No order of court is necessary to entitle a defendant to file and serve notice of special matter. It is only necessary that it be in writing and be served thirty days before the trial. *Teese* v. *Huntington*, 23 How., 10.—CLIFFORD, J.; Sup. Ct., 1859.

2. If a first notice is defective or not sufficiently comprehensive, other notices may be given to remedy the defect or supply the deficiency. *Ibid.*, 10.

3. Under such notice, depositions taken before it was served, as well as those taken afterwards, are admissible. *Ibid.*, 10.

4. Notices may be served in term time, but must be thirty days before trial. *Latta* v. *Shawk*, MS.—LEAVITT, J.; Ohio, 1859.

5. Such notices cannot, however, be filed and served in suits in equity. *Doughty* v. *West*, MS.—NELSON, SHIPMAN, JJ.; N. Y., 1865.

(*c*) 1. It is a question for the jury whether the specification contains the whole truth relative to the discovery; and, if not, whether it has been concealed with a view to deceive. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. A defect or concealment is not fatal, unless made with an intention to deceive. *Whittemore* v. *Cutter*, 1 Gall., 437.—STORY, J.; Mass., 1813. *Gray* v. *James*, Pet. C. C., 409.—WASHINGTON, J.; Pa., 1817. *Lowell* v. *Lewis*, 1 Mass., 188, 189.—STORY, J.; Mass., 1817.

3. The question as to the materiality of the thing concealed is, could an artist, after the expiration of the patent, construct a machine by looking at the specification. *Reutgen* v. *Kanowrs*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

(*d*) 1. The defence "that the patentee was not the original and first inventor or discoverer of the thing patented," is complete without showing that the first inventor had put his invention in practice. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. No person who is not at once the first and original inventor, is entitled to a patent. A subsequent inventor, though an original one, is not. *Reed* v. *Cutter*, 1 Story, 596.—STORY, J.; Mass., 1841.

See also DIGEST PAT. CASES, title INVENTOR, B.

(*e*) 1. The description in a public work must be sufficiently full and precise to enable a mechanic to construct the machine, and must be in all material respects like that covered by the plaintiff's patent. *Parker* v. *Stiles*, 5 McLean, 61.—McLean, J.; Ohio, 1849.

2. The publication may be proved as to its contents, and the fact of publication by the production of the book, or by parol testimony. *Allen* v. *Hunter*, 6 McLean, 314.—McLean, J.; Ohio, 1855.

3. The publication must have been prior to the *time of invention*. It is not sufficient that it was prior to the time of *application* for a patent. *Bartholomew* v. *Sawyer*, MS.—Ingersoll, J.; N. Y., 1859. *Allen* v. *Hunter*, 6 McLean, 314.—McLean, J.; Ohio, 1855.

4. To render admissible in evidence a printed publication it is not necessary to make proof of the date of its publication. A book purporting on its title-page to be published in a certain year will be received without proof that it was then published. *Judson* v. *Cope*, MS.—Leavitt, J.; Ohio, 1860.

5. A book of plates without any letter-press cannot be admitted in evidence. *Semble*, that it is not a "printed publication." *Ibid.*

6. Where reference is made to a public work, it should be to the particular part of the work intended to be relied upon. A reference merely to the title of the work is not sufficient. *Foote* v. *Silsby*, 1 Blatchf., 454, 462.—Conkling, Nelson, JJ.; N. Y., 1849. *Silsby* v. *Foote*, 14 How., 222.—Curtis, J.; Sup. Ct., 1852.

See also Digest Pat. Cases, title Public Work.

(*f*) 1. The public use or sale, to defeat the inventor of a right to a patent, must be a public use or sale by others with his knowledge and consent before his application for a patent. *Ryan* v. *Goodwin*, 3 Sumn., 518.—Story, J.; Mass., 1839. *Wyeth* v. *Stone*, 1 Story, 281.—Story, J.; Mass., 1840. *Gayler* v. *Wilder*, 10 How., 496, 498.—Taney, Ch. J.; Sup. Ct., 1850. *Pitts* v. *Hall*, 2 Blatchf., 235, 236.—Nelson, J.; N. Y., 1851. *Hunt* v. *Howe*, MS. (App. Cas.)—Morsell, J.; D. C., 1855.

2. A use without the inventor's knowledge or consent, or experimental to ascertain its value, utility, or success, or a use intermediate the application and grant, will not be sufficient. *Ryan* v. *Goodwin*, 3 Sumn., 518.—Story, J.; Mass., 1839. *Wyeth* v. *Stone*, 1 Story, 281.—Story, J.; Mass., 1840. *Pierson* v. *Eagle Screw Co.*, 3 Story, 407.—Story, J.; R. I., 1844. *Winans* v. *N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 322.—Nelson, J.; N. Y., 1855.

3. The right to use and sell an invention for two years previous to the application is now conferred by act of 1839, section 7.

See also Digest Pat. Cases, titles Abandonment, A.; Public Use.

(*g*) 1. An inventor who has first actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at the time using due diligence in adapting and perfecting his invention. *Reed* v. *Cutter*, 1 Story, 599.—Story, J.; Mass., 1841.

2. But the first inventor has the prior right if he is using due dili-

gence, even though another may have first perfected the invention. *Ibid.*, 600.

3. The clause using "reasonable diligence in adapting and perfecting" an invention is applicable only to the case of a defence that the plaintiff's patent had been surreptitiously or unjustly obtained; and if pleaded, it may be necessary for the defendant to show, in order to vacate the patent, that he was using due diligence when the patent was obtained. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

4. The words "unless such person was using reasonable diligence in adapting and perfecting the same," constitute a *qualification* of the preceding language of the section, so that an inventor who has actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was *in fact invented* by another, *unless the latter* was at the time *using reasonable diligence* in adapting and perfecting the same. *Marshall* v. *Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

5. The defence that the patentee had "surreptitiously and unjustly obtained a patent for that which was in fact invented or discovered by another, who was using reasonable diligence in perfecting and adapting the same," does not necessarily imply bad faith on the part of the patentee against whose patent this defence is set up. The words were intended to be used, and are used, in their broadest sense. *Phelps, Dodge & Co.*, v. *Brown Bros.*, 18 How. Pr.—NELSON, J.; N. Y., 1859.

6. If a person does not use due diligence in perfecting his invention after he has conceived the idea, and another conceives the idea and perfects it, and applies it to use, the latter will be considered the first inventor, and a patent granted the former will be void. *Ransom* v. *Mayor, &c., of New York*, MS.—HALL, J.; N. Y., 1856.

(*h*) 1. An alien patentee must put and continue on sale his invention within eighteen months from the date of his patent. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J. D. C., 1841.

2. The assignees of an alien patentee take their patent with all the privileges of American citizens. The alien clause in this section does not apply to such assignees. *Tatham* v. *Lowber*, 2 Blatchf., 50, 51.—NELSON, J.; N. Y., 1847.

3. But it is not necessary that an alien patentee, or his assignee, should take active measures for putting his patented invention in the market, and forcing a sale, but only that he should at all times be ready to sell at a fair price when a reasonable offer is made. *Ibid.*, 51. *Tatham* v. *Le Roy*, MS.—NELSON, J.; N. Y., 1849.

(*i*) 1. The provision in this section, requiring notice of prior knowledge and use, was intended to guard against surprise from such evidence as was given in Whitney's case. Though his invention was one of undoubted originality, two persons were brought forward, one of whom testified that he had seen such an invention in England seven-

teen years before, and the other that he had seen one in Ireland. *Wilton* v. *Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847.

2. The provision of the statute requiring notice of the previous use, is designed to give the patentee the benefit of examining into the facts of the supposed prior use. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

3. This section requires only the names and residences of the persons who possessed the prior knowledge, and of the places where the invention had been used. The names and residences of the witnesses need not be given. *Wilton* v. *Railroads*, 1 Wall., Jr., 195.—GRIER, J.; Pa., 1847. *Many* v. *Jagger*, 1 Blatchf., 376.—NELSON, J.; N. Y., 1848.

4. Notice of the *time* of the prior knowledge or use is not required. *Phillips* v. *Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

5. In the seventh circuit, the notice must specify the street or factory where the prior structure was used, or the name of the person or owner using it. The name of the city, or town, or county, is not sufficiently definite as to place. *Latta* v. *Shawk*, MS.—LEAVITT, J.; Ohio, 1859. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

6. And also, the name of the person by whom the prior knowledge is to be proved. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

See also DIGEST PAT. CASES, title GENERAL ISSUE, B.

(*j*) 1. The provision of section 7 and of this section introduced an important modification into the laws of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity by the existence of a secret invention or discovery abroad, that is a discovery not patented, and not described in any printed publication. *Anon.*, 5 Opin., 21.—TOUCEY, Atty.-Gen., 1848.

2. The only exception to the rule that a patentee must be the original and first inventor, exists in the case of a party obtaining a patent, believing himself to be the original inventor, and his invention is shown to have been *known in a foreign country*, but not patented there, or described in a printed publication. *Parker* v. *Stiles*, 5 McLean, 61.—MCLEAN, J.; Ohio, 1849.

3. In determining whether the patentee *believed* himself to be the first inventor, the defendant may give evidence that the patentee knew of the existence of the thing abroad; and in considering the fact whether he so *believed* himself to be the first inventor, it is material to determine whether he was in fact the original inventor. *Forbush* v. *Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

4. A prior use of a thing in a foreign country will not invalidate a patent subsequently taken out here, where the inventor believed himself to be the first inventor, unless the prior invention had been patented, or described in some printed publication. *Coleman* v. *Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

5. Evidence cannot be received of an actual use and knowledge of an invention in a foreign country, prior to the time of the invention

here, but the defendants must be confined to the description of the invention as found in printed publications or patents; they cannot go beyond such publications or patents. *Judson* v. *Cope*, MS.—LEAVITT, J.; Ohio, 1860.

6. The time referred to in this section by the terms "having been before known and used in any foreign country," or "had been patented or described in any printed publication," is the time when the original discovery or invention of a patentee was made, and not the time when he presented his application for a patent. *Bartholomew* v. *Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

7. A foreign patent, in order to defeat an American patent for the same invention, must have been before the discovery or invention here; it is not sufficient that it is before the application. *Howe* v. *Morton*, MS.—SPRAGUE, J.; Mass., 1860.

8. An invention is not "patented" in England within the meaning of this section, until the complete specification has been enrolled—until the invention shall have been made patent to the world, which is usually six months after the date of the patent. *Ibid.*

(*k*) The second proviso of this section virtually superseded by the act of 1837, section 9.

SECTION 16. [Enlarged by act of 1839, § 10.] *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners (*a*), on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise (*b*), in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive

a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. (*c*) And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided, however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

(*a*) Of the justices of the Supreme Court of the District of Columbia, appeals now lying to them under section 3 of the act of 1863, establishing that court. Previous to that act appeals lay, by the act of 1839, section 11, to the chief-justice, and, by the act of 1852, section 1, to the assistant justices of the Circuit Court of the District of Columbia.

(*b*) The provisions of this section are now extended "to all cases where patents are refused for any reason whatever." Act of 1839, section 10.

(*c*) 1. Proceedings, under this section and section 10 of the act of 1839, in equity, against the Commissioner of Patents, to compel him to issue a patent, must be commenced in the Circuit Court of the United States for the District of Columbia, and the Circuit Courts in the various States have no jurisdiction. *Prentiss* v. *Ellsworth*, Mir. Pat. Off., 35, 36.—RANDALL, J.; Pa., 1846.

2. Upon a bill filed under this section and section 10 of the act of 1839, to declare a patent granted by the Commissioner invalid or inoperative, the hearing is altogether independent of that before the Commissioner, and takes place upon such testimony as the parties may see fit to produce, agreeably to the rules and practice of a court of equity. The evidence before the Commissioner is not evidence in such a suit except by consent of parties; nor are the parties restricted to the testimony used before the Commissioner. Either party is at liberty to introduce additional evidence. *Atkinson* v. *Boardman*, MS.—NELSON, J.; N. Y., 1851.

3. The assignee of an invention, by virtue of an assignment made before patent issued, may file a bill in his own name under this section and section 10 of the act of 1839, against a patentee to whom a patent issued on the rejection of his assignor's application, for the purpose of annulling the patent so issued, and having one granted to him as assignee. And such assignment need not have been recorded before

suit brought; it will be sufficient if it is recorded at any time before the issuing of the patent. *Gay* v. *Cornell*, 1 Blatchf., 509, 510.—NELSON, J.; N. Y., 1849.

4. The Circuit Courts of the United States have exclusive jurisdiction under this section. *Gibson* v. *Woodworth*, 8 Paige, 134.—WALWORTH, Chan.; N. Y., 1840.

SECTION 17. [Enlarged by act of 1861, chap. 37.] *And be it further enacted*, That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the Circuit Courts of the United States, or any District Court having the power and jurisdiction of a Circuit Court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable (*a*): *Provided, however*, That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of Circuit Courts, and in all other cases in which the court shall deem it reasonable to allow the same. (*b*)

(*a*) 1. Under this section the Circuit Courts of the United States have not only original, but exclusive cognizance of all actions arising under the patent laws. *Dudley* v. *Mayhew*, 3 Comst., 14.—STRONG, J.; N. Y., 1849. *Elmer* v. *Pennel*, 40 Maine, 434.—RICE, J.; Me., 1855. *Parsons* v. *Barnard*, 7 John., 144.—CURIAM; N. Y., 1810.

2. The jurisdiction conferred upon the Circuit Courts by this section is the same in its nature and extent as the equity jurisdiction in Eng-

land, from which it is derived. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

3. Under this section the Circuit Courts have jurisdiction irrespective of the right of the plaintiff to an injunction or a demand for one. *Nevins* v. *Johnson*, 3 Blatchf., 83.—NELSON, BETTS, JJ.; N. Y., 1853.

4. The natural interpretation of the language of this section seems to be, that Congress has betowed upon this court a common jurisdiction, both on its law and equity sides, over all cases under the patent laws, and that no suit of that character can be maintained at law which may not also be prosecuted in equity. *Ibid.*, 83.

5. In cases arising under the patent law, the jurisdiction of the Circuit Courts does not depend upon the citizenship of the parties to the action, or the amount in controversy, but upon the subject-matter. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849. *Goodyear* v. *Union Rub. Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

6. The jurisdiction as to subject-matter does not extend to a bill in equity filed for the specific performance of a contract respecting patents. *Nesmith* v. *Calvert*, 1 Wood. & Min., 37.—WOODBURY, J.; Mass., 1845. *Brooks* v. *Stolley*, 3 McLean, 525.—MCLEAN, J.; Ohio, 1845. *Burr* v. *Gregory*, 2 Paine, 426, 429.—THOMPSON, J.; N. Y., 1828.

7. Nor to a suit brought to enforce the covenants of a license granted under a patent. *Goodyear* v. *Union Rub. Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

8. Section 11 of the judiciary act of 1789 requiring one of the parties, plaintiff or defendant, to be an inhabitant of the State where the suit is brought, does not apply to actions arising under the patent laws. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849.

9. To give the courts jurisdiction, the party defendant must be an inhabitant of the district in which the suit is brought, or he must be found within it at the time of the service of the original process. The provisions of section 11 of the act of 1789, in this respect, apply to patent actions. *Day* v. *Newark Ind. Rub. Co.*, 1 Blatchf., 631, 632.—NELSON, J.; N. Y., 1850. *Allen* v. *Blunt*, 1 Blatchf., 486.—NELSON, J.; N. Y., 1849. *Wilson* v. *Sherman*, 1 Blatchf., 541.—NELSON, J.; N. Y., 1850. *Brown* v. *Shannon*, 20 How., 56.—TANEY, Ch. J.; Sup. Ct., 1857. *Chaffee* v. *Hayward*, 20 How., 215.—CATRON, J.; Sup. Ct., 1857.

See also DIGEST PAT. CASES, title COURTS, B. 2.

(*b*) 1. Other reasonable cases under this section in which appeals and writs of error may be allowed to the Supreme Court, must be limited to cases which relate to the construction of the patent laws, and such as involve important and not trifling matters connected with those laws, and questions really doubtful. *Allen* v. *Blunt*, 2 Wood. & Min., 157.—WOODBURY, J.; Mass., 1846. *Sizer* v. *Many*, 16 How., 103.—TANEY, Ch. J.; Sup. Ct., 1853.

2. Under this section, if a writ of error is allowed by the court as "reasonable," such writ must bring up the whole case for consideration, and the court below cannot decide as to what particular points

shall be taken up. *Hogg* v. *Emerson*, 6 How., 478.—WOODBURY, J.; Sup. Ct., 1847.

3. An appeal or writ of error now lies to the Supreme Court from all judgments and decrees of any Circuit Court rendered in any action arising under the patent laws, without regard to the value or amount in controversy. Act of 1861, chap. 37.

See also DIGEST PAT. CASES, titles APPEALS, A.; WRIT OF ERROR.

SECTION 18. [Amended by act of 1848, § 1; act of 1861, §§ 12, 16.] *And be it further enacted*, That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof (*a*); and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury (*b*), as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. (*c*) And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, shall constitute a board (*d*) to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss

and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. (*e*) And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein (*f*): *Provided, however*, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued. (*g*)

(*a*) 1. In this section the word *patentee* is used as equivalent to *inventor*. *Woodworth* v. *Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844.

2. This section authorizes the extension of a patent on the application of an administrator. *Nyman's Case*, 3 Opin., 446.—GRUNDY, Atty.-Gen.; 1839. *Van Hook* v. *Scudder* (cited 3 Story, 132; 3 McLean, 438).—THOMPSON, J.; N. Y., 1843. *Brooks* v. *Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843. *Brooks* v. *Bicknell*, 3 McLean, 436.—MCLEAN, J.; Ohio, 1844. *Woodworth* v. *Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844. *Woodworth* v. *Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

3. And this, though the patentee during his lifetime had disposed of all his interest in the existing patent, and having at the time of his death no interest in it. *Wilson* v. *Rosseau*, 4 How., 675, 686, 688.—NELSON, J.; Sup. Ct., 1845.

See also DIGEST PAT. CASES, title EXTENSION OF PATENT, A.

(*b*) The fee is now fifty dollars on the application for an extension, and fifty dollars when the extension is granted. Act of 1861, § 10.

(*c*) 1. The notice of application for an extension is intended to protect the public, and give all an opportunity to appear and oppose. *Gale's Case*, 3 Opin., 594.—GILPIN, Atty.-Gen.; 1840.

2. Application must now be made at least ninety days before the expiration of the patent, and the notice must be published at least sixty days before such expiration. Act of 1861, § 12.

(*d*) Commissioner of Patents substituted for this board by act of 1848, section 1.

(*e*) 1. The right of renewal is not limited to future patents, but applies to the past. *Woodworth* v. *Sherman*, 3 Story, 176.—STORY, J.; Mass., 1844. *Wilson* v. *Turner*, 7 Law Rep., 529.—TANEY, Ch. J.; Md., 1845.

2. This section provides for but one extension. *Gibson* v. *Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

3. The decision of the Board of Commissioners, under this section, is conclusive within the scope of its authority. *Brooks* v. *Bicknell*, 3 McLean, 258.—MCLEAN, J.; Ohio, 1843. *Wilson* v. *Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845. *Woodworth* v. *Stone*, 3 Story, 753. —STORY, J.; Mass., 1845. *Colt* v. *Young*, 2 Blatchf., 473, 474.—NELSON, J.; N. Y., 1852. *Battin* v. *Taggert*, 17 How., 84.—MCLEAN, J.; Sup. Ct., 1854. *Clum* v. *Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

4. A renewed patent confers the same rights with an original patent. *Evans* v. *Jordan*, 1 Brock., 254.—MARSHALL, Ch. J.; Va., 1813.

5. After an extension, the original patent becomes one virtually for twenty-one years. *Gibson* v. *Harris*, 1 Blatchf., 169.—NELSON, J.; N Y., 1846.

6. If extended again by act of Congress, it becomes one for twenty eight years. *Woodworth* v. *Edwards*, 3 Wood. & Min., 125.—WOODBURY, J.; Mass., 1847.

7. Patents may also be extended by act of Congress, after having been once extended, under this section. *Evans* v. *Eaton*, Pet. C. C., 337.—WASHINGTON, J.; Pa., 1816. *Evans* v. *Eaton*, 3 Wheat., 528.—MARSHALL, Ch. J.; Sup. Ct., 1818. *Blanchard* v. *Haynes*, 6 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848. *Bloomer* v. *Stolley*, 5 McLean, 160, 161.—MCLEAN, J.; Ohio, 1850.

See also DIGEST PAT. CASES, title EXTENSION OF PATENT, B., D., E.

(*f*) 1. The extension of a patent, under this section, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefit of such renewal

is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal. *Wilson* v. *Rosseau*, 4 How., 682.—NELSON, J.; Sup. Ct., 1845.

2. The meaning of the words "thing patented," in the latter part of this section, when construed in connection with the simple right to *use*, without the right to *make* and *vend*, has reference to the machine patented. *Ibid.*, 683.

3. The phrase "to the extent of their interests therein," means their interests in the patented machines, be that interest in one or more at the time of the extension. *Ibid.*, 683.

4. The object of the clause as to assignees, is to preserve any previous contract of assignment in the sense in which both parties understood and intended it at the time it was made, and to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson* v. *Turner*, 7 Law Rep., 530.—TANEY, Ch. J.; Md., 1845.

5. The words of this section as to assignees and grantees, seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of such assignees and grantees, and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Day* v. *Union Rub. Co.*, 3 Blatchf., 497.—HALL, J.; N. Y., 1856.

6. But such right is limited to a right to *use*, although the person holding it may also have held, during the original term, an exclusive right to use, to make, and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*, 502.

See also DIGEST PAT. CASES, title EXTENSION OF PATENT, C.

(*g*) The extension of all patents, except for designs, granted subsequently to March 2d, 1861, is now prohibited. Act of 1861, § 16.

SECTION 19. *And be it further enacted*, That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

ACT OF 1836, CHAP. 357, §§ 20, 21. IN FORCE.

SECTION 20. *And be it further enacted*, That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

The Commissioner of Patents may now restore to applicants, models of rejected applications, or of applications for designs, or otherwise dispose of them, in cases where he shall not think it necessary to preserve them. Act of 1861, § 5.

SECTION 21. *And be it further enacted*, That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided, however*, That all actions and processes in law or equity sued out prior to the passage of this act, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto: *And provided, also*, That all applications or petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

Approved July 4th, 1836.

ACT OF 1837, CHAPTER 45.

5 STATUTES AT LARGE, 191.

[*This Act still in Force.*]

An Act in addition to the act to promote the progress of science and useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim and drawings annexed or belonging to the same; and it shall be the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file or copied as aforesaid, together with certificate of the oath; or such drawings may

be made in the office, under the direction of the Commissioner, in conformity with the specification. And it shall be the duty of the Commissioner to take such measures as may be advised and determined by the Board of Commissioners provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States, to transmit as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and transmit to said Commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said Commissioner.

SECTION 2. *And be it further enacted*, That copies of such record and drawings, certified by the Commissioner, or, in his absence, by the chief clerk, shall be *prima facie* evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; and no patent issued prior to the aforesaid fifteenth day of December, shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a draw-

ing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

1. Under this section it was held, where a patent was granted in 1834, but no drawing was attached thereto, and in June, 1837, such patent was recorded anew, and was also extended for seven years on the 25th of September, 1848, and in November, 1848, a drawing with written references was filed, with an affidavit of the patentee of the correctness of such drawing, that a certified copy of such drawing was admissible in evidence in connection with the patent and specification, and that the whole together made *prima facie* evidence of the particulars of such invention. *Winans* v. *Schenec. & Troy R. R.*, 2 Blatchf., 283, 285, 298 —NELSON, J.; N. Y., 1851.

2. Such a drawing, however, as a general rule will not be effectual to correct any material defect in the specification. In case of discrepancy between the drawings and specification, the latter must prevail. Nor will such a drawing have the same effect as if it had been referred to in the specification. *Ibid.*, 299.

SECTION 3. [Extended by act of 1842, § 2.] *And be it further enacted*, That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided, however*, That before such patent shall be issued, the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the origi-

nal model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the Commissioner; and such patent and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

1. Where a patent was obtained in 1834, the original of which and the drawings were destroyed by fire in 1836, and the patentee, under the act of 1837, filed in 1841 a copy of his patent, and deposited a drawing, which, however, was not verified, but which he verified in February, 1844, and subsequently in March, 1844, considering such copy imperfect, filed another and a fuller drawing, and commenced suit in May, 1844; *Held*, that a certified copy of such second drawing was properly received in evidence in such action. *Emerson* v. *Hogg*, 2 Blatchf., 9.—BETTS, J.; N. Y., 1845.

2. When such drawings are put on file they become public records, and copies of them must be received in evidence. If they are discordant, one may destroy the effect of the other. *Ibid.*, 12.

3. Under this section drawings when burnt may be restored, and if in some respects erroneous they can be corrected. *Hogg* v. *Emerson*, 11 How., 606.—WOODBURY, J.; Sup. Ct., 1850.

4. But it would not be proper to leave the drawings so long not restored or corrected as to evince neglect, or a design to mislead the public. *Ibid.*, 606.

5. The provisions of this section extended to patents granted prior to December 15th, 1836, but lost subsequent thereto. Act of 1842, § 2.

SECTION 4. *And be it further enacted*, That it shall be the duty of the Commissioner to procure a duplicate of such of the models destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inven-

tions and improvements: *Provided*, That a duplicate of such models may be obtained at a reasonable expense: *And provided, also*, That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and, also, to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said Commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

SECTION 5. [Amending act of 1836, § 13.] *And be it further enacted*, That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued (*a*); *Provided, however*, That no patent made prior to the aforesaid fifteenth day of December, shall be corrected and reissued until a duplicate of the model and drawing of the thing as originally invented, verified by oath as shall be required by the Commissioner, shall be deposited in the Patent Office;

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor, of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally invented, verified as aforesaid, shall have been deposited in the Patent Office, if the Commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the Commissioner, shall, in like manner, be deposited in the Patent Office;

And in all such cases, as well as in those which may arise under the third section of this act, the question of compensation for such models and drawing shall be subject to the judgment and decision of the commissioners provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

(*a*) 1. If an original patent include two inventions, and its validity on that account is doubted, a separate renewal is just and proper. *Goodyear* v. *Day*, MS.—GRIER, J.; N. J., 1852.

2. With respect to reissues, this section, and section 13 of the act of 1836 are to be taken together in construction, and the most just and equitable extent to which the terms of the law in its true spirit will admit of, ought to be adopted. *Ball, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

3. If the patent be defective or insufficient, either in the specification or *claim*, the patentee has a right, in the absence of fraud and deception, to have a reissue, for each separate and distinct part, effectually to cure the defect: and he has the right to *restrict* or *enlarge* his claim, so as to give it operation, and effectuate his invention. *Ibid.*

See also notes to section 13 of the act of 1836.

SECTION 6. [Enlarging act of 1836, § 5.] *And be it further enacted*, That any patent hereafter to be issued,

may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

1. This is an enabling statute. Prior to its passage, letters patent could only issue to the inventor: and after they were issued they were assignable, so as to give the assignee, in whole or in part, legal rights. This act gave the right to the assignee or assignees to have the patent issued to him or them, and not to the inventor. *Anon.*, 4 Opin., 400. —MASON, Atty.-Gen.; 1845.

2. But patents cannot issue jointly to the inventor as such, and to the assignee of a partial interest: but must issue to the assignee or assignees of the whole interest. *Ibid.*, 401.

3. A partial assignment before issue, does not entitle the partial assignee to have the patent issued to him to the extent of his interest. *Ibid.*, 401.

4. After the assignment of the invention, under this section, by which the inventor divests himself of all interest therein, and transfers it to the assignee, although the application for a patent must be in his name, still, for all substantial purposes, and in judgment of law, the assignee is the party making the application. *Gay* v. *Cornell*, 1 Blatchf., 509.—NELSON, J.; N. Y., 1849.

5. An assignment before patent issued, may be made after the rejection of the assignor's application, and after his appeal to the justices of the Circuit Court, and will be sufficient to enable such assignee to file his bill under section 16 of the act of 1836, amended by section 10 of the act of 1839, to compel the issue of a patent to him. *Ibid.*, 509, 510.

6. If an inventor assign all his right in an invention, the assignee may have the patent issued to himself. But if the assignment be only partial, though the part excepted is small, the assignee has no legal claim to the patent. It must be issued in the name of the inventor, and be held by him in trust for the use of the assignee, to the extent of the equities he has by virtue of his contract. *Ager's Case*, MS., Opin.—BLACK, Atty.-Gen.; 1859.

7. The provision of this section, requiring duplicate drawings, though directory in its terms, is not a condition: and it has reference, in point

of time, to the issuing of the patent, and not to the filing of the petition for it. Duplicate drawings need not be filed at the time of the application, and such is the interpretation of the Patent Office. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851. *O'Reilly* v. *Morse*, 15 How., 126. —GRIER, J.; Sup. Ct., 1853.

See also DIGEST PAT. CASES, title ASSIGNEE, B. 3.

SECTION 7. *And be it further enacted*, That. whenever any patentee shall have through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer (*a*) of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent (*b*); which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him (*c*) subsequent to the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same. (*d*)

(*a*) 1. The law requiring and permitting a patentee to enter a disclaimer, is penal and not remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construc-

tion that would restrict its operation within narrower limits than the law fairly imports. *O'Reilly* v. *Morse*, 15 How., 121.—TANEY, Ch. J.; Sup. Ct., 1853.

2. Whether a patent is illegal in part because of claiming more than he had described, or more than he has invented, the patentee must in either case disclaim, in order to save the portion to which he is entitled. *Ibid.*, 122.

3. A patentee has a right to disclaim any thing which has been claimed through "inadvertence or mistake." *Parker* v. *Sears*, MS.—GRIER, J.; Pa., 1850.

4. *Semble*, That a disclaimer, under this section, should not only disclaim what is not claimed as new, but should also distinctly set forth what part of the invention is still claimed, as it is manifestly designed to act as a new specification. *Lippincott* v. *Kelly*, 1 West. Law Jour., 513.—IRVIN, J.; Pa., 1844.

(*b*) 1. Under this section the disclaimer must state the interest of the person disclaiming. But where an administrator in whose name a patent had been extended, entered a disclaimer, stating that he was the patentee, and referring to the patent as showing his interest, it was held sufficient. *Brooks* v. *Bicknell*, 3 McLean, 439.—MCLEAN, J.; Ohio, 1844.

2. Where a disclaimer made by a patentee stated that "it was to operate to the extent of the interest in said letters patent vested" in the patentee, *Held*, that it fairly imported on its face, that the patentee was the owner of the entire interest in the patent, and if so, there was a substantial compliance with the statute, as to the disclaimer stating the interest of the party making it. *Foote* v. *Silsby*, 1 Blatchf., 461.—NELSON, J.; N. Y., 1849. *Silsby* v. *Foote*, 14 How., 221.—CURTIS, J.; Sup. Ct., 1852.

(*c*) 1. If a patent has been previously assigned in part, and a disclaimer has been filed by the patentee alone, such disclaimer will not operate in favor of the assignee, in any suit either at law or equity, unless he has joined in it. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

2. A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts of it; he may refuse to be affected by it. *Smith* v. *Mercer*, 5 West. Law Jour., 53.—KANE, J.; Pa., 1846.

3. Under section 7 of the act of 1837, the owner of a sectional interest in a patent may make a disclaimer of part of the thing patented, which will be considered as a part of the original patent, to the extent of his interest; but the patentee is not compelled to join in such disclaimer, nor will it affect any one except him making it, and those claiming under him. *Potter* v. *Holland*, MS.—NELSON, INGERSOLL, JJ.; Ct, 1858.

4. After such a disclaimer, a different claim of right is secured to the disclaimant from what is purported to be secured to the patentee.

Different claims of right in the same invention are thus secured to different sectional owners. *Ibid.*

5. A disclaimer, before it can be received in evidence, must be properly proved, either as an original paper, or by a certified copy, and if received at all, must have full effect given to it as a disclaimer. *Foote* v. *Silsby*, 1 Blatchf., 450, 461.—NELSON, J.; N. Y., 1849.

6. The disclaimer of part of an invention, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the patentee from embracing the part so disclaimed, on a reissue of his patent. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

(*d*) 1. The disclaimer mentioned in this section applies solely to suits pending when the disclaimer is filed; and the disclaimer mentioned in section 9, applies solely to suits brought after the disclaimer is filed. *Wyeth* v. *Stone*, 1 Story, 294.—STORY, J.; Mass., 1840.

2. A disclaimer to be effectual under this and section 9, must be filed before suit brought. If it is filed during the pendency of the suit, the plaintiff will not be entitled to the benefit thereof in that suit. *Reed* v. *Cutter*, 1 Story, 600.—STORY, J.; Mass., 1841.

3. If filed before suit, the plaintiff will be entitled to costs, if he establish that a part of his invention, not disclaimed, has been infringed by the defendant. *Ibid.*, 600.

4. But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit thereof, if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defence to the suit. *Ibid.*, 600.

See also DIGEST PAT. CASES, title DISCLAIMER; and notes to section 9 of this act.

SECTION 8. [Repealed in part by act of 1861, § 9.] *And be it further enacted*, That, whenever application shall be made to the Commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner;

and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

This section so far as it relates to patents for additions to existing patents, is repealed by the act of 1861, section 9.

SECTION 9. [Enlarging act of 1836, § 15.] *And be it further enacted*, (any thing in the fifteenth section of the act to which this is additional to the contrary notwithstanding,) That, whenever by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* his own; *Provided*, It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. (*a*) And every such patentee, his executors, administrators, and assigns, whether of the whole or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be *bona fide* his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. (*b*) But, in every such case in which a judgment

or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right (*c*). *Provided, however*, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid. (*d*)

(*a*) 1. This section contemplates the rule of the common law, that if a patent embraces different machines, and any one of them is not new, or was not the invention of the patentee, or the like, the whole patent would be void, as being then in full force, and therefore sought to mitigate it by providing that under the cases therein mentioned, the patent should be good to the extent of the patentee's invention. *Wyeth* v. *Stone*, 1 Story, 288, 289.—STORY, J.; Mass., 1840.

2 It points throughout to a single invention, as the "thing patented," and does not justify the position that one patent can lawfully include divers distinct and independent inventions, having no connection with each other, nor any common purpose. It may therefore be deemed a legislative recognition and adoption of the general rule of law in cases not within its exceptive provision. *Ibid.*, 290.

3. This section is intended to cover "inadvertences and mistakes" of law, as well as inadvertences and mistakes of fact. *Ibid.*, 295.

4. Prior to the act of 1836, if the patentee claimed more than he had invented, his patent was void. But under this section, his patent is not absolutely void, because the patentee claims more than he has actually invented, but is valid for as much as is truly and *bona fide* his own; but to secure the benefits of this section, the specification must state in what the improvement consists. *Peterson* v. *Wooden*, 3 McLean, 249.—MCLEAN, J.; Ohio, 1843.

(*b*) 1. Prior to the act of 1836, a patent was void if the claim extended beyond the invention. Under section 6 of the act of 1836, it was void if a substantial part had been patented or described in a printed publication. Section 15 of the same act saved the patent from being void, if the patentee believed himself to be the first inventor. Section 9 of the act of 1837, enlarged the right of the patentee, providing, notwithstanding section 15 of the act of 1836, that the patent should not be void, where the patentee had acted in good faith, if through mistake or inadvertence he had claimed more than he had invented, and that he might maintain suit on the part actually invented by him, provided he

filed within a reasonable time, a disclaimer of the parts not invented by him. *Smith* v. *Ely*, 5 McLean, 84, 85.—McLean, J., Ohio, 1849.

2. The doctrine that a party may take out a valid patent for a combination, and include in it a right to each distinct improvement, is confirmed by the obvious intent of this section, which gives a patentee a right of action for a piratical use of any one of his invented improvements, which is distinctly stated in his patent, though he may by mistake, accident, or inadvertence, have claimed others of which he was not the inventor. *Pitts* v. *Whitman*, 2 Story, 621.—Story, J.; Mass., 1843.

(*c*) 1. The disclaimer mentioned in this section applies solely to suits brought after the disclaimer is filed. *Wyeth* v. *Stone*, 1 Story, 294.—Story, J.; Mass., 1840.

2. Where a patent contains several claims, and the invention embraced in one seems to be not new, or useless, the patentee, under this and section 7 may still maintain an action for an infringement, although he did not, before action brought, make a disclaimer of the part claimed without right; but he will not be entitled to costs. *Hall* v. *Wiles*, 2 Blatchf., 198.—Nelson, J.; N. Y., 1851.

3. If in the progress of a trial, it turns out that a disclaimer ought to have been made, the plaintiff may still recover, but will not be entitled to costs. *Ibid.*, 198.

4. A disclaimer is necessary only where the thing claimed without right is a material and substantial part of the thing invented. If the part not new is not essential to the machine, and was not introduced into the patent through wilful default, or intent to defraud or mislead the public, the want of a disclaimer affords no ground for invalidating the patent. *Ibid.*, 199.

5. Under this section, in an action for infringement, the plaintiff cannot recover costs if he has claimed any thing of which he was not the first and original inventor, unless before suit brought he has disclaimed such part: and it makes no difference whether the infringement alleged was of or against the part so claimed, but not new, or of some other part claimed in the patent. *Seymour* v. *McCormick*, 19 How., 106.—Nelson, J.; Sup. Ct., 1856.

6. The omission to disclaim a part not new, prevents a plaintiff from recovering costs, and it makes no difference that such part is not alleged to be infringed. *Ibid.*, 106.

7. Though the neglect to file a disclaimer until after suit brought, will prevent the plaintiff recovering costs, it does not interfere with the power of the court to increase the verdict under section 14 of the act of 1836. *Guyon* v. *Serrell*, 1 Blatchf., 245, 246.—Nelson, J.; N. Y., 1847.

(*d*) 1. The plaintiff will not be entitled to the benefit of a disclaimer if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defence to a suit. *Reed* v. *Cutter*, 1 Story, 600.—Story, J.; Mass., 1841.

2. An unreasonable delay to enter a disclaimer cuts off the patentee, not only from a right to costs, but also from a right of action. *Brooks* v. *Bicknell*, 3 McLean, 449.—McLean, J.; Ohio, 1844.

3. What is an unreasonable delay is a mixed question of law and fact. Less vigilance will be required from an administrator than from the original inventor. *Ibid.*, 449, 450.

4. Where a patentee has unintentionally claimed something which was not original, but has unreasonably neglected to file a disclaimer, he cannot, under this section, recover in an action of infringement, even if the defendant has infringed the parts of his invention which are new. *Parker* v. *Stiles*, 5 McLean, 56.—Leavitt, J.; Ohio, 1849.

5. Under this section, the question of unreasonable negligence or delay in entering a disclaimer goes to the right of the action; and if the delay shows great negligence, the jury may find the patent void. *Hall* v. *Wiles*, 2 Blatchf., 199.—Nelson, J.; N. Y., 1851.

6. Where a claim has been held valid by the Patent Office, and has been sanctioned by a court below, the patentee will not be guilty of *unreasonable delay* in disclaiming it by waiting to obtain the decision of the highest court upon it. *O'Reilly* v. *Morse*, 15 How., 122.—Taney, Ch. J.; Sup. Ct., 1853.

7. Under this section, where a patentee claims more than he has invented, or is entitled to, his patent will still be valid for what he has invented, provided he enters a disclaimer of what he has included in his patent which he has not invented, without unreasonable neglect or delay. *Silsby* v. *Foote*, 20 How., 387.—Nelson, J.; Sup. Ct., 1857.

See also Digest Pat. Cases, title Disclaimer; and notes to section 7 of this act.

Section 10. [Repealed by act of 1861, § 6.] *And be it further enacted*, That the Commissioner is hereby authorized and empowered to appoint agents in not exceeding twenty of the principal cities or towns in the United States as may best accommodate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the Patent fund.

Section 11. *And be it further enacted*, That, instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be ap-

pointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; and also, an additional copying clerk, at an annual salary of eight hundred dollars. And the Commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the Commissioner.

The Commissioner of Patents has now the power to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

SECTION 12. [Repealed by act of 1861, § 9.] *And be it further enacted*, That, wherever the application of any foreigner for a patent shall be rejected and withdrawn for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the Commissioner shall be a sufficient warrant to the treasurer to pay back to such applicant two-thirds of the duty he shall have paid into the Treasury on account of such application.

The right of withdrawal, as to any portion of the patent fee, in applications made subsequent to March 2d, 1861, is now taken away. Act of 1861, § 9.

SECTION 13. *And be it further enacted*, That in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

ACT OF 1837, CHAP. 45, § 14. IN FORCE.

1. The act referred to is that of 1836, section 6.

2. As to what persons may administer this oath, when the applicant is without the jurisdiction of the United States, see act of 1842, section 4.

SECTION 14. *And be it further enacted*, That all moneys paid into the Treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act to which this is additional, shall be carried to the credit of the Patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided for by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and also for such other purposes as are or may be hereafter specially provided for by law. And the Commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund; And it shall also be his duty to lay before Congress in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property during the same period; together with such other information of the state and condition

of the Patent Office as may be useful to Congress or the public.

Approved March 3d, 1837.

The annual report of the Commissioner of Patents on mechanics is to be prepared so that the plates and drawings shall be comprised in one volume, not to exceed eight hundred pages. Act of 1859, § 4.

ACT OF 1839, CHAPTER 88.

(5 STATUTES AT LARGE, 353.)

[*This Act still in Force.*]

An Act in addition to "An act to promote the progress of the useful arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars.

The Commissioner of Patents has now authority to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

SECTION 2. *And be it further enacted*, That the Commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires it; *Provided, however*, That instead of salary, a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.

Fee for copies is ten cents per hundred words. Act of 1836, § 4. Act of 1861, § 10.

ACT OF 1839, CHAP. 88, §§ 3–6. IN FORCE

SECTION 3. *And be it further enacted*, That the Commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one thousand dollars, if necessary, be appropriated, out of the Patent fund, to defray the expense of the same.

SECTION 4. *And be it further enacted*, That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the Patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.

SECTION 5. *And be it further enacted*, That the sum of one thousand dollars be appropriated from the Patent fund, to be expended under the direction of the Commissioner, for the purchase of necessary books for the library of the Patent Office.

SECTION 6. [Enlarging act of 1836, § 8.] *And be it further enacted*, That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six (*a*), to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided, also*, That in all cases every such patent shall be limited to the term of fourteen years (*b*) from the date or publication of such foreign letters patent. (*c*)

(*a*) For provision referred to, see act of 1836, § 8.

(*b*) Patents are now granted for the term of seventeen years. Act of 1861, § 16.

(*c*) 1. The date of a patent may be altered to correspond with that of a foreign patent, previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. *Detmold's Case*, 4 Opin., 335.—NELSON, Atty.-Gen.; 1844.

2. Under this section, if the domestic patent, in a case where a foreign patent has been previously obtained, purports to give an exclusive right for fourteen years from its date, instead of from the date of the foreign patent, it is void, as having been issued without authority of law; but the error is not fatal, and may be corrected on application to the Patent Office. *Smith* v. *Ely*, 5 McLean, 78, 80.—MCLEAN, J.; Ohio, 1849.

3. The proviso of this section as to when a home patent shall bear the date of a foreign patent, relates only to such patents as are *applied for* here *after* the issue of a foreign patent. *French* v. *Rogers*, MS.—KANE, J.; Pa., 1851.

4. Where, therefore, an application for a patent was made in this country in April, 1838, and acted on in that month, but a patent was not actually issued until June 20th, 1840, at which time the patent was dated, and a foreign patent was obtained in August, 1838; *Held*, as the application here was before the foreign patent, that the grant of the patent here was under the general enactments of the act of 1836, and its term runs properly from its date. *Ibid.*

5. A patent is not void because it does not, on its face, bear the same date with a foreign patent. If it is not, for any reason, exempt from the operation of the statute on such subject, the only effect is to limit the monopoly to fourteen years from the date of the foreign patent. *O'Reilly* v. *Morse*, 15 How., 112.—TANEY, Ch. J.; Sup. Ct., 1853.

SECTION 7. [Qualifying act of 1836, §§ 7, 15.] *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter, so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or

use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

1. This section, allowing the use and sale of an invention for two years before the application for a patent, is in the nature of a statute of limitations. *Hovey* v. *Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

2. It virtually extends the patentee's privilege to sixteen years instead of fourteen. *McCormick* v. *Seymour*, 2 Blatchf., 254.—NELSON, J.; N. Y., 1851.

3. The object of this section is twofold: first, to protect the person who has used the thing patented from any liability to the patentee, or his assignee; and second, to protect the rights granted to the patentee against any infringement by any other person. *McClurg* v. *Kingsland*, 1 How., 208, 209.—BALDWIN, J.; Sup. Ct., 1843.

4. This section relieved the patentee from the effect of the former laws, and their construction by the court, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor, which, if given before the application for a patent, would justify a continued use of it after it issued, without liability. *Ibid.*, 209.

5. It is not limited to patents for machines, manufactures, and compositions of matter, but embraces inventions for modes of doing a thing, or processes, as a new improvement in the art of casting iron. *Ibid.*, 209.

6. This section is not to be construed as confined to a specific machine as distinguished from an invention or thing patented, but the words "newly invented machine, manufacture, or composition of matter," and "such invention," mean the "invention patented," and the words "specific machine" refer to "the thing as originally patented," whereof the right is secured by patent, but not to any newly invented improvement on a thing once patented. *Ibid.*, 210.

7. This section has exclusive reference, in respect to the use of a machine, to an original patent, and not to a renewal or reissue of it. *Stimpson* v. *West Chester R. R.*, 4 How., 403.—MCLEAN, J.; Sup. Ct., 1845.

8. This section allows the use of an invention, even with leave of the inventor, for two years before application for a patent, without invalidating his right to a patent; *a fortiori*. the use by a third person, or a subsequent inventor, after the invention and before the issuing of a patent to the first inventor, without his consent, is no bar to the issuing of a patent to the first inventor. *Hildreath* v. *Heath*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

IN FORCE. ACT OF 1839, CHAP. 88, §§ 7, 8.

9. Both before and since the act of 1839, an inventor might exercise a claim to an inchoate right to an invention, which was capable of being perfected to an exclusive right by obtaining letters patent, and the public may acquiesce in such claim. *Sargeant* v. *Seagrave*, 2 Curt., 555.—CURTIS, J.; R. I., 1855.

10. Before the act of 1839, he might, by way of experiment, bring the knowledge of his invention to the public, at the same time making known that he was about to apply for a patent; and since the act of 1839, he may sell any number of his machines to the public, during any period less than two years, accompanied by a claim to the inchoate right sufficient to show an intention not to abandon it to the public. *Ibid.*, 555.

11. Under this section the purchaser must be a purchaser from the inventor himself, before his application for a patent, and not from a wrongdoer, without his knowledge or against his will. *Pierson* v. *Eagle Screw Co.*, 3 Story, 406, 407.—STORY, J.; R. I., 1844. *Hovey* v. *Stevens*, 1 Wood. & Min., 301.—WOODBURY, J.; Mass., 1846.

12. A surreptitious knowledge and use of an invention, before the application by the inventor for a patent, does not, under this section, give any right to continue to use it after the inventor has obtained a patent for it. *Kendall* v. *Winsor*, 21 How., 330.—DANIEL, J.; Sup. Ct., 1858.

13. The sale of the product of an invention is not a sale of the thing invented within this section: the sale here spoken of is a sale of the invention or patented article. *Booth* v. *Garelly*, 1 Blatchf., 250.—NELSON, J.; N. Y., 1847.

14. This section gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Goodyear* v. *Day*, MS. —GRIER, J.; N. J., 1852.

15. This section provided a remedy for cases where the conduct of the party, as to the sale of his invention, did not show an actual abandonment. It also secures the rights of those who may have purchased or constructed any newly invented machine, prior to the application for a patent. *Sanders* v. *Logan*, 3 Wall., Jr.—GRIER, J.; Pa., 1861.

16. The obvious construction of it is, that a purchase, sale, or prior use, shall not invalidate, unless it amounts to an abandonment to the public. *Ibid.*

See also DIGEST PAT. CASES, title PRIOR USE.

SECTION 8. *And be it further enacted*, That so much of the eleventh section of the above recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyance of the whole or any part of the interest or right

under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyances shall, in future, be recorded without any charge whatever.

Fees for recording assignments are again required, according to certain rates, by the act of 1843, section 2, and the act of 1861, section 10.

SECTION 9. [Obsolete; temporary enactment.] *And be it further enacted*, That a sum of money not exceeding one thousand dollars, be, and the same is hereby, appropriated, out of the Patent fund, to be expended by the Commissioner of Patents in the collection of agricultural statistics, and for other agricultural purposes; for which the said Commissioner shall account in his next annual report.

By an act passed May 15, 1862, a "Department of Agriculture" was established, to which supervision of every thing relating to agriculture was given. No further provisions relating to agriculture will therefore be inserted.

SECTION 10. [Extending act of 1836, § 16.] *And be it further enacted*, That the provisions of the sixteenth section of the before recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

1. An assignee of an invention, by virtue of an assignment made

before patent issued, may file a bill in his own name under section 16 of the act of 1836, and this section, against a patentee to whom a patent issued, upon an interference with complainant's assignor, for the purpose of having the patent so issued set aside, and one granted to the complainant. *Gay* v. *Cornell*, 1 Blatchf., 507.—NELSON, J.; N. Y., 1849.

2. And it will be sufficient if such assignment is recorded before patent is issued. *Ibid.*, 509.

SECTION 11. [Amending act of 1836, § 7.] *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the District Court of the United States for the District of Columbia (*a*), by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint (*b*), his reasons of appeal, specifically set forth in writing (*c*), and also paying into the Patent Office, to the credit of the Patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner (*d*), at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be con-

fined. (*e*) And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case, is prayed for. (*f*) And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case (*g*); *Provided, however*, That no opinion or decision of the judge in any such case, shall preclude any person interested in favor or against the validity of any patent which has been, or may hereafter, be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

(*a*) 1. Appeals were afterwards allowed to be made to either of the assistant judges of the Circuit Court of the District of Columbia. Act of August 18th, 1852, § 1.

2. By the act of March 3d, 1863, section 3, establishing the Supreme Court of the District of Columbia, the justices of such court were clothed with the same powers theretofore exercised by the judges of the Circuit Court.

(*b*) 1. The filing of the reasons of appeal is essentially the appeal itself. *Greenough* v. *Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

2. Where the reasons of appeal are not filed within the time prescribed by the Commissioner of Patents, the right of appeal is lost. *Ibid.* Also, *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

3. But the Commissioner may enlarge the time to file such reasons. *Justice* v. *Jones*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

4. An appeal cannot be made after the time limited in the notice of appeal. *Linton, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

See also DIGEST PAT. CASES, title APPEALS, B. 1.

(*c*) 1. The reasons of appeal must not be vague and unsatisfactory, as "that the decision of the Commissioner was in opposition to a clear apprehension of the merits of the case." *Winslow, Ex parte*, MS. (App.

Cas.)—CRANCH, Ch. J.; D. C., 1850. *Douglass* v. *Blakinton*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

2. No reason of appeal can be considered as valid, which would not justify the Commissioner in refusing a patent. *Wade* v. *Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

3. No assignment is sufficiently explicit which does not, with reasonable certainty, point out the precise matter of alleged error. *Douglass* v. *Blakinton*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

4. The reasons of appeal should be so expressed that the judge may gather from their language what is meant by them, but they need not be according to any technical formula. *Laidley* v. *James*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

See also DIGEST PAT. CASES, title APPEALS, B. 4.

(*d*) 1. The questions are to be decided by the judge according to the evidence produced before the Commissioner. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

2. The provision requiring the judge to hear and determine appeals "on the evidence produced before the Commissioner," is to be construed with reference to section 7 of the act of 1836, providing that reasonable notice shall be given both to the party appealing, and the Commissioner, "so that they may have an opportunity of furnishing such facts and evidence as they may deem necessary to a just decision." *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

3. There is nothing in the act of 1839, which takes away or impairs that right, but there is every reason to infer that it was intended to be saved to the fullest extent. *Ibid.*

4. Where, therefore, a party has been prevented before the Commissioner from producing his proofs to support his claim, it is the duty of the judge, by reasonable regulations, similar to those directed by section 12 of the act of 1839, to pursue such a course, as will afford the party an opportunity to produce such proofs, and he may make an order, authorizing the party to take and file his proofs as to the originality and utility of his invention. *Ibid.*

(*e*) 1. All the conditions prescribed by this section must be complied with as prerequisites before the judge can take jurisdiction. His jurisdiction is special and limited, and no other power can be exercised except that expressly given. *Greenough* v. *Clark*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

2. The powers and jurisdiction of the judges on appeal, are special and limited, and must be exercised and construed strictly. *Pomeroy* v. *Connison*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1842.

3. The power of the justices on appeal from the decision of the Commissioner of Patents is confined to the points involved in the reasons of appeal. *Kemper, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *Smith* v. *Flickinger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

Cochrane v. *Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844. *Warner* v. *Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846. *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850. *Aiken, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850. *Burlew* v. *O'Neil*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

See also DIGEST PAT. CASES, title APPEALS, B. 2, 3.

(*f*) 1. The provision of this section as to the examination of the Commissioner, &c., must be considered in connection with section 7 of the act of 1836, as to the powers of the old Board of Examiners. The statute means that the explanation may be so full and clear an explanation of the *principles* of the thing, as to enable the judge to weigh and apply the evidence offered, and is not to be limited to a mere exposition of the terms used; and such explanations the judge is bound to respect as a part of the case. *Richardson* v. *Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

2. The judge succeeds to all the authority conferred upon the Board of Examiners by section 7 of the act of 1836, to require of the Commissioner and examiners information relative to the subject-matter under consideration, and to the full extent. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

3. The officer of the Patent Office attending before the judge is not to be considered as counsel for the Patent Office, or for either of the parties, but only attends to explain the decision of the Commissioner. *Perry* v. *Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

(*g*) 1. The provision that "the decision of the judge shall govern the further proceedings of the Commissioner in the case," applies only to so much of the case as is involved in the reasons of appeal; and the appeal itself can only be considered as an appeal to so much of the decision of the Commissioner as is affected by such reasons. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. If, therefore, after the judge shall have decided in favor of an applicant, upon the points involved in the reasons of appeal, other grounds remain for rejecting the claim, it would seem the Commissioner might still reject it; whether such new rejection would be the subject of appeal; *query*. *Ibid.*

3. As to who may appeal, see notes to section 8, act of 1836.

See also DIGEST PAT. CASES, title APPEALS, B. 3 and 5.

SECTION 12. [Repealing act of 1836, § 7: Enlarged by act of 1861, § 1.] *And be it further enacted*, That the Commissioner of Patents shall have power to make all such regulations in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which

this is additional, as provides for a board of examiners, is hereby repealed.

1. The power granted to the Commissioner under this section to make rules as to the taking of evidence, gives no right to make new rules of evidence, or to make new rules of law so as to divest vested rights. *Dyson, Ex parte*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

2. The rules as to evidence, made under this section by the Commissioner of Patents, in conformity with the law, while they remain unabrogated, are as binding as the law itself, and as well upon the Commissioner as on others. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841. *O'Hara* v. *Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

3. After a deposition has been taken while the rules were in force, a revocation of them cannot affect such deposition. A revocation can affect only subsequent proceedings. *Arnold* v. *Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

4. The rules of the Patent Office as to taking evidence, prescribed under this section, must be *just and reasonable*, according to the established principles and precedents in like cases. *Nichols* v. *Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

5. The power of the Commissioner to make rules as to evidence is now extended to all cases pending before the Patent Office. Act of 1861, § 1.

See also DIGEST PAT. CASES, title EVIDENCE, C. 3.

SECTION 13. [Obsolete: Repealed by act of 1852, § 3.] *And be it further enacted*, That there be paid annually, out of the Patent fund, to the said Chief Justice, in consideration of the duties herein imposed, the sum of one hundred dollars.

Approved March 3d, 1839.

This section was repealed by section 3 of the act of 1852; and it was also provided that, in case of an appeal to the chief justice, or to either of the assistant justices, there should be paid to the judge to whom appeal should be made, the $25 required to be paid by this section. Act of 1852, § 2.

ACT OF 1842, CHAPTER 263.

5 STATUTES AT LARGE, 543,

[*This Act still in Force.*]

An Act in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose. (*a*)

(*a*) This act purports, from its title, to repeal all acts and parts of acts heretofore made to promote the progress of the useful arts; but though it extends some of the existing laws to new cases, it in fact repeals no act or part of any act whatsoever. *Stimpson* v. *Pond*, 2 Curt., 506.—CURTIS, J.; Mass., 1855.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the Patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to said Treasurer by the Commissioner of Patents.

SECTION 2. [Extending act of 1837, § 3.] *And be it further enacted*, That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided*,

however, The same shall not have been recorded anew under the provisions of said act.

SECTION 3. [Obsolete: Superseded by act of 1861, § 11.] *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases which by the now existing laws would be required

of the particular applicant shall be one-half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

SECTION 4. *And be it further enacted*, That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister, plenipotentiary, *chargé d'affaires*, consul, or commercial agent holding commission under the Government of the United States, or before any notary public of the foreign country in which such applicant may be.

Oaths required by act of 1836, section 6; affirmation substituted therefor in certain cases by act of 1837, section 13.

SECTION 5. *And be it further enacted*, That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon any thing made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters patent," or the word "patentee," or

any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall affix the same, or any word, stamp, or device, of like import, on any unpatented article, for the purpose of deceiving the public (*a*), he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars (*b*), with costs, to be recovered by action in any of the Circuit Courts of the United States, or in any of the District Courts of the United States having the powers and jurisdiction of a Circuit Court (*c*); one-half of which penalty, as recovered, shall be paid to the Patent fund, and the other half to any person or persons who shall sue for the same.

(*a*) The penalty mentioned in this section is incurred as to all articles made, and having the word "patent" affixed, with a guilty purpose or intent. *Stephens* v. *Caldwell*, MS.—SPRAGUE, J.; Mass., 1860.

(*b*) 1. This section—though its phraseology, "a penalty of not less than one hundred dollars," is peculiar—authorizes the infliction of a penalty of just one hundred dollars for the offence therein described and no more. *Stimpson* v. *Pond*, 2 Curt., 506.—CURTIS, J.; Mass., 1855.

2. The penalty may be recovered in an action of debt. *Ibid.*, 506.

(*c*) The two years' limitation of suits for penalties, contained in section 32 of the Crimes act of 1790 (1 Stat. at Large, 119), is repealed by implication by section 4 of the act of 1839 (5 Stat. at Large, 322), which extends the time to five years. *Ibid.*, 503.

SECTION 6. [Superseded by act of 1861, § 13.] *And be it further enacted*, That all patentees and assignees of patents hereafter granted, are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended, or offered for sale, the date of the patent; and if any person or persons, patentees or assignees, shall neglect to do so, he, she, or they, shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act.

Approved August 29th, 1842.

1. Under this section it was held, that it was not the selling the articles unstamped that made the party liable to the penalty, but the omitting to put the stamp on. *Palmer* v. *Allen*, MS.—BETTS, J.; N. Y., 1854.

2. The assignees of an interest in a patent are no more liable for articles purchased and sold by them, without the date of the patent stamped on them, than any other persons, unless the articles were manufactured with their connivance. *Ibid.*

3. Held, also, that the penalty attaches for each separate article sold. *Ibid.*

4. It is necessary that each article should be stamped with the day of the month, as well as the year; but if this is done it is sufficient, even if the word "patented" is abbreviated. *Hawley* v. *Bagley*, MS. —BETTS, J.; N. Y., 1855.

ACT OF 1848, CHAPTER 47.

9 STATUTES AT LARGE, 231.

[*This Act still in Force.*]

An Act to provide additional examiners in the Patent Office, and for other purposes.

SECTION 1. [Amending act of 1836, § 18.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in the manner provided in the second section of the act entitled "An act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six, two principal examiners, and two assistant examiners, in addition to the number of examiners now employed in the Patent Office; and that hereafter each of the principal examiners employed in the Patent Office shall receive an annual salary of twenty-five hundred dollars, and each of the assistant examiners an annual salary of fifteen hundred dollars (*a*):

Provided, That the power to extend patents now vested in the board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, by the eighteenth section of the act approved July fourth, eighteen hundred and thirty-six, respecting the Patent Office, shall hereafter be vested solely in the Commissioner of Patents (*b*); and when an application is made to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make a full report to said Commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said Commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years. (*c*)

(*a*) 1. The Commissioner of Patents is now authorized to appoint, from time to time, examiners, not to exceed four in each class. Act of 1861, § 7.

2. As to the gradation and pay of examiners and clerks in the Patent Office, see act of 1853, chapter 97, section 3, and act of 1860, section 5, and act of 1861, section 7.

(*b*) 1. This act is not a repeal of section 18 of the act of 1836, providing for the extension of patents, and the enactment of a new system for that purpose, but simply a repeal of so much of it as related to the action of the Secretary of State, and the Solicitor of the Treasury, leaving the Commissioner of Patents alone to go on in the execution of the duty. *Colt* v. *Young*, 2 Blatchf., 473.—NELSON, J.; N. Y., 1852.

2. Where an application for an extension of a patent under section 18 of the act of 1836 was pending at the time of the passage of the act of 1848, which conferred upon the Commissioner of Patents solely, the power previously vested in the Board created by the act of 1836, *Held*, that it was not necessary to renew the application, but that the Commissioner had the power to go on with the proceedings as having

been already properly instituted, and complete them by granting the extension. *Ibid.*, 473.

3. For reference to other decisions bearing upon the extension of patents, see section 18 of the act of 1836, and the notes thereto.

(*c*) The extension of all patents granted subsequently to March 2d, 1861, except patents for designs, which may be extended for seven years, is now prohibited. Act of 1861, § 16.

SECTION 2. [Re-enacted by act of 1861, § 10.] *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance of the whole or any part of the interest in letters patent, or power of attorney, or license to make or use the thing patented, when such instrument shall not exceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

The original provision as to fees for recording assignments, was contained in the act of 1836, section 11. That section was repealed by act of 1839, section 8. Fees for recording were again restored by this section, which is also re-enacted in act of 1861, section 10.

SECTION 3. *And be it further enacted*, That there shall be appointed, in manner aforesaid, two clerks, to be employed in copying and recording, and in other services in the Patent Office, who shall each be paid a salary of one thousand two hundred dollars per annum.

SECTION 4. *And be it further enacted*. That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

Approved May 27th, 1848.

ACT OF 1849, CHAPTER 108.

9 STATUTES AT LARGE, 395.

[*This Act still in Force.*]

Extract from the act entitled "An Act to establish the Home Department, and to provide for the Treasury Department as Assistant Secretary of the Treasury and a Commissioner of the Customs."

SECTION 2. *And be it further enacted*, That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary of State; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

Approved March 3d, 1849.

ACT OF 1851, CHAPTER 32.

9 STATUTES AT LARGE, 617.

[*This Act still in Force.*]

Extract from the act entitled "An Act making appropriations for the civil and diplomatic expenses of government," &c.

SECTION 2. *And be it further enacted*, That there shall

be appointed and paid, in the manner now provided by law, two principal examiners and two assistant examiners of patents, in addition to the examining force now employed in the Patent Office.

Approved March 3d, 1851.

The Commissioner of Patents is now authorized to appoint, from time to time, examiners, not to exceed four in each class. Act of 1861, § 7.

ACT OF 1852, CHAPTER 107.

10 STATUTES AT LARGE, 75.

[*This Act still in Force.*]

An Act in addition to an act to promote the progress of the useful arts.

SECTION 1. [Enlarging act of 1839, § 11.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That appeals provided for in the eleventh section of the act entitled "An act in addition to an act to promote the progress of the useful arts," approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges.

1. By the act of March 3d, 1863, the Circuit Court of the District of Columbia was abolished, and a Supreme Court for the District established; and it was provided by section 3 of that act, that the justices of the said Supreme Court should severally possess the powers and exercise the jurisdiction now possessed and exercised by the judges of the

Circuit Court. Under this act, appeals are now taken to the justices of the said Supreme Court.

2. As to appeals, who may make, and when, see notes to sections 7 and 8 of the act of 1836.

3. As to the power of the judges on appeal, and the effect of their action, see section 11 of the act of 1839, and the notes thereto.

SECTION 2. *And be it further enacted*, That in case appeal shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the appellant into the Patent Office by the eleventh section of said act, on said appeal.

SECTION 3. [Repealing act of 1839, § 13.] *And be it further enacted*, That section thirteen of the aforesaid act, approved March the third, eighteen hundred and thirty-nine, is hereby repealed.

Approved August 30th, 1852.

ACT OF 1852, CHAPTER 108.

10 STATUTES AT LARGE, 95, 96.

[*This Act still in Force.*]

Extracts from the act entitled "An Act making appropriations for the civil and diplomatic expenses of the Government," &c.

For compensation of the librarian of the Patent Office, twelve hundred dollars, to be paid out of the Patent Fund. (*a*)

For books for the library of the Patent Office, to be paid out of the Patent Fund, one thousand five hundred dollars.

For fitting up the library of the Patent Office, to be paid out of the Patent Fund, two thousand dollars.

For additional compensation to the disbursing clerk and draughtsman in the Patent Office, the sum of three hundred dollars each, to be paid out of the Patent Office Fund; and that hereafter the disbursing clerk shall be required to give bond, with approved security in the sum of five thousand dollars, conditioned for the faithful discharge of the duties of his office.

For the compensation of two additional permanent clerks in the Patent Office, to be appointed by the Commissioner of Patents, at a salary of fourteen hundred dollars each, the sum of twenty-eight hundred dollars, to be paid out of the Patent Office Fund.

Approved August 31st, 1852.

(*a*) The salary of the librarian is now fixed at one thousand eight hundred dollars. Act of 1861, § 4.

ACT OF 1853, CHAPTER 97.

10 STATUTES AT LARGE, 209, 210, 211.

[*This Act still in Force.*]

Extracts from "An Act making appropriations for the civil and diplomatic expenses of the Government," &c.

SECTION 1. For the purchase of books for the library of the Patent Office, to be paid out of the Patent fund, one thousand five hundred dollars.

SECTION 3. *And be it further enacted*, That from and after the thirtieth of June, eighteen hundred and fifty-three, the clerks in the Departments of the Treasury,

War, Navy, the Interior, and the Post Office, shall be arranged into four classes, of which class number one shall receive an annual salary of nine hundred dollars each, class number two an annual salary of one thousand two hundred dollars each, class number three an annual salary of one thousand five hundred dollars each, and class number four an annual salary of one thousand eight hundred dollars each.

This section also provides for eight clerks of the second class, twelve (including six assistant examiners) of the third class, and one of the fourth class; and also provides for an increase of the salary of the chief clerk to two thousand dollars.

Approved March 3d, 1853.

1. The Commissioner of Patents is now authorized to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

2. As to the pay of examiners, see also act of 1860, section 5, and act of 1861, section 7.

3. The salary of the chief clerk is now fixed at two thousand five hundred dollars. Act of 1861, § 4.

ACT OF 1855, CHAPTER 175.

10 STATUTES AT LARGE, 670, 674.

[*This Act still in Force.*]

Extracts from "An Act making appropriations for the civil and diplomatic expenses of the Government," &c.

SECTION 10. *And be it further enacted*, That there shall be appointed and paid in the manner now provided by law, four principal examiners and four assistant examiners of patents, in addition to the examining force now authorized by law, to be so employed in the Patent

Office; and should the necessities of the public service, in the estimation of the Commissioner of Patents, require any additional examining force to that herein provided, previous to the next session of Congress, there may also be appointed and paid in the manner now provided by law, in addition to the foregoing, not exceeding two principal and two assistant examiners, who shall not so continue to be employed subsequent to the expiration of said next session of Congress, without further provision of law.

The Commissioner of Patents is now authorized to appoint examiners, not to exceed four in each class. Act of 1861, § 7.

SECTION 25. *And be it further enacted*, That the first assistant examiners in the Patent Office shall be rated as of the fourth class of clerks, and the second assistant examiners, machinist, and librarian as of the third class.

Approved March 3d, 1855.

ACT OF 1856, CHAPTER 129

11 STATUTES AT LARGE, 91.

[*This Act still in Force.*]

Extracts from the "Act making appropriations for certain civil expenses of the Government," &c.

SECTION 9. *And be it further enacted*, That there shall be appointed and paid, in the manner now provided by law, two principal examiners and two assistant examiners, in addition to the examining force now authorized by law to be so employed in the Patent Office.

For provision authorizing the appointment of examiners by the Commissioner of Patents, see act of 1861, section 7.

SECTION 10. [Obsolete—only temporary.] *And be it further enacted*, That the Commissioner of Patents is hereby authorized to pay those employed in the United States Patent Office from April first, eighteen hundred and fifty-four, until April first, eighteen hundred and fifty-five, as examiners and assistant examiners of patents, at the rates fixed by law for these respective grades: *Provided*, That the same be paid out of the Patent Office fund, and that the compensation thus paid shall not exceed that received by those duly enrolled as examiners and assistant examiners of patents for the same period.

Approved August 18th, 1856.

ACT OF 1859, CHAPTER 80.

11 STATUTES AT LARGE, 422.

[*This Act still in Force.*]

Extract from "An Act making appropriations for the legislative, executive, and judicial expenses of the Government," &c.

SECTION 4. *And be it further enacted*, That the Secretary of the Interior be, and he is hereby, directed to cause the annual report of the Commissioner of Patents on mechanics hereafter to be made to the Senate and House of Representatives to be prepared and submitted in such manner as that the plates and drawings necessary to illustrate each subject shall be inserted so as to comprise the entire report in one volume not to exceed eight hundred pages.

Approved March 3d, 1859.

ACT OF 1860, CHAPTER 211.

12 STATUTES AT LARGE, 110.

[*Obsolete: Temporary Enactment.*]

Extract from "An Act making appropriations for sundry civil expenses of the Government," &c.

SECTION 5. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to pay those employed in the Patent Office from April first, eighteen hundred and fifty-five, until April first, eighteen hundred and sixty, as examiners and assistant examiners of patents, at the rates fixed by law for these respective grades: *Provided*, that the same be paid out of the Patent Office fund, and that the compensation thus paid shall not exceed that received by those duly enrolled as examiners and assistant examiners of patents for the same period.

Approved June 25th, 1860.

ACT OF 1861, CHAPTER 37.

12 STATUTES AT LARGE, 130.

[*This Act still in Force.*]

An Act to extend the right of appeal from the decisions of Circuit Courts to the Supreme Court of the United States.

SECTION 1. [Enlarging act of 1836, § 17.] *Be it enacted by the Senate and House of Representatives of the United*

States of America in Congress assembled, That from all judgments and decrees of any Circuit Court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner, and under the same circumstances as is now provided by law in other judgments and decrees of such Circuit Courts, without regard to the sum or value in controversy in the action.

Approved February 18th, 1861.

The provision as to writs of error or appeals from judgments and decrees rendered in actions arising under the patent laws, previous to the passage of this act, is contained in the act of 1836, section 17.

ACT OF 1861, CHAPTER 88.

12 STATUTES AT LARGE, 246.

[*This Act still in Force.*]

An Act in addition to "An act to promote the progress of the useful arts."

SECTION 1. [Enlarging act of 1839, § 12.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office (*a*), and such affidavits and depositions may be taken before any justice of the peace, or

other officer authorized by law to take depositions to be used in the courts of the United States, or in the State courts of any State where such officer shall reside; and in any contested case (*b*) pending in the Patent Office it shall be lawful for the clerk of any court of the United States for any District or Territory, and he is hereby required, upon the application of any party to such contested case, or the agent or attorney of such party, to issue subpœnas for any witnesses residing or being within the said district or territory, commanding such witnesses to appear and testify before any justice of the peace, or other officer as aforesaid, residing within the said district or territory, at any time and place in the subpœna to be stated; and if any witness, after being duly served with such subpœna, shall refuse or neglect to appear, or, after appearing, shall refuse to testify (not being privileged from giving testimony), such refusal or neglect being proved to the satisfaction of any judge of the court whose clerk shall have issued such subpœna, said judge may thereupon proceed to enforce obedience to the process, or to punish the disobedience in like manner as any court of the United States may do in case of disobedience to process of *subpœna ad testificandum* issued by such court; and witnesses in such cases shall be allowed the same compensation as is allowed to witnesses attending the courts of the United States (*c*): *Provided*, That no witness shall be required to attend at any place more than forty miles from the place where the subpœna shall be served upon him to give a deposition under this law: *Provided, also*, That no witness shall be deemed guilty of contempt for refusing to disclose any secret invention made or owned by him: *And provided, further*, That

no witness shall be deemed guilty of contempt for disobeying any subpœna directed to him by virtue of this act, unless his fees for going to, returning from, and one day's attendance at the place of examination, shall be paid or tendered to him at the time of the service of the subpœna.

(*a*) By the act of 1839, section 12, the Commissioner was empowered to make regulations as to taking evidence in contested cases. This act extends to all cases pending in the Patent Office.

(*b*) Whether, under this act, the power to compel the attendance of witnesses is not confined to "contested cases"—as cases of interference —*query*.

(*c*) Witnesses are allowed one dollar and fifty cents per day, and five cents per mile travelling from their places of residence to the place of trial or hearing, and five cents per mile for returning. Act of 1853, chap. 167, § 3.

SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners-in-chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall be governed in their

action by the rules to be prescribed by the Commissioner of Patents. (*a*)

SECTION 3. *And be it further enacted*, That no appeal shall be allowed to the examiners-in-chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected (*a*); and the second examination of the application by the primary examiner shall not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention (*b*), as provided for in the seventh section of the act entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six.

NOTES TO §§ 2 AND 3.

(*a*) 1. Previous to this act, all judicial acts done in the Patent Office by the primary examiners or the board of appeals were, in intendment of law, the judicial acts of the Commissioner, and had no legal validity until sanctioned by him. They were the organs of the Commissioner to *inquire* and *enlighten* his judgment, and till the Commissioner gave validity to their judicial acts, by his *fiat*, they had no legal evidence as judgment. *Snowden* v. *Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

2. Under the act of 1861, the primary examiners and examiners-in-chief are recognized as *judicial officers*, acting independently of the Commissioner, who can *only control them*, when their judgment in due course comes before the Commissioner, on appeal. *Ibid.*

3. Their acts are not the acts of the Commissioner, but their own acts. They are no longer *mere* organs of the Commissioner, but independent officers. He can only reach and overrule them, when their judgments come regularly before him, *on appeal*. *Ibid.*

4. The Commissioner can give no judgment till the appeal reaches him, and this cannot be done till the judgment of the primary examiners has been submitted to the examiners-in-chief. *Ibid.*

(*b*) The renewal oath dispensed with in all cases by act of 1863, § 1.

SECTION 4. *And be it further enacted*, That the salary of the Commissioner of Patents, from and after the passage of this act, shall be four thousand five hundred dol-

lars per annum, and the salary of the chief clerk of the Patent Office shall be two thousand five hundred dollars, and the salary of the librarian of the Patent Office shall be eighteen hundred dollars.

Previous to this act, the salary of the Commissioner had been three thousand dollars per annum (act of 1836, section 1); that of the chief clerk, seventeen hundred dollars per annum (act of 1836, section 2); and the compensation of the librarian, one thousand five hundred dollars per annum (act of 1853; act of 1855, section 25).

SECTION 5. *And be it further enacted*, That the Commissioner of Patents is authorized to restore to the respective applicants, or when not removed by them, to otherwise dispose of such of the models belonging to rejected applications as he shall not think necessary to be preserved. The same authority is also given in relation to all models accompanying applications for designs. He is further authorized to dispense in future with models of designs when the design can be sufficiently represented by a drawing.

SECTION 6. [Repealing act of 1837, § 10.] *And be it further enacted*, That the tenth section of the act approved the third of March, eighteen hundred and thirty-seven, authorizing the appointment of agents for the transportation of models and specimens to the Patent Office, is hereby repealed.

SECTION 7. *And be it further enacted*, That the Commissioner is further authorized, from time to time, to appoint, in the manner already provided for by law, such an additional number of principal examiners, first assistant examiners, and second assistant examiners as may be required to transact the current business of the office with dispatch, provided the whole number of additional examiners shall not exceed four of each class, and that

the total annual expenses of the Patent Office shall not exceed the annual receipts.

SECTION 8. *And be it further enacted*, That the Commissioner may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the parties filing such papers; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. [Amending act of 1836, §§ 7, 12; and repealing in part § 13 of same act.] *And be it further enacted*, That no money paid as a fee on any application for a patent after the passage of this act shall be withdrawn or refunded (*a*), nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. (*b*) That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is deposited in the post office at Washington, with the regular time for the transmission to the same added thereto, which time shall be indorsed on the notice; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

(*a*) The right of withdrawal was given to American applicants by the act of 1836, section 7; and was extended to foreigners by the act of 1837, section 12.

(*b*) The right of having a caveat fee applied as part of the sum to be paid upon a subsequent application, was given by the act of 1836, section 12.

SECTION 10. *And be it further enacted*, That all laws now in force fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are hereby repealed, and in their stead the following rates are established:

On filing each caveat, ten dollars.

On filing each original application for a patent, except for a design, fifteen dollars.

On issuing each original patent, twenty dollars.

On every appeal from the examiner-in-chief to the Commissioner, twenty dollars.

On every application for the reissue of a patent, thirty dollars.

On every application for the extension of a patent, fifty dollars; and fifty dollars in addition, on the granting of every extension.

On filing each disclaimer, ten dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, and other papers of three hundred words or under, one dollar.

For recording every assignment, and other papers, over three hundred and under one thousand words, two dollars.

For recording every assignment or other writing, if over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making the same.

SECTION 11. [Superseding act of 1842, § 3.] *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue or bas-relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents, expressing such desire; and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application: *Provided*, That the fee to be paid in such

application shall be for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And, provided*, That the patentees of designs under this act shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patent shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent.

1. This act does not require *utility* in order to secure the benefits of its provisions. *Wooster* v. *Crane*, MS.—BENEDICT, J.; N. Y., 1866.

2. But it does require that the shape produced shall be the result of industry, effort, genius, and expense. *Ibid.*

3. *Semble*, That the shape or configuration sought to be secured should be new and original, as applied to articles of manufacture. *Ibid.*

4. W. obtained a patent for "the design and configuration of a reel" for containing ruffles, &c., and which consisted of two parallel disks of pasteboard, cut in the form of a rhombus, with the corners rounded, and connected by four wood cross pieces, on which the ruffles were wound. *Held*, the shape being a well-known mathematical figure, and a common one in many articles of manufacture, that its application to a reel could not be said to be the result of industry, genius, efforts, and expense. *Ibid.*

5. Under the present practice of the Patent Office, names, titles, bill-heads, and other matters intended for use as circulars or trade-marks, if printed in the ordinary movable type, are not held to be patentable as designs.

6. But when any such matter is the special work of an artist for a specified purpose, as when engraved, it may be patented as a design. Hence, when a patent is desired for a design to be used as a trade-mark, it is recommended that it should be engraved.

SECTION 12. [Amending act of 1836, § 18.] *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, they shall be regarded as abandoned by the parties thereto; unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable;

and all applications now pending shall be treated as if filed after the passage of this act, and all applications for the extension of patents, shall be filed at least ninety days before the expiration thereof; and notice of the day set for the hearing of the case shall be published, as now required by law, for at least sixty days.

The previous provisions as to the extension of patents are contained in section 18 of the act of 1836, and section 1 of the act of 1848, amending the former act of 1836.

SECTION 13. [Repealing act of 1842, § 6.] *And be it further enacted*, That in all cases where an article is made or vended by any person under the protection of letters patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word patented, together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters patent by the party failing so to mark the article the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented. And the sixth section of the act entitled "An act in addition to an act to promote the progress of the useful arts," and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be, and the same is hereby, repealed.

The act of 1842 imposed a penalty of one hundred dollars on each

article vended or offered for sale, not having the date of the patent stamped or marked upon it; but the neglect to do so did not affect the right of the patentee in any action of infringement brought by him under his patent.

SECTION 14. [Obsolete: Repealed by act of 1862.] *And be it further enacted*, That the Commissioner of Patents be, and he is hereby, authorized to print, or in his discretion to cause to be printed, ten copies of the description and claims of all patents which may hereafter be granted, and ten copies of the drawings of the same, when drawings shall accompany the patents: *Provided*, The costs of printing the text of said descriptions and claims shall not exceed, exclusive of stationery, the sum of two cents per hundred words for each of said copies, and the cost of the drawing shall not exceed fifty cents per copy; one copy of the above number shall be printed on parchment to be affixed to the letters patent; the work shall be under the direction, and subject to the approval, of the Commissioner of Patents, and the expense of the said copies shall be paid for out of the Patent fund.

SECTION 15. *And be it further enacted*, That printed copies of the letters patent of the United States, with the seal of the Patent Office affixed thereto and certified and signed by the Commissioner of Patents, shall be legal evidence of the contents of said letters patent in all cases.

SECTION 16. [Modifying act of 1836, § 5; Superseding act of 1836, § 18]. *And be it further enacted*, That all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue; and all extension of such patents is hereby prohibited.

SECTION 17. *And be it further enacted*, That all acts and parts of acts heretofore passed, which are inconsistent with the provisions of this act, be, and the same are hereby, repealed.

Approved March 2d, 1861.

ACT OF 1862, CHAPTER 182.

12 STATUTES AT LARGE, 583.

[*This Act still in Force.*]

An Act making supplemental appropriations for sundry civil expenses.

[Repealing act of 1861, § 14.] For the fund of the Patent Office, fifty thousand eight hundred and fifty-five dollars and forty-nine cents, to supply a deficiency existing under the act of March second, eighteen hundred and sixty-one, entitled "An act in addition to an act to promote the progress of the useful arts:" *Provided*, That the fourteenth section of said act be, and the same is hereby, repealed.

Approved July 16th, 1862.

ACT OF 1863, CHAPTER 102.

12 STATUTES AT LARGE, 796.

[*This Act still in Force.*]

An Act to amend an act entitled "An act to promote the progress of the useful arts."

SECTION 1. [Repealing act of 1836, § 7, in part.] *Be it enacted by the Senate and House of Representatives of*

the United States of America in Congress assembled, That so much of section seven of the act entitled "An act to promote the progress of the useful arts," approved July fourth, eighteen hundred and thirty-six, as requires a renewal of the oath, be, and the same is hereby, repealed.

SECTION 2. *And be it further enacted*, That, whereas the falling off of the revenue of the Patent Office required a reduction of the compensation of the examiners and clerks, or other employees in the office, after the thirty-first day of August, eighteen hundred and sixty-one, that the Commissioner of Patents be, and he is hereby, authorized, whenever the revenue of the office will justify him in so doing, to pay them such sums, in addition to what they shall already have received, as will make their compensation the same as it was at that time.

SECTION 3. [Extended by acts of 1864 and 1865.] *And be it further enacted*, That every patent shall be dated as of a day not later than six months after the time at which it was passed and allowed, and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within the said six months, the patent shall be withheld, and the invention therein described shall become public property as against the applicant therefor: *Provided*, That in all cases where patents have been allowed previous to the passage of this act, the said six months shall be reckoned from the date of such passage.

Approved March 3d, 1863.

ACT OF 1864, CHAPTER 159.

13 STATUTES AT LARGE, 194.

[*This Act still in Force.*]

An Act amendatory of "An act to amend an act entitled an act to promote the progress of the useful arts," approved March third, eighteen hundred and sixty-three.

[Enlarging act of 1863, § 3.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person having an interest in an invention, whether as the inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March third, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided by said act, shall have the right to make the payment of such fee, and receive the patent withheld on account of the non-payment of said fee, provided such payment be made within six months from the date of the passage of this act: *Provided*, That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent as aforesaid was ordered to be issued.

Approved June 25th, 1864.

ACT OF 1865, CHAPTER 112.

13 STATUTES AT LARGE, 533.

[*This Act still in Force.*]

An Act amendatory of "An act to amend an act entitled an act to promote the progress of the useful arts," approved March third, eighteen hundred and sixty-three.

[Enlarging act of 1863, § 3.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person having an interest in an invention, whether as inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March third, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided in said act, shall have the right to make an application for a patent for his invention, the same as in the case of an original application, provided such application be made within two years after the date of the allowance of the original application: *Provided*, That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent aforesaid was ordered to issue. This act shall apply to all cases now in the Patent Office, and also to such as shall hereafter be filed. And all acts or parts of acts inconsistent with this act are hereby repealed.

Approved March 3d, 1865.

ACT OF 1866, CHAPTER 126.

14 STATUTES AT LARGE, 66.

[*Obsolete: Temporary Enactment.*]

An Act to authorize the Commissioner of Patents to pay those employed as examiners and assistant examiners the salary fixed by law for the duties performed by them.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the Commissioner of Patents is hereby authorized to pay those employed in the patent office from April first, eighteen hundred and sixty-one, until the first day of August, eighteen hundred and sixty-five, as examiners and assistant examiners of patents, at the rates fixed by law for these respective grades; *Provided*, that the same be paid out of the patent office fund, and that the compensation thus paid shall not exceed that received by those duly enrolled as examiners and assistant examiners of patents for the same period.

Approved, June 18, 1866.

ACT OF 1866, CHAPTER 143.

14 STATUTES AT LARGE, 76.

[*This Act still in Force.*]

An Act in amendment of an act to promote the progress of the useful arts, and the acts in amendment of and in addition thereto.

[Qualifying Act of 1861, § 2.] *Be it enacted by the Senate and House of Representatives of the United States*

of America in Congress assembled, That upon appealing for the first time from the decision of the primary examiner to the examiners-in-chief in the patent office, the appellant shall pay a fee of ten dollars into the patent office, to the credit of the patent fund; and no appeal from the primary examiner to the examiners-in-chief shall hereafter be allowed until the appellant shall pay said fee.

Approved, June 27, 1866.

FORMS

UNDER THE PATENT LAWS.

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1. CAVEAT.
2. APPLICATION FOR PATENT, BY INVENTOR.
3. APPLICATION FOR PATENT, BY EXECUTOR OR ADMINISTRATOR.
4. APPLICATION FOR PATENT FOR A DESIGN.
5. APPLICATION FOR REISSUE, BY PATENTEE.
6. APPLICATION FOR REISSUE, BY ASSIGNEE OR EXECUTOR.
7. APPLICATION FOR EXTENSION, BY PATENTEE.
8. DISCLAIMER.
9. APPEAL TO EXAMINERS IN CHIEF.
10. APPEAL TO COMMISSIONER OF PATENTS.
11. APPEAL TO JUSTICES SUPREME COURT DISTRICT COLUMBIA.
12. DEPOSITIONS.
13. ASSIGNMENT OF INVENTION BEFORE PATENT: PATENT TO ISSUE TO ASSIGNEE.
14. ASSIGNMENT OF INVENTION BEFORE PATENT: PATENT TO ISSUE TO INVENTOR AND ANOTHER.
15. ASSIGNMENT OF ENTIRE OR PARTIAL INTEREST IN A PATENT.
16. ASSIGNMENT OF UNDIVIDED INTEREST IN PATENT.
17. EXCLUSIVE LICENSE TO MAKE AND USE AN INVENTION.
18. LICENSE TO USE AN INVENTION ON PAYMENT OF ROYALTY.

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1. CAVEAT.

Petition.

TO THE COMMISSIONER OF PATENTS:

The petition of John Fitch, of Philadelphia, in the county of Philadelphia and State of Pennsylvania,

RESPECTFULLY REPRESENTS:

That he has invented a new and improved mode of preventing steam boilers from bursting, and that he is now engaged in making experiments for the purpose of perfecting the same, pre-

CAVEAT.

paratory to his applying for letters patent therefor. He therefore prays that the subjoined description of his invention may be filed as a caveat in the confidential archives of the Patent Office, agreeably to the provisions of the act of Congress in that case made and provided; he having paid ten dollars into the treasury of the United States, and otherwise complied with the requirements of the said act.

JOHN FITCH.

PHILADELPHIA, March 1, 1856.

Description of Invention.

TO ALL WHOM IT MAY CONCERN:

Be it known that I, John Fitch, of Philadelphia, in the county of Philadelphia, and State of Pennsylvania, have invented a new and improved mode of preventing steam boilers from bursting, and that the following is a general description thereof.

My invention consists in making in the upper part of a steam boiler an aperture similar to that made for the safety-valve; and in filling or closing such aperture with a plug or disk of some alloy, which will fuse at any given degree of heat, and permit the steam to escape, should the safety-valve fail to perform its functions.

The steam boiler is constructed in any of the known forms, and may have applied to it gauge-cocks, a safety-valve, and other usual appendages. To obviate any danger that may arise from the adhesion of the safety-valve or from any other cause, I make in the top of the boiler an opening similar to that made for the safety-valve, and I fill such opening with a plug or disk of fusible alloy, secured in any sufficient manner. Such fusible plug may be made so as to melt at a given temperature, which will be that to which it is desired to limit the pressure of the steam.

When the temperature of the steam in the boiler rises to such limit, the alloy will melt and allow the steam to escape, thus preventing all danger of explosion.

JOHN FITCH.

Witnesses—
ROBERT FULTON,
OLIVER EVANS.

The description in a caveat need not be as particular as is requisite in a specification; but should be sufficiently precise to enable the Patent Office to judge as to any probable interference when a subsequent application is filed.

APPLICATION FOR PATENT, BY INVENTOR.

Oath.

CITY AND COUNTY OF PHILADELPHIA,
STATE OF PENNSYLVANIA, } *ss.*

On this first day of March, 1856, before me, the subscriber, a justice of the peace, personally appeared the within-named John Fitch, and made solemn oath [or affirmation] that he verily believes himself to be the original and first inventor of the mode herein described for preventing steam boilers from bursting, and that he does not know or believe the same was ever before known or used; and that he is a citizen of the United States [or in the case of an alien, and that he is a native of (naming the country), that he has resided in the United States for the year last past, and has made oath of his intention to become a citizen thereof].

5 CENT INT. REV. STAMP.

BENJAMIN FRANKLIN,
Justice of the Peace.

2. APPLICATION FOR PATENT, BY INVENTOR.

Petition.

TO THE COMMISSIONER OF PATENTS:

The petition of John Fitch, of Philadelphia, in the county of Philadelphia and State of Pennsylvania,

RESPECTFULLY REPRESENTS:

That your petitioner has invented a new and improved mode of preventing steam boilers from bursting, which he verily believes has not been known or used prior to the invention thereof by your petitioner. He therefore prays that letters patent of the United States may be granted to him therefor, vesting in him and his legal representatives the exclusive right to the same, upon the terms and conditions expressed in the act of Congress in that case made and provided; he having paid fifteen dollars into the treasury, and complied with the other provisions of the said act.

JOHN FITCH.

PHILADELPHIA, January 1, 1857.

APPLICATION FOR PATENT, BY INVENTOR.

Specification.

TO ALL WHOM IT MAY CONCERN:

Be it known that I, John Fitch, of Philadelphia, in the county of Philadelphia, in the State of Pennsylvania, have invented a new and improved mode of preventing steam boilers from bursting [or, a new and useful machine for (stating the use and title of the machine); or, a new and useful improvement on a, or on the, machine, &c.]; and I do hereby declare that the following is a full and exact description thereof, reference being had to the accompanying drawings, and to the letters of reference marked thereon, making a part of this specification.

The nature of my invention consists in providing the upper part of a steam boiler with an aperture in addition to that for the safety-valve; which aperture is to be closed by a plug or disk of alloy, which will fuse at any given degree of heat, and permit the steam to escape, should the safety-valve fail to perform its functions.

To enable others skilled in the art to make and use my invention, I will proceed to describe its construction and operation. I construct my steam boiler in any of the known forms, and apply thereto gauge-cocks, a safety-valve, and the other appendages of such boilers; but in order to obviate the danger arising from the adhesion of the safety-valve, and from other causes, I make a second opening in the top of the boiler, similar to that made for the safety-valve, as shown at A, in the accompanying drawing; and in this opening I insert a plug or disk of fusible alloy, securing it in its place by a metal ring and screws, or otherwise. This fusible metal I, in general, compose of a mixture of lead, tin, and bismuth, in such proportions as will insure its melting at a given temperature, which must be that to which it is intended to limit the steam; and will, of course, vary with the pressure the boiler is intended to sustain.

I surround the opening containing the fusible alloy by a tube B, intended to conduct off any steam which may be discharged therefrom. When the temperature of the steam in such a boiler rises to its assigned limit, the fusible alloy will melt, and allow the steam to escape freely, thereby securing it from all danger of explosion.

What I claim as my invention, and desire to secure by letters patent, is the application to steam-boilers of a fusible alloy which will melt at a given temperature, and allow the steam to escape, as herein described, using for that purpose the aforesaid

APPLICATION FOR PATENT, BY INVENTOR.

metallic compound, or any other substantially the same, and which will produce the intended effect.

JOHN FITCH.

Witnesses—
ROBERT FULTON,
OLIVER EVANS.

Oath.

CITY AND COUNTY OF PHILADELPHIA,
STATE OF PENNSYLVANIA, } *ss.*

On this first day of January, 1857, before me, the subscriber, a justice of the peace, personally appeared the within-named John Fitch, and made solemn oath [or affirmation] that he verily believes himself to be the original and first inventor of the mode herein described for preventing steam boilers from bursting, and that he does not know or believe the same was ever before known or used; and that he is a citizen of the United States [or citizen or subject of other country, as the case may be].

.....
: 5 CENT :
: INT. REV. :
: STAMP. :
.....

BENJAMIN FRANKLIN,
Justice of the Peace.

If the application is made through a solicitor or other person, there will be required a Power of Attorney, which may be as follows

Power of Attorney.

KNOW ALL MEN BY THESE PRESENTS, That I, John Fitch, hereby constitute and appoint Robert Morris, of the city of Philadelphia, or his accredited agent, my Attorney, to prosecute, before the Patent Office of the United States, the accompanying application; to alter or modify the Specification and Claim therein as may be necessary, and as he may deem expedient; to receive any Letters Patent which may be granted therefor; and to do all things proper and necessary in the premises, with full power of substitution and revocation.

Witness my hand, this first day of January, A. D. 1857.

.....
: 50 CENT :
: INT. REV. :
: STAMP. :
.....

JOHN FITCH.

APPLICATION FOR PATENT, BY EXECUTOR OR ADMINISTRATOR.

3. Application for Patent, by executor or administrator of inventor.

Petition.

To the Commissioner of Patents:

The petition of Robert Morris, of Philadelphia, in the county of Philadelphia, and State of Pennsylvania, executor of John Fitch, of the same place,

Respectfully represents:

That, as your petitioner is informed and believes, John Fitch, late of said city, was, during his lifetime, the first and original inventor of a new and improved mode of preventing steam boilers from bursting, which your petitioner believes had not been known or used prior to the invention thereof by said John Fitch.

That said John Fitch died, at the said city of Philadelphia, on or about the first day of January, 1857, and that your petitioner, upon due and proper proceedings being had, and having complied with all the requirements of the law in such cases made and provided, was appointed executor [or administrator of the goods and effects] of him, said Fitch.

Your petitioner therefore prays that letters patent of the United States may be granted to him therefor, vesting in him, in trust for the heirs at law [or devisees] of said Fitch, the exclusive right to the said invention, upon the terms and condition expressed in the act of Congress in that case made and provided; he having paid fifteen dollars into the treasury, and complied with the other provisions of the said act.

ROBERT MORRIS,
Executor of John Fitch.

Philadelphia, July 1, 1857.

Specification.

To all whom it may concern:

Be it known that John Fitch, of Philadelphia, in the county of Philadelphia, and State of Pennsylvania, invented a new and improved mode of preventing steam boilers from bursting, and that the following is a full and exact description thereof, refer-

ence being had to the accompanying drawings and to the letters of reference marked thereon, making a part of this specification.

The nature of the said invention, &c. [The specification will be the same as before, except that it will be in the third person.]

ROBERT MORRIS,
Executor of John Fitch.

Witnesses—
ROBERT FULTON,
OLIVER EVANS.

Oath.

CITY AND COUNTY OF PHILADELPHIA,
STATE OF PENNSYLVANIA, } *ss.*

On this first day of July, 1857, before me, the subscriber, a justice of the peace, personally appeared the within-named Robert Morris, and made solemn oath [or affirmation] that he is the executor [or administrator] of John Fitch, deceased, late of said city and State, that he verily believes the said John Fitch was the original and first inventor of the mode herein described for preventing steam boilers from bursting; and that he does not know or believe the same was ever known or used before the invention thereof by said John Fitch; and that the said John Fitch was, and the said Robert Morris is, a citizen of the United States.

BENJAMIN FRANKLIN,
Justice of the Peace.

5 CENT INT. REV. STAMP.

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4. APPLICATION FOR PATENT FOR A DESIGN.

Petition.

TO THE COMMISSIONER OF PATENTS:

The petition of Benjamin West, of the city and county of Philadelphia and State of Pennsylvania,

RESPECTFULLY REPRESENTS:

That your petitioner has invented or produced a new and original design or pattern for carpets [or design for a trade-mark], which he verily believes has not been known prior to

APPLICATION FOR PATENT FOR A DESIGN.

the production thereof by your petitioner. He therefore prays that letters patent of the United States may be granted to him therefor, for the term of three and a half [or seven, or fourteen] years, vesting in him and his legal representatives the exclusive right to the same, upon the terms and conditions expressed in the act of Congress in that case made and provided, he having paid ten [or fifteen, or thirty] dollars into the treasury and complied with the other provisions of the said act.

BENJAMIN WEST.

PHILADELPHIA, January 1, 1866.

Specification.

TO ALL WHOM IT MAY CONCERN:

Be it known that I, Benjamin West, of the city of Philadelphia, in the county of Philadelphia and State of Pennsylvania, have originated and designed a new pattern for carpets or other fabrics [or design for a trade-mark], of which the following is a full, clear, and exact description, reference being had to the accompanying specimens or drawings, making part of this specification.

[Here follows a description of the design, with reference to the specimen or drawing, the specification to conclude as follows:]

Claim.

What I claim as my invention and desire to secure by letters patent, is the design or pattern for carpets or other fabrics [or design for a trade-mark] herein set forth.

BENJAMIN WEST.

Witnesses—
NOAH WEBSTER,
NATHANIEL BOWDITCH.

Oath.

CITY AND COUNTY OF PHILADELPHIA,
STATE OF PENNSYLVANIA, } *ss.*

On this first day of January, 1866, before the subscriber, a justice of the peace, personally appeared the within-named Benjamin West, and made solemn oath [or affirmation, as the case may be] that he verily believes himself to be the original and first inven-

tor, or producer, of the design or pattern for carpets [or design for a trade-mark] herein described, and that he does not know or believe that the same was ever before known or used, and that he is a citizen of the United States.

BENJAMIN FRANKLIN,
Justice of the Peace.

5 CENT INT. REV. STAMP.

5. APPLICATION FOR REISSUE, BY THE ORIGINAL PATENTEE.

Petition.

TO THE COMMISSIONER OF PATENTS:

The petition of Samuel Morey, of Philadelphia, in the county of Philadelphia and State of Pennsylvania,

RESPECTFULLY REPRESENTS:

That he did obtain letters patent of the United States for an improvement in the boilers of steam-engines, which letters patent are dated on the first day of March, 1850; that he now believes that the same are inoperative and invalid by reason of a defective specification, which defect has arisen from inadvertence and mistake. He therefore prays that he may be allowed to surrender the same, and requests that new letters patent may issue to him, for the same invention, for the residue of the period for which the original patent was granted, under the amended specification herewith presented, he having paid thirty dollars into the treasury of the United States, agreeably to the requirements of the act of Congress in that case made and provided.

SAMUEL MOREY.

PHILADELPHIA, January 1, 1860.

Specification.

TO ALL WHOM IT MAY CONCERN:

Be it known that I, Samuel Morey, of Philadelphia, in the county of Philadelphia, in the State of Pennsylvania, have invented a new and useful improvement in the boilers of steam-

APPLICATION FOR REISSUE, BY ASSIGNEE OR EXECUTOR.

engines; and I do hereby declare that the following is a full and exact description thereof, reference being had to the accompanying drawings, and to the letters of reference marked thereon.

[The specification will conform substantially to that in the original application, with such changes in the description and claims thereof as shall embrace what is sought to be covered by the reissue.]

[But as a reissued patent must be for the "same invention for which the original patent was granted" (act 1836, § 13), care should be taken not to make any such alterations or changes as will expand the invention beyond that originally described or represented, as such enlargement of the invention will vitiate the patent, even if granted.]

Oath.

CITY AND COUNTY OF PHILADELPHIA,
STATE OF PENNSYLVANIA, } *ss.*

On this first day of January, 1860, before the subscriber, a justice of the peace, personally appeared the above-named Samuel Morey, and made solemn oath [or affirmation] that he verily believes that, by reason of an insufficient or defective specification, his aforesaid patent is not fully valid and available to him; and that the said error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, to the best of his knowledge or belief.

JAMES DALLAS,
Justice of the Peace.

5 CENT INT. REV. STAMP.

6. APPLICATION FOR REISSUE BY THE ASSIGNEE, OR EXECUTOR, OF THE ORIGINAL PATENTEE.

Petition.

TO THE COMMISSIONER OF PATENTS:

The petition of James C. Fisher, of Philadelphia, in the county of Philadelphia and State of Pennsylvania,

APPLICATION FOR REISSUE, BY ASSIGNEE OR EXECUTOR.

RESPECTFULLY REPRESENTS:

That Samuel Morey, of said city, did obtain letters patent of the United States for an improvement in the boilers of steam-engines, which letters patent are dated on the first day of March, 1850; that your petitioner, by an assignment duly made and executed, bearing date the first day of January, 1855 [or by mesne assignments duly made and executed], and recorded in the Patent Office of the United States, has become the owner and holder of said letters patent [or that the said Samuel Morey departed this life on the tenth day of May, 1858, and that your petitioner has been duly appointed his executor]; and your petitioner now believes that the said letters patent are inoperative and invalid, by reason of a defective specification, which defect has arisen from inadvertence and mistake. He therefore prays that he may be allowed to surrender the same, and requests that new letters patent may issue to him, for the same invention, for the residue of the period for which the original patent was granted, under the amended specification herewith presented, he having paid thirty dollars into the Treasury of the United States, agreeably to the requirements of the act of Congress in that case made and provided.

JAMES C. FISHER.

PHILADELPHIA, January 1, 1860.

Specification.

TO ALL WHOM IT MAY CONCERN:

Be it known that Samuel Morey, of Philadelphia, State of Pennsylvania, invented a new and useful improvement in steam boilers, and that the following is a full and exact description thereof, reference being had to the accompanying drawings and to the letters of reference marked thereon, and making a part of this specification.

[The rest of the specification will be as in No. 5, except that it will be expressed in the third person.]

Oath.

CITY AND COUNTY OF PHILADELPHIA, }
STATE OF PENNSYLVANIA, } *ss.*

On this first day of January, 1860, before the subscriber, a justice of the peace, personally appeared the above-named

APPLICATION FOR EXTENSION, BY PATENTEE.

James C. Fisher, and made solemn oath [or affirmation] that he verily believes that, by reason of an insufficient or defective specification, the aforesaid patent is not fully valid and available to him; and that the said error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, to the best of his knowledge or belief.

BENJAMIN FRANKLIN,
Justice of the Peace.

5 CENT INT. REV. STAMP.

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7. Application for extension, by Patentee.

Petition.

To the Commissioner of Patents:

The Petition of Sebastian Cabot, of Cabotsville, in the county of Hampden and State of Massachusetts,

Respectfully represents:

That your petitioner, on the tenth day of April, 1849, duly obtained letters patent of the United States, for improvements in machines for manufacturing weavers' heddles; that said letters patent were issued in the name of your petitioner [and were duly reissued to him on the first day of August, 1860, if such was the fact]: that your petitioner verily believes himself to be the original and first inventor of said improvement; that he has made diligent exertions to put said invention into general use, and to realize compensation from the public therefor, but that, without neglect or fault on his part, he has failed to obtain from the use and sale of said invention a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use.

Your petitioner therefore prays, that the said letters patent may be duly extended, according to law.

SEBASTIAN CABOT.

Cabotsville, January 1, 1863.

APPLICATION FOR EXTENSION, BY PATENTEE.

Statement.

In the matter of the application of Sebastian Cabot, for the extension of letters patent of the United States granted to him on the 10th day of April, 1849, for improvements in machines for manufacturing wire heddles.	Before the Commissioner of Patents.

Statement and Account, prepared and submitted under the provisions of § 18, *of the act of* 1836.

The Statement of Sebastian Cabot, of Cabotsville, county of Hampden and State of Massachusetts, the above-named applicant, respectfully shows:

[Such statement should set forth clearly and intelligibly the facts and circumstances connected with the original invention, and its development; the time and money spent in perfecting the same; the efforts that have been made to effect its introduction into use; and such facts as go to show or prove the ascertained value of the invention; and all receipts derived from and expenditures paid out in connection with such invention, which receipts and expenditures should be sufficiently in detail to exhibit a true and faithful account of loss and profit, in any manner accruing from and by reason of the invention.

Such statement should also be accompanied by an account, showing in debit and credit the expenditures and receipts connected with the invention, and set out in the statement.]

SEBASTIAN CABOT.

CABOTSVILLE, January 1, 1863.

Oath.

STATE OF MASSACHUSETTS, } *ss.*
COUNTY OF HAMPDEN. }

On this first day of January, 1863, before me, the subscriber, a justice of the peace, personally appeared the above-named Sebastian Cabot, and made solemn oath [or affirmation] that he verily believes that the foregoing statement and account, signed by him, is a true and correct account of the receipts and expenditures derived from and paid out in connection with his be-

DISCLAIMER.

fore-mentioned invention and letters patent, and of the ascertained value of such invention, and that he has, without neglect or fault on his part, failed to obtain from the use and sale of his said invention a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and its introduction into use.

JAMES NEWBOLD,
Justice of the Peace.

5 CENT INT. REV. STAMP.

An application for an extension, made by an executor or administrator of the patentee, will be substantially like the above, except that changes will be made in the petition and oath similar to such as are set forth and contained in Form 3.

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8. DISCLAIMER.

TO THE COMMISSIONER OF PATENTS:

The petition of Sebastian Cabot, of Cabotsville, in the county of Hampden and State of Massachusetts,

RESPECTFULLY REPRESENTS:

That letters patent of the United States, bearing date the first day of March, 1850, were granted to your petitioner for certain improvements in the steam-engine [or, "that he has, by assignment, duly recorded in the Patent Office, become the owner of a right for the several States of Massachusetts, Connecticut, and Rhode Island, to certain improvements in the steam-engine, for which letters patent of the United States were granted to John Doe, of Boston, in the State of Massachusetts, dated on the first day of March, 1850"]; that he has reason to believe that, through inadvertence and mistake, the claim made in the specification of said letters patent is too broad, including that of which your petitioner [or the said patentee] was not the first inventor. Your petitioner, therefore, hereby enters his disclaimer to that part of the claim in the aforenamed specification which is in the following words, to wit: "I also claim the particular manner in which the piston of the above-described engine is constructed so as to insure the close fitting of the packing

thereof to the cylinder, as set forth;" which disclaimer is to operate to the extent of the interest in said letters patent vested in your petitioner, who has paid ten dollars into the Treasury of the United States, agreeably to the requirements of the act of Congress in that case made and provided.

CABOTSVILLE, January 1, 1860. SEBASTIAN CABOT.

Witnesses—
JOHN DOE,
RICHARD ROE.

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9. APPEAL TO EXAMINERS IN CHIEF.

TO THE COMMISSIONER OF PATENTS:

SIR: In conformity with section third of the act of Congress dated 2d March, 1861, I hereby make application for an appeal from the decision of the principal examiner in the matter of my application for a patent for an improvement in the manner of tripping the valves of steam-engines, rejected a second time on tenth day of December, 1863, and request that the same may be heard by the examiners in chief, the fee on appeal required in such cases having been paid.

Dated, January 1, 1864. Respectfully,
JOHN ERRICSON.

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10. APPEAL TO THE COMMISSIONER OF PATENTS.

TO THE COMMISSIONER OF PATENTS:

SIR: In conformity with section second of the act of Congress dated 2d March, 1861, I hereby make application for an appeal, in the matter of my application for a patent for an improvement in the manner of tripping the valves of steam-engines, from the decision of the examiners in chief, made therein, on the third day of February, 1864, and request that the same may be heard by you, in person, the fee required by said act having been duly paid by your petitioner.

JOHN ERRICSON.

Dated, March 1, 1864.

APPEAL TO JUSTICES SUPREME COURT, DISTRICT OF COLUMBIA.

11. Appeals to the Justices of the Supreme Court of the District of Columbia.

1. *In case of refusal of Patent.*

To the Hon. Judges of the Supreme Court of the District of Columbia:

The petition of Charles Marshall, of New York, in the county of New York and State of New York, respectfully showeth, that he has heretofore invented a new and useful improvement in machines for crushing ore, and has applied to the Patent Office of the United States for a patent for the same, and has complied with the requirements of the several acts of Congress, and with the rules of the Patent Office prescribed in such cases; that his said application has been rejected by the Commissioner of Patents; that he has filed in said office his prayer for an appeal from said decision, and notice thereof to said Commissioner, and his reasons of appeal, and paid into the same the sum of twenty-five dollars upon said appeal; all which will appear from the certificate of said Commissioner of Patents hereto annexed.

And the said Charles Marshall prays that his said appeal may be heard and determined by your Honors, at such time as may be appointed for that purpose; and that the Commissioner of Patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

Patent Office, Washington, D. C.,
January 10th, 1866.

I hereby certify that the above-named Charles Marshall has complied with the requisites of the law necessary to perfect his aforesaid appeal.

T. C. THEAKER,
Commissioner of Patents.

To the Hon. T. C. Theaker, Commissioner of Patents:

Charles Marshall, of New York, in the county of New York and State of New York, prays that an appeal may be allowed him from the decision of your Department, rejecting his application for a patent for improvements in machines for crushing ore, and of this you are respectfully requested to take notice.

APPEAL TO JUSTICES SUPREME COURT, DISTRICT OF COLUMBIA.

And the said Charles Marshall assigns the following reasons for appealing from the said decision of the Commissioner of Patents, viz.:

2. *In case of rejection on Interference.*

TO THE HON. JUDGES OF THE SUPREME COURT OF THE DISTRICT OF COLUMBIA:

The petition of Charles Marshall, of New York, in the county of New York and State of New York, respectfully showeth, that he has heretofore invented a new and useful machine for desulphurizing ores, and has applied to the Patent Office of the United States for a patent for the same, and has complied with the requirements of the several acts of Congress, and with the rules of the Patent Office prescribed in such cases; that afterwards it was declared by the Commissioner of Patents that your petitioner's claims interfered with those of James King, of Ausburn, in the county of Monroe and State of New York, an applicant for a patent for a similar invention, and the question of priority of invention was determined by him in favor of the said James King; that your petitioner has filed in said office his prayer for an appeal from said decision, and notice thereof to said Commissioner, and his reasons of appeal, and paid into the same the sum of twenty-five dollars upon said appeal; all which will appear from the certificate of said Commissioner of Patents hereto annexed.

And the said Charles Marshall prays that his said appeal may be heard and determined by your Honors, at such time as may be appointed for that purpose; and that the Commissioner of Patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

CHARLES MARSHALL.

NEW YORK, Feb. 1, 1866.

PATENT OFFICE, WASHINGTON, D. C.,
February 4th, 1866.

I hereby certify that the above-named Charles Marshall has complied with the requisites of the law necessary to perfect his aforesaid appeal.

T. C. THEAKER,
Commissioner of Patents.

DEPOSITIONS.

To THE HON. T. C. THEAKER, Commissioner of Patents:

Charles Marshall, of New York, in the county of New York and State of New York, prays that an appeal may be allowed him from the decision of your Department upon the interference declared between the said Charles Marshall and James King, and determining the question of priority in favor of the said James King, and of this you are respectfully requested to take notice.

And the said Charles Marshall assigns the following reasons for appealing from the said decision of the Commissioner of Patents, viz.:

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12. DEPOSITIONS.

1. *Notice of taking.*

In the matter of the Interference between the application of E. F. for a Patent for Improvement in Skirts, and the application of I. K. for a Patent for the same invention.	Before the Commissioner of Patents.

SIR: Please take notice that an examination of witnesses in the above matter, on the part of the said E. F., will be had in the city of New York, at the office of R. S. Stillwell, Nos. 41 and 43 Chambers Street, in said city, before R. S. Stilwell, United States Commissioner, or some person authorized to take depositions, and that said examination will commence on the first day of January, 1866, at ten o'clock in the forenoon, and that the same will be adjourned from time to time, if necessary, until the witnesses produced shall be examined.

You can attend, and cross-examine the witnesses produced, if you desire. Yours, &c.,

Dated, NEW YORK, Dec. 24, 1866. RUFUS CHOATE,
Counsel for E. F.

To CHARLES SULLIVAN, Esq.,
Counsel for I. K., 25 Wall Street, New York.

Such notice is required only in interference and other contested cases. It must be served a reasonable time before the time of taking the deposition, by delivering a copy to the adverse party; or, if he cannot be found, such service may be made upon his agent or attorney, or by leaving a copy at his usual place of residence, with some member of his family arrived at years of discretion.

DEPOSITIONS.

2. *Deposition, form of.*

In the matter of the Interference between the application of E. F. for a patent for Improvement in Skirts, and the application of I. K. for a patent for the same invention.	Before the Commissioner of Patents.

Depositions of witnesses, produced, sworn, and examined in the above matter, on the part of E. F., before me, R. S. Stilwell, United States Commissioner, at my office, Nos. 41 and 43 Chambers Street, in the city of New York, on the first day of January, 1866, pursuant to the foregoing notice hereto annexed, marked Exhibit A.

Present: RUFUS CHOATE, Esq., Counsel for E. F., and CHARLES SULLIVAN, Esq., Counsel for I. K.

A. B., a witness produced on the part of said E. F., being duly sworn, doth depose and say, in answer to interrogatories propounded to him by Rufus Choate, counsel for E. F., as follows:

1. *Interrogatory.* What is your name, age, residence, and occupation?

1. *Answer.* My name is A. B.; my age is 45; I am a carpenter, and reside in Boston, Massachusetts.

And in answer to cross-interrogatories proposed to him by George Sullivan, counsel for I. K., as follows, viz.:

1. *Cross-Interrogatory, &c.*

(Signed) A. B.

STATE OF NEW YORK, }
CITY AND COUNTY OF NEW YORK. } *ss.*

At the said city and county, on the 1st day of January, A. D. 1866, before me personally appeared the above-named A. B., and made oath that the foregoing deposition, by him subscribed, contains the whole truth, and nothing but the truth.

The said deposition is taken at the request of E. F., to be used upon the hearing of an interference between the claims of

the said E. F. and those of I. K., before the Commissioner of Patents of the United States, at his office, on the first Monday of February next. The said I. K. was duly notified, as appears by the original notice hereto annexed, and attended by George Sullivan, his counsel.

5 CENT INT. REV. STAMP.

Certified by me,

R. S. STILWELL,
U. S. Commissioner.

Certificate on the envelope containing the depositions.

I hereby certify that the depositions of A. B., C. D., &c., relating to the matter of interference between E. F. and G. H., were taken, sealed up, and addressed to the Commissioner of Patents by me.

R. S. STILWELL,
U. S. Commissioner.

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13. Assignment of invention before Patent: Patent to issue to assignee.

Whereas I, Jethro Wood, of Scipio, in the county of Cayuga and State of New York, have invented certain new and useful improvements in Ploughs, for which I am about to make application for letters patent of the United States; and whereas David Peacock, of Burlington, New Jersey, has agreed to purchase from me all the right, title, and interest which I have, or may have, in and to the said invention in consequence of the grant of letters patent therefor, and has paid to me, the said Wood, the sum of five thousand dollars, the receipt of which is hereby acknowledged: Now this indenture witnesseth, that for and in consideration of the said sum to me paid, I have assigned and transferred, and do hereby assign and transfer, to the said David Peacock, the full and exclusive right to all the improvements made by me, as fully set forth and described in the specification which I have prepared and executed preparatory to the obtaining of letters patent therefor. And I do hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said David Peacock, as the assignee of my whole

ASSIGNMENT BEFORE PATENT, TO INVENTOR AND ANOTHER.

right and title thereto, for the sole use and behoof of the said David Peacock and his legal representatives.

In testimony whereof, I have hereunto set my hand and affixed my seal this 16th day of February, 1856.

Sealed and delivered in the presence of
GEORGE CLYMER,
DAVID RITTENHOUSE.

JETHRO WOOD. [SEAL.]

STATE OF NEW YORK, COUNTY OF CAYUGA. } ss.

On this 16th day of February, 1856, before me, a justice of the peace, within and for said county, personally appeared Jethro Wood, to me known to be the individual described in, and who executed, the foregoing assignment, and acknowledged that he executed the same for the uses and purposes therein mentioned.

A. B.,
Justice of the Peace.

5 CENT INT. REV. STAMP.

An acknowledgment is not required by the statute, but it is most advisable to have it made.

---

14. ASSIGNMENT OF INVENTION BEFORE PATENT: PATENT TO ISSUE TO INVENTOR AND ANOTHER.

Whereas I, Jethro Wood, of Scipio, in the county of Cayuga and State of New York, have invented certain new and useful improvements in Ploughs, for which I am about to make application for letters patent of the United States; and whereas David Peacock, of Burlington, New Jersey, is desirous of obtaining an interest in the said invention, and in any letters patent that may be obtained therefor, and has paid to me, the said Wood, the sum of five thousand dollars, the receipt of which is hereby acknowledged: Now this indenture witnesseth, that, for and in consideration of the said sum to me paid, I have assigned and transferred, and do hereby assign and transfer to the said David Peacock and to myself, the full and exclusive right to all the improvements made by me, as fully set forth and described

in the specification which I have prepared and executed preparatory to the obtaining of letters patent therefor. And I do hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said David Peacock and to myself, as the assignees of my whole right and title thereto, for the sole use and behoof of the said David Peacock and myself, and our legal representatives.

In testimony whereof, I have hereunto set my hand and affixed my seal, this 16th day of February, 1856.

Sealed and delivered in presence of
GEORGE CLYMER,
DAVID RITTENHOUSE.

JETHRO WOOD. [SEAL.]

5 CENT INT. REV. STAMP.

Acknowledgment, as in No. 13.

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15. ASSIGNMENT OF THE ENTIRE OR OF A PARTIAL INTEREST IN A PATENT.

Whereas I, Jethro Wood, of Scipio, in the county of Cayuga and State of New York, did obtain letters patent of the United States for certain improvements in Ploughs, which letters patent bear date the 1st day of March, 1855; and whereas David Peacock, of Burlington, New Jersey, is desirous of acquiring an interest therein: Now this indenture witnesseth, that for and in consideration of the sum of two thousand dollars, to me in hand paid, the receipt of which is hereby acknowledged [or to be paid according to the terms of a certain agreement, of even date herewith, made by and between said Peacock and myself], I have assigned, sold, and set over, and do hereby assign, sell, and set over, unto the said David Peacock, all the right, title, and interest which I have in the said invention, as secured to me by said letters patent, for, to, and in the entire territory of the United States [or in the several States of New York, New Jersey, and Pennsylvania, and in no other place or places]; the same to be held and enjoyed by the said David Peacock, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are granted [if it is intended to assign for any extended term, then add—and for the term of any extension thereof], as

fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof, I hereunto set my hand and affix my seal, this 16th day of February, 1856.

Sealed and delivered in the presence of
JACOB PERKINS,
BENJAMIN FRANKLIN.

JETHRO WOOD. [SEAL.]

5 CENT INT. REV. STAMP.

Acknowledgment, as in No. 13.

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16. ASSIGNMENT OF AN UNDIVIDED INTEREST IN A PATENT.

Whereas I, Jethro Wood, of Scipio, in the county of Cayuga and State of New York, did obtain letters patent of the United States for certain improvements in Ploughs, which letters patent bear date the 1st day of March, 1855; and whereas David Peacock, of Burlington, New Jersey, is desirous of acquiring an interest therein: Now this indenture witnesseth, that for and in consideration of the sum of two thousand dollars, to me in hand paid, the receipt of which is hereby acknowledged, I have assigned, sold, and set over, and do hereby assign, sell, and set over, unto the said David Peacock, the full and equal undivided one-half part of all the right, title, and interest which I have in the said invention, as secured to me by said letters patent, for, to, and in the entire territory of the United States [or within the several States of New York, New Jersey, and Pennsylvania, but in no other places], the same to be held and enjoyed by the said David Peacock, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are granted [if it is intended to assign for any extended term, then add—and for the term of any extension thereof—] as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

It is hereby covenanted and agreed, by and between the parties hereto, that neither of said parties, their executors, administrators, or assigns, will sell or dispose of their interest in said patent, or grant licenses under the same to make and use, or

sell said invention, without the written consent of the other party first had and obtained.

It is further covenanted and agreed, by and between the parties hereto, and for themselves, their heirs, executors, administrators, and assigns, that in case they, or either of them, shall manufacture and sell ploughs under said letters patent, and containing the invention therein described, that the party so making and selling such ploughs shall and will pay to the other party hereto, or his representatives, as royalty or patent fee, the sum of one dollar on each and every plough so made and sold by him, which payment shall be made on the first day of January in each and every year; and that correct books of account of all ploughs so made shall be kept, which shall be open to the inspection of the other party or his representatives, at all reasonable times.

In testimony whereof, the said parties have hereunto set their hands and affixed their seals, this 16th day of February, 1856.

JETHRO WOOD. [SEAL.]
DAVID PEACOCK. [SEAL.]

Sealed and delivered in the presence of
JACOB PERKINS,
BENJAMIN FRANKLIN.

5 CENT INT. REV. STAMP.

Acknowledgment, as in No. 13.

17. EXCLUSIVE LICENSE TO MAKE, USE, AND SELL AN INVENTION.

Whereas letters patent of the United States, bearing date the 1st day of January, 1850, were granted to Jethro Wood, of Scipio, in the county of Cayuga and State of New York, for certain improvements in Ploughs, as by reference to said letters patent will more fully appear;

And whereas, John Brown, of Boston, State of Massachusetts, is desirous of obtaining the right to make, use, and sell the said invention within and for the States of Massachusetts, Connecticut, and Rhode Island, and has agreed to pay therefor the sum of three thousand dollars:

Now this indenture witnesseth, that the said Jethro Wood, for and in consideration of the sum of one thousand dollars in hand paid by the said John Brown, and of the two promissory

EXCLUSIVE LICENSE TO MAKE, USE, AND SELL AN INVENTION.

notes of the said John Brown, each being for the sum of one thousand dollars, and bearing even date with these presents, and payable in one and two years from the date thereof, with interest, the receipt of which money and notes is hereby acknowledged, hath given and granted, and by these presents does give and grant unto the said John Brown, his executors, administrators, and assigns, during the residue of the unexpired term of said letters patent, full and free liberty, license, power, and authority to make, use, and sell, or vend to others to be sold, either wholesale or retail, within and for the several States of Massachusetts, Connecticut, and Rhode Island, the said invention, or ploughs employing and using the invention described and set forth in said letters patent, and to receive to his and their own use any and all profits and advantages which shall or can be made by the making, use, and selling of said invention within said territory, and that without any let, suit, trouble, or hinderance of him, said Jethro Wood, his executors, or administrators, or any other person or persons claiming to hold and use said invention, from, by, or under him or them, by virtue of said letters patent, or otherwise.

Provided, however, that if at any time the said party of the second part or his representatives shall make default in the payment of the said promissory notes or either of them, it shall and may be lawful for the said party of the first part, or his representatives, to revoke and annul this license, upon giving written notice to such effect to said party of the second part, or his representatives, and which notice may be served by leaving the same at the ordinary place of business of said party of the second part, or his representatives, and if such note shall not be paid within ten days after such notice, then this license shall be and become null and void, and all rights and privileges under the same shall cease and determine; and thereupon it shall and may be lawful for any court of equity, having jurisdiction, to perpetually enjoin and restrain the said party of the second part, and his representatives, and all persons claiming under them, from making, using, or selling said invention or any part thereof.

The said party of the first part, for himself, his executors, administrators, and assigns, hereby covenants and agrees with the said party of the second part, that he or they will not license and empower any person or persons whatever to make, use, or sell the said invention within the territory before named, during the existence of this license; but nothing herein contained shall be construed to hinder or prevent the said party of the first part, or his representatives, from constructing or licensing the

EXCLUSIVE LICENSE TO MAKE, USE, AND SELL AN INVENTION.

construction of the said invention to be made and used elsewhere than in the territory aforesaid.

Should it be decided, before the said notes or either of them shall become due as aforesaid, by any court having jurisdiction to pass upon the validity of letters patent, that the said letters patent so granted to said Jethro Wood, are invalid and null and void, the said party of the second part shall be thereby released and discharged of and from the payment of such of the said promissory notes as then remain unpaid; and if either of said notes shall then be paid, said party of the first part covenants with said party of the second part to repay the one-half of whatever sums shall have been so paid: *Provided, however*, that if such adjudication, as to the validity of such letters patent, shall not have been made by the court of last resort, and the said Wood or his representatives shall determine to carry such decision to such court of last resort, that then the payment of any note so remaining unpaid shall be suspended until the determination of such court of last resort as to the validity of such patent, and such note shall be payable or otherwise, according as said letters patent shall be finally held to be valid, or null and void.

It is further agreed between the parties hereto, that in case any person or persons shall infringe the said letters patent within the said territory, the said John Brown, his executors, administrators, and assigns, may and shall have the right, for his and their benefit, in the name of the said Jethro Wood, his executors, administrators, and assigns, to commence, sue, and prosecute all such suits and actions, as shall be deemed expedient, against any person or persons who shall be guilty of any such infringement; and for this purpose the said Jethro Wood constitutes the said John Brown, his executors, administrators, and assigns, the lawful attorney or attorneys irrevocable of him, the said Jethro Wood, at the costs and to the use of the said John Brown, his executors, administrators, and assigns, to commence and prosecute, in the name of the said Jethro Wood, all such suits and actions aforesaid.

In witness whereof, the parties to these presents have hereunto set their hands and seals the day and year first above written.

JETHRO WOOD. [SEAL.]

Sealed and delivered in presence of } JOHN BROWN. [SEAL.]

Acknowledgment, as in No. 13.

5 CENT INT. REV. STAMP.

18. License to use an invention on payment of royalty.

Whereas certain letters patent of the United States, bearing date the 10th day of May, 1860, were issued to Rufus Dutton, of the city and State of New York, for improvements in Harvesting Machines, which said letters patent were afterwards surrendered, and new and reissued letters patent, for the same invention, issued to said Rufus Dutton, on the 1st day of June, 1863, as by reference to said letters patent will more fully appear;

And whereas, Robert Brown, of Providence, Rhode Island, is desirous of obtaining a license to use the improvements so patented to said Dutton in and upon mowing and reaping machines, to be manufactured and sold by him, said Brown:

Now this indenture witnesseth, that the said Rufus Dutton, for and in consideration of one dollar, to him in hand paid by said Robert Brown, and of the covenants hereinafter contained, and to be kept and performed by said Brown, has given and granted, and by these presents does give and grant, unto the said Robert Brown, his executors, administrators, and assigns, the liberty, license, power, and authority to make, use, and sell, within and for the State of Rhode Island, for and during the unexpired term of said patent, the said improvements so patented under and by said letters patent, upon the terms and conditions herein contained, and upon the payment of the sums of money as herein provided, and not otherwise.

1st. The said Robert Brown, for himself, his executors, administrators, and assigns, covenants and agrees to pay to said Rufus Dutton, his executors, administrators, and assigns, as patent fee or royalty, the following sums of money upon all mowing and reaping machines manufactured and sold by him, containing and using said improvements, or either of them, or any substantial part thereof, as follows, that is to say: upon each and every one-horse machine, the sum of five dollars; upon each and every two-horse machine, six dollars; and upon each mowing and reaping machine combined, the sum of seven dollars and fifty cents.

2d. The said Robert Brown, for himself, his executors, administrators, and assigns, also covenants and agrees to keep full and correct books of account of any and all mowing and reaping machines, and of the several kinds or sizes, which he or they may manufacture, containing or using the said invention, which said books of account shall be open, at all reasonable

LICENSE TO USE AN INVENTION ON PAYMENT OF ROYALTY.

times, to the inspection of said Rufus Dutton and his representatives, or his or their attorney, and on the first day of September of each and every year to make a true return, under oath, of all such machines manufactured and sold by him or them during the past year, and also remaining unsold; and within thirty days thereafter to pay to said Rufus Dutton, or his representatives, upon all such machines so manufactured and sold, the patent rent or royalty, as hereinbefore provided, and agreeable to the returns herein required.

3d. The said Robert Brown further covenants and agrees, for himself, his executors, administrators, and assigns, to mark or paint on each and every machine made and sold by them under this license, using or employing said invention or any part thereof, the words and figures, "Patented, May 10, 1860; June 1, 1863."

4th. The said Rufus Dutton, for himself, his executors, administrators, and assigns, covenants and agrees, that he or they will not grant licenses to any other parties, to make and sell machines using or employing said invention, for a less patent rent or royalty than above specified, without making corresponding reductions to the said party of the second part.

5th. Upon the failure of said party of the second part, his executors, administrators, or assigns, at any time to faithfully carry out and perform any or either of the said herein contained conditions and provisions, the said Rufus Dutton, his executors, administrators, or assigns, may revoke and annul this license, first giving said Robert Brown thirty days' notice thereof, in which case this license, and all rights and privileges hereunder, shall forever cease and determine.

In witness whereof, the said Rufus Dutton has hereunto set his hand and seal, this tenth day of May, A. D. 1866.

Sealed and delivered in presence of } RUFUS DUTTON. [L. S.]

I, the said Robert Brown above named, hereby accept the above license, and bind myself, my executors, administrators, and assigns, to observe faithfully all and each of the obligations, conditions, and covenants therein contained.

In witness whereof, I have hereunto set my hand and seal, this tenth day of May, A. D. 1866.

Sealed and delivered in presence of } ROBERT BROWN. [L. S.]

Acknowledgment, as in No. 13.

5 CENT INT. REV. STAMP.

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TO

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